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REPORTS
OF
CASES ARGUED AND DETERMINED
IN THE
Circuit Court of the United States
FOR THE SECOND CIRCUIT.

BY SAMUEL BLATCHFORD,
REPORTER OF THE COURT.

VOLUME II.

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JUDGES
OF THE CIRCUIT COURTS OF THE UNITED
STATES

WITHIN THE SECOND CIRCUIT,

DURING THE TIME OF THESE REPORTS.

SAMUEL NELSON, Associate Justice of the Supreme
Court of the United States.

DISTRICT JUDGES.

SAMUEL R. BETTS, New York, Southern District.
ALFRED CONKLING,* }
NATHAN K. HALL,* } New York, Northern District.
SAMUEL PRENTISS, VERMONT.
ANDREW T. JUDSON, CONNECTICUT.

* The Honorable NATHAN K. HALL was appointed District Judge for the Northern District of New York, August 31st, 1852, in place of the Honorable ALFRED CONKLING, resigned.

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CASES
ARGUED AND DETERMINED
IN THE
CIRCUIT COURTS OF THE UNITED STATES
WITHIN THE SECOND CIRCUIT.

JOHN B. EMERSON
vs.
PETER HOGG AND CORNELIUS H. DELAMATER.

It is the province and the duty of the Court to settle, as a question of law, the meaning of the specification of a patent, and, if that cannot be ascertained satisfactorily upon its face, the patent is void for ambiguity.

Accordingly, where it was objected, upon the face of the specification of a patent for improvements in the mode of propelling vessels, that it was uncertain whether the patentee claimed a *wheel* constructed *spirally*, or only *spiral paddles* attached to a wheel, and the Court instructed the jury that the question whether the specification was ambiguous in the particular charged was one compounded of law and fact, and that, if the jury should find that a *spiral wheel* and a *spiral propeller* were the same thing in ordinary acception, then the specification was sufficiently certain in that respect: *Held*, that the instruction was erroneous.

Where prayers for instructions to the jury are made, and are not complied with by the Court, they are to be considered as refused.

Exceptions will lie to the refusals of the Court to give instructions when requested, in like manner as to the instructions actually given.

A patent embracing several distinct inventions is valid, where they are capable of being used in connection, and to subserve the same common end.

- But their actual employment together is not required to sustain the validity of the patent, and the wrongful use of either invention separately is a violation of the patent *pro tanto*.

Emerson v. Hogg.

Where a patent contained three claims, viz.: (1.) A mode of converting the reciprocating motion of a piston into a continued rotary motion, by a new combination of machinery; (2.) An improved spiral propelling-wheel; and (3.) The application of a revolving vertical shaft to the turning of a capstan on the deck of a vessel; and it appeared from the specification that the three inventions were contrived with the view of being used conjointly, and as conducing to a common end, in the better propelling and navigating a ship: *Held*, that the patent was valid.

Held, also, that the fact that the three inventions were capable of being used separately and independent of each other, did not prevent their being embraced in one patent.

If a patent describes an invention, and how it is to be applied, it is not necessary in either the specification or the drawing to describe or delineate the old machinery with which the new contrivance is to be connected, when no change in its form or proportions enters into the new invention.

Under the act of February 21st, 1793, (1 *U. S. Stat. at Large*, 322, § 3,) it is sufficient for the patentee to put on file, with his specification, drawings and written references, without their being mentioned in the specification; and, if the references are written on the drawings, the terms of the act are complied with.

Where a patent was issued in 1834, to which no drawing was annexed, but a drawing had been originally deposited in the Patent Office, and the record of the patent and the drawing were destroyed by fire in the burning of the Office in December, 1836, and the patentee, under the act of March 3d, 1837, (5 *U. S. Stat. at Large*, 191,) restored the record of his patent in May, 1841, but did not file a drawing under § 1 of that act, verified by oath, until February, 1844, and then, in March, 1844, finding that drawing imperfect, made and swore to and filed a second one, and, in May, 1844, commenced an action for the infringement of his patent: *Held*, that a duly certified copy of the second drawing, as so attested and filed, was admissible in evidence, on the trial of such action, under § 2 of that act.

It being alleged that the patentee had abandoned his discovery, and the lapse of time from the grant of the patent to the commencement of the action being urged as proof of that fact: *Held*, that he was entitled to give evidence of the filing of his drawings, or of any other act done by him in assertion of his right.

Where, in such case, on a motion by the defendant for a new trial, it was objected that the plaintiff was not entitled to damages for infringements committed prior to the re-recording of his patent, the charge of the Court at the trial having imported a general liability of the defendant, and the Court not having been prayed to instruct the jury otherwise, and no exception having been taken to the direction as given: *Held*, that the objection could not now be taken.

(Before NELSON and BETTS, JJ., Southern District of New York, December 1st, 1845.)

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THIS was an action on the case, commenced in May, 1844, for the infringement of Letters Patent granted to the plaintiff on the 8th of March, 1834, for "a new and useful improvement in the steam-engine." The specification is set forth at length in the case of *Hogg v. Emerson*, (6 How. 437, 438 to 441.) In the preamble to the specification the invention was said to be of "certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land." The claims were as follows :

"What I claim as my invention, and for which I ask a patent, is the substituting for the crank in the reciprocating engine a grooved cylinder, operating in the manner hereinbefore described, by means of its connection with the piston-rod, together with all the variations of which this principle is susceptible ; as, for example, a bar of metal may be bent in the form of a groove, and attached to the revolving shaft, and friction-wheels on the piston-rod may embrace this on each side, producing an effect similar to that produced by the groove. I also claim the spiral propelling-wheel, constructed and operating in the manner which I have set forth ; and likewise the application of the revolving vertical shaft to the turning of a capstan on the deck of a vessel. Not intending, in either of these parts, to confine myself to precise forms or dimensions, but to vary them in such manner as experience or convenience may dictate, whilst the principle of action remains unchanged, and similar results are produced by similar means."

It appeared at the trial that the drawing and model of the plaintiff's invention, originally deposited in the Patent Office, were destroyed when that Office was burned in December, 1836. Under the act of March 3d, 1837, (5 U. S. Stat. at Large, 191,) the plaintiff, for the purpose of restoring the record of his patent, filed in the Patent Office, in May, 1841, a Court copy of his patent. No drawing was annexed to the patent originally issued, nor was any referred to in the specification. But the plaintiff, when he restored the record of his patent in May, 1841, at the same time deposited in the Patent Office a new drawing of his invention, which, however, was not sworn to by him or in any way attested. On the 12th of February, 1844, this drawing, having been duly sworn to by the plaintiff, was filed in the Patent Office. But, on a subsequent examination of it, it was found to be imperfect, and a

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second drawing was made and sworn to and filed in the Patent Office on the 27th of March, 1844. A certified copy of this drawing, as so attested and filed, was offered in evidence by the plaintiff, and admitted, under the objection of the defendants.

The validity of the patent was objected to by the defendants, on the ground that the specification was ambiguous, and that it was uncertain upon its face whether the patentee claimed a *wheel* constructed *spirally*, or only *spiral paddles* attached to a wheel; and the defendants requested the Court to charge the jury that the patent was void on that ground. The part of the specification on which the point arose is quoted in the opinion of the Court. The Court refused to charge as requested; but charged that the question whether the specification was ambiguous in the particular charged was one compounded of law and fact, and that, if the jury should find that a *spiral wheel* and a *spiral propeller* were the same thing in ordinary acceptation, then the specification was sufficiently definite and certain in that respect.

The defendants also objected to the validity of the patent, on the following grounds: (1.) That the claim of the patent covered three distinct and independent inventions; (2.) That the specification did not sufficiently indicate what was the invention claimed; (3.) That it did not sufficiently distinguish the new mechanism from what was before known. The Court charged that the patent was not open to any of these objections.

There was a verdict for the plaintiff, and the defendants now moved for a new trial, on a bill of exceptions.

Seth P. Staples and *John O. Sargent*, for the defendants.

Francis B. Cutting, for the plaintiff.

BETTS, J. The exceptions taken to the rulings of the Court on the trial, and to the final instructions to the jury, and the

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points raised on the argument under those exceptions, embrace a great variety of topics, relating as well to general principles applicable to all patent cases as to the particular features of this case. Several days have been occupied in the discussion of those questions, but the conclusion to which we have come in examining the exceptions will spare us the necessity of considering the argument in its whole extent, and of adjudicating all the matters in controversy.

We think the exception well taken to the fourth instruction given by the Court to the jury, which is as follows: "Whether the specification be ambiguous is generally a question of law to be decided by the Court. In this case, it is compounded of law and fact, and, if the jury find the fact to be that a *spiral wheel* and a *spiral propeller* are the same thing in ordinary acceptation, then the specification is sufficiently definite and certain in this respect." The part of the specification to which the instruction is applicable is this: "I employ an improved *spiral paddle wheel*, differing essentially from those which have heretofore been essayed. This *spiral* I make by taking a piece of metal of such length as I intend the *spiral propeller* to be, and of a suitable width, say, for example, eighteen inches; this I bend along the centre so as to form two sides, say of nine inches in width, standing at right angles, or nearly so, to each other, and give to it, longitudinally, the spiral curvatures which I wish. Of these pieces I prepare two, three, or more, and fix them on the outer end of the paddle-shaft, by means of arms of a suitable length, say of two feet, more or less, in such a position that the trough-form given to them longitudinally shall be effective in acting upon the water. It must be entirely under water, and operate in the direction of the boat's way. Instead of metal, the *spiral propeller* may be formed of wood, and worked into the proper form, the shape, and not the material thereof, being the only point of importance."

The specification was objected to on the trial as ambiguous, and one of the particulars urged in support of the objection was, that it was uncertain, upon the face of the specification,

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whether the patentee claimed a *wheel* constructed *spirally*, or only *spiral paddles* attached to a wheel. The Court did not dispose of the point as a question of construction merely, but left a fact to be found by the jury, and indicated the rule of law that would govern when that fact should be ascertained. This was undoubtedly error. It is the province and the duty of the Court to settle the meaning of the patent, and, if that cannot be ascertained satisfactorily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. (*Godson on Pat.* 109, and *Supp.* 29; *Phillips on Pat.* 249, 252.) The meaning of the terms employed, in view of the object the inventor had in contemplation, and to ascertain the extent of his claim, must be determined and declared by the Court. The specification is laid before the jury as defined and settled by the exposition of the Court, and the matters of fact presented by the respective parties to support or defeat the patent are then to be examined and applied as if the construction fixed by the Court had been incorporated in the specification. It accordingly devolved upon the Court to dispose of the question as a point of law, and either to decide that the patent was in this respect ambiguous, and therefore void, and direct the jury to find a verdict for the defendants, or to rule against the objection, and decide that the patent conveyed, in this particular, a meaning sufficiently certain, and point out what its claim was. (*Washburn v. Gould*, 3 *Story*, 122.) This Court cannot now estimate what effect upon the conclusions of the jury this wrong direction of the Court may have had, and, as the defendants were entitled to an explicit instruction on the point, the refusal of the Court to give it must necessarily avoid the verdict, it not being manifest that the point is irrelevant and immaterial to the issue tried.

The question whether the specification in this particular is so ambiguous and uncertain as to defeat the patent, was not argued on the exceptions, and we, therefore, forbear pronouncing upon that point now. It will remain to be brought up again on the new trial.

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Numerous instructions were prayed for by the defendants. When the charge has not complied with the prayers, they are to be considered as refused, and exceptions will lie to the refusals of the Court to give instructions when requested, in like manner as to the instructions actually given. (*Douglass v. McAllister*, 3 *Cranch*, 298; *Smith v. Carrington*, 4 *Cranch*, 62; *O'Neale v. Long*, 4 *Cranch*, 60; *Pennock v. Dialogue*, 2 *Peters*, 1; *Pitts v. Whitman*, 2 *Story*, 609; *Clymers' Lessee v. Dawkins*, 3 *How.* 674.) The Court is accordingly to be regarded as having decided on the trial: (1.) That the patent is good on its face, including the claim for three different inventions; (2.) That the specification is not defective for ambiguity, in any particular other than the one submitted to the jury as before stated; and (3.) That the specification sufficiently distinguishes the new mechanism from the old.

We shall not spread out at large the reasons governing our decision upon these general heads. Yet, as all the important questions involved in the case were fully argued, and the same questions may again arise on the new trial, we submit the conclusions adopted by us, as a guide in the future proceedings in the case. It will be the proper time to determine how far this present decision shall be held conclusive on these points, when the offer shall be made to re-open and review before us the same questions.

(1.) In *Evans v. Eaton*, (3 *Wheat.* 454, 506), and in *Barrett v. Hall*, (1 *Mason*, 447, 475,) doubts are started whether, under the general patent law, improvements on different machines can regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of them in combination. But the special statute, (6 *U. S. Stat. at Large*, 70,) applicable to the first case, furnished a rule in itself, and the doctrine intimated by the Court must accordingly be accepted as put hypothetically, and not laid down as a settled principle to govern the construction of specifications. The case of *Barrett v. Hall* attempts a generali-

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zation of the doctrines of the patent law, and, in the particular now under inquiry, the definition there adopted has no necessary connection with the case decided. Judge Story, in *Moody v. Fiske*, (2 *Mason*, 112, 119,) enters a caveat against his reasoning in that case being held to authorize the including in one specification several improvements in separate machines, having distinct and independent operations; much less the claiming in the same patent a combination of different machines, and distinct improvements in each. The suggestions advanced in all these cases were by way of caution, and were probably designed to avoid the conclusions that the Court had prejudged or was committed upon that particular form of the question. No one of the cases demanded a judgment upon the specific point. In *Wyeth v. Stone*, (1 *Story*, 273, 292,) the Court reviews those cases, and restricts their application to such inventions as are necessarily distinct from each other, and not contemplated to be used in connection, and holds that a patent for several machines, each being a distinct and independent invention, is valid, where they have a common purpose and are auxiliary to the same common end. (*Phillips on Pat.* 216, 217; *Pitts v. Whitman*, 2 *Story*, 609, 620, 621.) The principle seems to be, that the inventions should be capable of being used in connection, and to subserve a common end, (*Wyeth v. Stone*, 1 *Story*, 273, 289, 290,) though their actual employment together does not seem to be required to sustain the validity of the patent in which they may be united. Accordingly, the wrongful use of either separate machine is a violation of the patent right *pro tanto*. (*Id.* 292.)

We think the specification in this case shows that these three separate machines were contrived with the view of being used conjointly, and as conducing to a common end, in the better propelling and navigating a ship, and, in our opinion, their capability of being used separately and independent of each other, does not prevent their being embraced in one patent.

(2.) We think the other objections of ambiguity are not

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supported. The patent sufficiently indicates what the patentee claims to be his improvement, and the only question is, whether his description is sufficiently full and exact to enable a mechanic to construct the new machine. This is a fact to be inquired into and settled by the jury, and not a matter for the Court to adjudicate. If it be decided that the patent claims the invention of a spiral wheel, or of a spiral propeller, as distinct and different from a wheel, there does not seem to the Court any further uncertainty or ambiguity as to the object sought to be secured by the patent.

(3.) We think, also, the specification distinguishes the new mechanism from the old with as much particularity as is required by the rules of law. It describes the invention, and how that is to be applied, and the law does not render it necessary to set forth the old machinery with which the new contrivance is to be connected. (*Phillips on Pat.* 270, and *cases there cited.*) The drawing becomes part of the patent, and may be referred to in order to help out the description. But in neither need the old and well-known parts of the machine be described or delineated, when no change in their forms or proportions enters into the new invention.

One great object of the exceptions taken by the defendants is to rectify the decision of the Court as to the admissibility of evidence.

1. It is contended that the Court erred in admitting the drawings in evidence, they not being referred to in the specification. It is at best equivocal, whether the act of February 21st, 1793, (1 *U. S. Stat. at Large*, 318, 322,) requires the *specification* to contain *written references* to drawings. The language (§ 3) is: "and he shall accompany the whole with *drawings* and *written references*," &c. The express terms of the clause no more require that the *written references* should be incorporated in the specification, than that the *drawings* should be. Judge Story first read the section as demanding that the *references* should be set forth in the specification. (*Earle v. Sawyer*, 4 *Mason*, 1, 11.) But the specification in that case was so prepared, and accordingly

the interpretation of the statute was not demanded of the Court. Congress clearly suppose that the drawings are not necessarily to be noticed in the patent, for they say, in the act of March 3d, 1837, § 1, (5 *U. S. Stat. at Large*, 191,) "wherever a drawing was not originally annexed to the patent, and referred to in the specification," &c. And again, in the 3d section of the same act, the mode of making evidence of the drawing of an invention, if separate from the patent, is prescribed in language importing that it may be distinct, and without connection, by references or otherwise, with the patent.

Upon general principles, and in view of the policy and convenience of the matter, it might probably have been the better construction to hold that the drawings should be so connected, by reference or annexation, to the specification, as to make it certain that a drawing was relied upon, and what particular one was intended. There could then be no mistaking what was to be examined to learn the inventor's discovery, and no surprise could be practised by offering in evidence a different drawing, or producing one that had not been originally prepared with the description, to fix its meaning and extent. But we think the more recent acceptance with the Circuit Judges has been, that the patentee complies with the requirements of the act, if he puts on file, with his specification, drawings and written references, without their being mentioned in the specification, and that, if the references required are written on the drawings, the terms of the statute are satisfied. This was directly decided by Judge Story in *Washburn v. Gould*, (3 *Story*, 122,) and seems to have been so ruled by Judge McLean in *Brooks v. Bicknell*, (3 *McLean*, 250.) The long usage at the Patent Office to receive and record drawings not referred to in the specification, is of weight, also, in fixing the meaning of the clause. And we, in this case, conform our construction of the law to that usage and understanding, and hold that there was no error in the decision of the Court at the trial on this point.

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2. Another objection much pressed on the argument was, that the Court admitted in evidence several different copies of drawings filed by the patentee. It was insisted that he was not entitled, under the act of March 3d, 1837, to offer in evidence any other than the first drawing deposited by him in obedience to the requirement of that act.

The original patent and drawings were destroyed with the Patent Office in 1836. On the proof of that fact the plaintiff would, at common law, have been entitled to give secondary evidence of the contents of those documents. The second section of the act of 1837 restricts this common law rule of evidence, and interdicts the receiving any patent in evidence, unless it be re-recorded conformably to that act, and also excludes drawings not verified pursuant to that act. The first section of the act authorizes any person having in his possession or being interested in any patent issued prior to December 15th, 1836, to have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim, and drawings annexed or belonging to the same. Then follows a direction to the Commissioner to cause the same, or any authenticated copy of the original record, specification or drawing which he may obtain, to be transcribed and copied into books of record. The act then declares: "And wherever a drawing was not originally annexed to the patent, and referred to in the specification, *any drawing* produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require," may be filed, &c.; and, by the second section, copies thereof, certified by the Commissioner, are made *prima facie* evidence, the same as copies of the original record.

The plaintiff, after the loss of his original drawings, made out and filed a copy verified as directed by the Commissioner, and subsequently, considering that copy imperfect, he had another prepared and verified and filed. The certified copy of this second one was offered in evidence and received by the Court, and to that admission the exception applies.

We think the evidence was properly admitted upon either

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one of two grounds: (1.) The plaintiff had a right to draw up at any time a delineation or pictorial representation of his invention, and present it in elucidation of his written description. It performs in part the office of a model, which may at any time be constructed for the purpose of illustrating and giving application to contrivances which may be obscure or difficult to understand, as described in the specification. (*Phillips on Pat.* 294, 295.) (2.) This drawing was not originally annexed to the patent and referred to in the specification, and accordingly was of that particular class which was to be received at the discretion of the Commissioner. The provisions of the first section of the act of 1837 are full to show the meaning of Congress, that the Board of Commissioners were to take all practicable measures for restoring to the files the best possible substitutes for lost drawings. They may be prepared in the Patent Office, or obtained from clerks of Courts, &c. When put on file they are public records, and all parties are entitled to copies of them, and such copies must be received in evidence, when offered. If they are discordant, one may destroy the effect of another. But, if they concur in the essential particulars of the invention, the fact that there is a variety of them, derived from different sources, would conduce to prove that the contents of the original one are substantially recovered. We think the authentication of the Commissioner entitled the party presenting the copy to read it in evidence, in the first instance, and that the facts proved or offered to be proved on the part of the defendants, did not entitle them to exclude from the consideration of the jury the copy offered by the plaintiff. (3.) It might be added that the plaintiff was entitled to give evidence of the filing of his drawings, or of any other act done by him in 1841, in assertion of his patent right. One branch of the defence taken in the notice under the plea was, that the plaintiff had abandoned his discovery, and the lapse of time from the grant of the patent to the commencement of this suit was urged as proof of that fact. The plaintiff was entitled to rebut any presumption of aban-

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donment by showing acts prosecuting or asserting his discovery.

3. It is objected that the plaintiff is not entitled to damages for infringements committed anterior to the re-recording of his patent, and that the jury were not correctly instructed on that subject. The charge imports a general liability of the defendants, and no intimation is given that their liability ought to be so qualified. This point was not raised at the trial. The Court was not prayed to instruct the jury otherwise, nor was a specific exception taken to the direction as given. If the defendants wished more definite instructions, or desired that those given should be qualified, they should have called the matter to the notice of the Court, that the mistake, if one, might have been then rectified. No advantage can now be taken, if an error has been so committed. (*Smith v. Carrington*, 4 *Cranch*, 62; *Carver v. Jackson*, 4 *Peters*, 1; *Norman v. Wells*, 17 *Wend.* 136; *Stafford v. Bacon*, 1 *Hill*, 532, 537.)

A new trial must be granted, the costs to abide the event.*

* The case was again tried before NELSON, J., in May, 1847, when the plaintiff again had a verdict. The defendants, after judgment, carried the case to the Supreme Court, where it is reported as *Hogg v. Emerson* in 6 *Howard*, 437, and in 11 *Howard*, 587, and where the decision of this Court as to the validity of the patent was sustained.

The City Bank of New York v. Skelton.

THE PRESIDENT, DIRECTORS AND COMPANY OF THE CITY BANK
OF NEW YORK

vs.

ELIZABETH SKELTON AND OTHERS. IN EQUITY.

Upon the general principles of Equity jurisprudence, a bank may, in a proper case, have relief by bill of interpleader against separate and adversary parties who claim title to moneys therein deposited.

This Court has no power to restrain or interfere with a suit prosecuted and pending in a State Court, by enjoining the further prosecution of such suit.

But this Court, in executing a jurisdiction vested in it, may, in a case of which it has cognizance, act upon parties who are suitors in a State Court in relation to the same subject-matter, so far at least as to compel their submission to such judgment as this Court may render in the case.

Where funds were deposited in a bank, and afterward S., claiming the funds as his property, commenced a suit for their recovery in a State Court against the bank and Y., the depositor of the funds, and, while that suit was pending, Y. commenced two suits in this Court against the bank, to recover the funds and damages for their detention, the bank having no interest in the funds: *Held*, on a bill filed in this Court by the bank against S. and Y., that although this Court would not decree an interpleader in the case, or enjoin the suit in the State Court, yet it would enjoin the prosecution by Y. of his suits in this Court, until the final decision of the suit in the State Court.

Held, also, that this Court would give the parties the option to consent by stipulation to interplead in this Court on the subject-matter, and, in case they did so, would allow the bank to pay the funds into Court, first deducting such costs and expenses as the Court should allow.

(Before BETTS, J., Southern District of New York, March 2d, 1846.)

THIS was a bill in equity filed in December, 1845, by the plaintiffs, a banking corporation in the city of New York, against Elizabeth Skelton and Mary Ann Frazer, citizens of the West Coast of Africa, and Philip R. Yonge, a citizen and resident of Georgia. The facts were these: At the instance of Lot Clark, the plaintiffs, on the 5th of July, 1844, agreed to receive on deposit for safe keeping, for a short time, and until some conflicting claims in respect to them should be adjusted, certain bonds and moneys and a promissory note. Accordingly, the said Clark, Samuel L. Burritt

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and Erastus C. Benedict, (the latter acting, as was alleged, on behalf of the defendant Yonge,) deposited with the plaintiffs sixteen six *per cent.* bonds of the United States, amounting in the whole to \$52,000, with coupons attached for the payment of interest, and a promissory note of one Gibbs for \$1,000, and \$2,490 in cash, said to be interest previously collected on the bonds. The plaintiff's teller, who received the deposit, delivered to Benedict, with the knowledge and concurrence of Clark and Burritt, a bank book, commonly called a dealer's book, containing this entry: "City Bank, New York, in ac. with Philip R. Yonge. Bonds deposited for collection of the interest alone, no part of the said deposit, principal or interest, to be withdrawn before the first day of September next, unless Samuel L. Burritt, of E. Florida, shall in writing request said Yonge or his attorney to withdraw the same, or some portion thereof;" and then the particulars of the deposit were stated. About the 1st of August, 1844, three of the bonds, for \$3,000 each, and the note of Gibbs, were withdrawn from the bank pursuant to the above condition; and the bank subsequently received, for interest on the remaining thirteen bonds, \$2,580 in cash. The bill alleged that the plaintiffs continued to hold the said assets under such deposit, without making any claim to any part of them, and had always been and were ready and desirous to deliver the same to whosoever might be entitled to them.

In August, 1844, the defendants Skelton and Frazer, by the said Clark as their solicitor, filed a bill in the Court of Chancery of the State of New York, against the plaintiffs and the defendant Yonge, claiming the said assets and funds as their property, as legatees and heirs at law of John Frazer, deceased, representing that the said assets belonged to and were derived solely from his estate, of which the defendant Yonge was one of the executors, and that the executors had received other and sufficient assets to satisfy all the debts and specific legacies of the estate, and setting forth various other facts to show that the assets so deposited belonged to them and ought not to be paid over to the defendant Yonge, and

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praying an injunction against the plaintiffs and Yonge, and other appropriate relief. An injunction was issued by the State Court, on the bill, and served on the plaintiffs, restraining them from parting with the bonds and money. They appeared in the suit and filed their answer in January, 1845, disclaiming all title to or interest in the assets, and offering to pay over the same as the Court might direct. Yonge also appeared in that suit and answered the bill. The injunction was subsequently dissolved by the Chancellor, leaving the subject-matter of the suit to be prosecuted between the parties as they might be advised; and the suit was still pending, undetermined, when this bill was filed.

On the 3d of November, 1845, after the dissolution of the injunction, a notice in writing was served on the plaintiffs on behalf of the said heirs, to the effect that the said assets belonged to the said heirs, and that, if the plaintiffs should deliver them to Yonge, they would do so at their peril.

On the 25th of November, 1845, Yonge commenced two suits at law in this Court against the plaintiffs, one in trover and the other in *assumpsit*. In the former, he sought to recover the value of the said remaining thirteen bonds, with coupons attached; and, in the latter, damages for not delivering to him the said bonds, and for not paying to him the interest so collected thereon. Those suits, also, were pending, undetermined, when this bill was filed.

The bill contained other averments usual in bills of interpleader, and prayed that the defendants might be decreed to interplead and settle their rights to the said bonds and moneys, or might proceed and determine them, if possible, in said suit in the State Court of Chancery; or that, on the discontinuance of the latter suit, the plaintiffs might be at liberty to pay over the assets to the parties on being indemnified by this Court in so doing, or to pay the same into this Court, to be disposed of as it might direct, on the discontinuance of said suit in Chancery; that Yonge might be enjoined from prosecuting his suits at law, and Skelton and Frazer from prosecuting their suit in Chancery; and that the

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plaintiffs, on paying the assets into Court, might be discharged from all liability to the defendants in the premises, and have allowed to them all their costs and counsel fees in all the suits.

A motion was now made, upon the bill, for provisional injunctions.

George William Wright, for the plaintiffs.

Samuel Sherwood, for Skelton and Frazer.

Erastus C. Benedict, for Yonge.

BETTS, J. Two questions have been discussed on this motion: (1.) Whether the facts establish a case for a decree of interpleader; (2.) Whether this Court has jurisdiction to make such a decree.

The strong objection taken to the right of interpleader in this case is, that the plaintiffs received the deposit as bailees of Yonge, and became absolutely bound to him to return it at his call; and that the qualification in the deposit, that the written concurrence of Burritt should be necessary to a withdrawal of the deposit, operated only for a limited period, and ceased to have any effect after the 1st of September, 1844.

Eminent Judges speak of the doctrines respecting bills of interpleader as perplexing and not well defined. (2 *Story's Eq. Jur.* § 814, and notes.) The fundamental principle upon which relief by bill of interpleader is founded is, that two or more persons are claiming the same thing by different or separate interests, of a person who does not claim any interest therein himself, and does not know to whom he ought of right to surrender it, and that one or both have brought, or threaten to bring, actions against him. In such case, he may appeal to a Court of Equity to protect him from the vexation attending such suits, and also from being compelled to respond to several parties for the same thing. (2 *Story's Eq. Jur.*

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§ 806; 2 *Kent's Comm.* 567, 568; *Jeremy's Eq.* 347; *Eden on Inj.* 1st Am. ed. 242; *Crawshay v. Thornton*, 2 *Mylne & Craig*, 1; *Atkinson v. Manks*, 1 *Cowen*, 691.) The defendant Yonge insists that the rule does not apply to bailees or to bankers, but that they are bound by the general principles of law to restore to the bailor the deposit made with them. (2 *Story's Eq. Jur.* §§ 816, 817; *Story on Bailments*, § 110.) But the cases which seemingly support that objection are counterbalanced by a weightier array of authorities, both English and American, to the contrary. (2 *Kent's Comm.* 566 to 568; *Atkinson v. Manks*, 1 *Cowen*, 691; *Schuyler v. Pelissier*, 3 *Edw. Ch. R.* 191; *Birch v. Corbin*, 1 *Cox's Ch. Cases*, 144; *Jeremy's Eq.* 348.) The rule has been directly sanctioned in the cases of funds deposited in a bank, (*Birch v. Corbin*, 1 *Cox's Ch. Cases*, 144,) and with a stakeholder (*Id.* 145;) and it has been applied in behalf of a captain of a vessel, against whom there were adverse claims upon bills of lading. (*Lowe v. Richardson*, 3 *Madd.* 277.) Each of these cases is strong in analogy to the present one, and I should feel no difficulty in declaring, upon the general principles of Equity jurisprudence, that a bank may be entitled to relief by bill of interpleader against separate and adversary parties who claim title to moneys therein deposited.

But there is an impediment to the enforcement of that principle by this Court in the case now before it. One of the suits pending, against which the plaintiffs ask relief, is prosecuted in the State Court of Chancery, and this Court is clothed with no power to restrain or interfere with a suit so situated. A Court of the United States, in executing a jurisdiction vested in it, may undoubtedly act upon parties who are suitors in a State Court in relation to the same subject-matter, so far at least as to compel their submission to such judgment as the United States Court may render in a case of which it has cognizance. But, even then, it cannot interdict their prosecuting their suit in the State Court, much less control any action pending in such Court. It is understood that

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the State Courts uniformly adopt the same doctrine in respect to Courts of the United States. Here it is to be assumed that the State Court is competently possessed of the case before it, and a decree of this Court compelling the plaintiffs and one of the defendants in that Court to interplead here, would be an exercise of that authority and control over the State Court itself which can only be allowed to a tribunal of general jurisdiction under the same Government.

But the plaintiffs have made out a case of the most stringent equity against allowing Yonge to proceed in his suits in this Court against them, while the suit brought by Skelton and Frazer is pending in the State Court for the same subject-matter, and to which he is a party defendant. The conflicting rights of these two prosecuting parties are directly at issue in the suit in the State Court, and that forum has full capacity to decide the right between them. There the controversy should be continued so far as these plaintiffs are to be affected, and, with the determination of that case, they should legally know to whom they can rightfully deliver over the funds in their possession.

I think the cases of *Mallow v. Hinde*, (12 Wheat. 193,) and *Dunn v. Clarke*, (8 Peters, 1,) furnish a guide to the order proper to be made in this case. The former was a case similarly circumstanced to the present one, and is an authority that this Court may, in its discretion, restrain the prosecution of the suits brought by Yonge, until he has had an opportunity to settle his controversy with Skelton and Frazer in the suit in the State Court of Chancery.

I shall accordingly order an injunction to that effect, giving to the parties the option to consent, by stipulation, to interplead in this Court on the subject-matter, and thus place it wholly under the control of this Court.*

* Order. The bill in this case having been read, and counsel for the respective parties having been heard, and the premises being fully considered, and it appearing to the Court that the plaintiffs hold the assets and funds in the bill mentioned for the true owner, without having or claiming any right or interest

Suydam v. Day.

DAVID L. SUYDAM vs. HORACE H. DAY.

Under the Patent laws of the United States, an assignee of a patent must be regarded as acquiring his title to it, with a right of action in his own name, only by force of the statute.

Such exclusive right of action exists in favor of a sole assignee only in two cases, namely, where he acquires, by assignment, the whole interest in the patent, or a grant or conveyance of the whole interest within some particular district or territory.

Under §§ 11 and 14 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121 123,) an action is given only to such party, (composed of one or more persons,) as possesses the whole interest.

The subject-matter of a patent is not partible except in respect to territorial assignments.

therein, and that they are ready and willing to deliver the same over to whosoever may have right thereto; and it appearing to the Court that the defendants Elizabeth Skelton and Mary Ann Frazer have heretofore filed their bill in the Court of Chancery of the State of New York against the plaintiffs and the defendant Philip R. Yonge, alleging the full right and title to the said funds and assets to be vested in and to belong to the said Skelton and Frazer; and it appearing to the Court that the plaintiffs and the said Yonge entered their respective appearances in said suit in said Court of Chancery, and that said suit is still pending and undetermined; and it further appearing to the Court that after such suit was instituted the said Yonge commenced in this Court, in his own name, two separate actions at law against the plaintiffs, one in trover, in which he seeks to recover the value of the said funds and assets, and the other in assumpsit, in which damages are demanded for the detention of the said assets, and that the plaintiffs have appeared in the said actions, and the same are yet pending and undetermined in this Court: It is, therefore, considered by the Court that the plaintiffs are entitled to relief in this Court in the premises; but, inasmuch as the suit instituted against the plaintiffs by the said Skelton and Frazer is prosecuted in the Court of Chancery of the State of New York, and the proceedings before that tribunal are not within the cognizance of this Court, or subject to its control, it is considered by the Court, that so much of the prayer of the said bill as seeks an interpleader in the premises, and prays the same to be decreed by this Court against the above-named defendants, ought not to be granted, and it is, therefore, ordered, that the same be denied. It is further ordered, that an injunction issue: according to the prayer of the bill, against the said Yonge, restraining him from further prosecuting his said actions at law, or either of them, instituted in this Court against the plaintiffs, until the final decision of the said suit pending in the Court of Chancery of the State of New York, unless the said Yonge and Skelton and Frazer shall, within twenty days from the date of this order, file their stipulation in writing in this Court, electing to interplead between themselves in this Court, in respect to the subject-matter aforesaid; and, in case of such interpleader between the said parties, it is ordered that the said plaintiffs thereupon pay into this Court the funds and assets aforesaid, first deducting therefrom such their costs and expenses as shall be allowed them by the Court.

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Where a patent was granted for an improvement in the mode of preparing india-rubber with sulphur "for the manufacture of various articles," and S. became the assignee of the exclusive right to use the improvement "in the manufacture of shirred or corrugated india-rubber goods:" *Held*, that S. could not maintain an action in his own name alone for an infringement of his right by the manufacture of such goods.

(Before NELSON and BETTS, JJ., Southern District of New York, April 25th, 1846.)

DEMURREE to a declaration. The action was case for the infringement of Letters Patent. The plaintiff counted on two patents. The first count set forth a patent to Charles Goodyear, assignee of Nathaniel Hayward, granted February 24th, 1839, for an "improvement in the mode of preparing caoutchouc with sulphur, for the manufacture of various articles," and an assignment by Goodyear to the plaintiff on the 24th of May, 1844, of "the exclusive right, privilege, and license to use the said improvement in the manufacture of shirred or corrugated india-rubber goods," and alleged an infringement by "the manufacture of shirred or corrugated india-rubber goods." The specification of the said patent described the invention as an "improvement in the mode of preparing caoutchouc, gum-elastic or india-rubber, for the manufacturing of various articles in which that substance is used." The claim was "the combining of sulphur with gum-elastic, either in solution or in substance, either in the modes above pointed out, or in any other which is substantially the same, and which will produce a like effect." The second count set forth a patent to Charles Goodyear, granted June 15th, 1844, for an "improvement in india-rubber fabrics." The claims of the last-mentioned patent were: (1.) The combining of caoutchouc "with sulphur and with white-lead, so as to form a triple compound, either in the proportions herein named, or in any other within such limits as will produce a like result. And I will here remark, that although I have obtained the best results from the carbonate of lead, other salts of lead, or the oxides of that metal may be substituted therefor, and will produce a good effect, I, therefore, under this head, claim the employment

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of either of the oxides or salts of lead, in the place of the white-lead in the above-named compound." (2.) "In combination with the foregoing, the process of exposing the india-rubber fabric to the action of a high degree of heat, such as is herein specified." The second count also set forth an assignment by Goodyear to the plaintiff on the 24th of May, 1844, of "the sole and exclusive right to use, in the manufacture of corrugated or shirred india-rubber goods, the application of white-lead and the oxides of lead in connection with the application of artificial heat, and in combination with india-rubber and sulphur, in the manner and proportions set forth in the specification annexed" to the last-mentioned patent, and averred that the said specification and the application for Letters Patent under the same were, at the time of the making of the assignment, on file in the Patent Office, according to law, and alleged an infringement by "the manufacture of shirred or corrugated india-rubber goods or fabrics."

The defendant demurred to both counts, and the plaintiff joined.

George Griffin and Francis B. Cutting, for the defendant.

Seth P. Staples, for the plaintiff. (1.) By the act of Congress, the plaintiff can maintain an action in his own name, for injury to his rights under the patents. He has the *exclusive* right to use the patents for his own profit. Under § 11 of the act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) a party may sell any undivided part of his interest in a patent. The right to sell is not confined to an aliquot or integral part of the patent, but applies also to the divisible properties of the invention. Section 14 of the same act also tends to support the idea that a person who has an *exclusive* right in a patent, may have a remedy by action, may disclaim, &c., and, under § 17, a bill in equity may be filed by "any party aggrieved." (2.) The plaintiff can sustain this action on the general principles of the common law. It is an action on the case, and the law furnishes the remedy where the right is established.

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THE COURT held: 1. Under the Patent laws of the United States, an assignee of a patent must be regarded as acquiring his title to it, with a right of action in his own name, only by force of the statute. 2. Such exclusive right of action exists in favor of a sole assignee only in two cases, namely, where he acquires, by assignment, the whole interest in the patent, or a grant or conveyance of the whole interest within some particular district or territory. 3. Section 11 of the act of 1836, which authorizes the assignment of "the whole interest or any undivided part thereof," taken in connection with section 14 of the same act, gives an action only to such party (composed of one or more persons,) as possesses the whole interest. 4. The subject-matter of a patent is not partible except in respect to territorial assignments. 5. As the declaration in this case shows that the plaintiff has an interest in only a part of each patent, to wit, a license to use, in the manufacture of a particular kind of goods, the invention covered by each patent, it is bad on its face, and judgment must be rendered for the defendant.

JOHN JACQUES vs. EDWARD K. COLLINS AND OTHERS.

In a proceeding in this Court under § 15 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 82,) to obtain a discovery, in an action at law, of documents in the possession of the adverse party, it is only requisite that the cause should be at issue, and that the Court should be satisfied that the evidence required to be disclosed will be pertinent to such issue, and that the circumstances should be those in which a discovery would be decreed in Chancery.

It is not necessary that the petition for the discovery should contain the formalities of a bill of discovery in Chancery; but it is enough if it contains a notice to the opposite party of the time and place of making the application, and a plain designation of the documents sought for.

(Before BARR, J., Southern District of New York, May 25th, 1846.)

THIS was an action at law to recover damages for alleged false representations made by the defendants concerning the

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character and condition of divers goods shipped at New York by one De Goer on board a vessel for England, the plaintiff averring that, by reason of those representations, he was induced to advance a large sum of money to De Goer, by way of loan, on the goods as security, which money was entirely lost. The defendants now presented a petition to the Court, setting forth that the cause was at issue; that, prior to the making of the loan, a correspondence took place between the plaintiff and De Goer, in which the special motives and reasons for the loan were set forth, the reverse of those averred in the declaration; that the loan was made on certain bills of lading, invoices, and other documents, transferred to or deposited with the plaintiff by De Goer, as security for the loan; that De Goer had absconded, and his testimony as a witness could not be obtained; that the defendants had served a written notice on the plaintiff to deposit the correspondence and the other papers with the clerk of this Court, so that the defendants might take copies of them, or to serve copies of them, duly verified, on or before a day named, but the notice had not been complied with; that the papers in question were not in the possession or under the control of the defendants; and that the discovery of them was necessary to enable the defendants to prepare for trial. The petition prayed a discovery either by a deposit with the clerk, or by the service of sworn copies, and was verified by one of the defendants, to the effect that the papers were not in their possession or under their control, and that the affiant was advised by counsel and believed that the discovery was necessary to enable the defendants to prepare for trial. There was added a certificate of counsel that he had given such advice.

Seth P. Staples and John Anthon, for the defendants.

Francis B. Cutting, for the plaintiff.

BETTS, J. The petition now presented conforms to the course of practice in the State Courts, (*Graham's Pr. B.* 3, *ch.*

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6,) but an objection is taken to its sufficiency, on the ground that, if it were filed in Chancery to compel a discovery of the same papers, it would be bad on general demurrer, and that the present proceeding is substantially of the same character as if it were had in Equity.

The Supreme Court of New York seems to regard the State statute as transferring to the law Courts the jurisdiction and practice of Chancery in relation to this subject of discovery, to be exercised conformably to standing rules of Court. (*Townsend v. Lawrence*, 9 *Wend.* 458.) There is a difference, however, in the terms of the State and United States statutes, which may perhaps require some diversity of proceeding in executing them. (2 *R. S.* 199, §§ 21, 22; *Act of Sept. 24th*, 1789, § 15, 1 *U. S. Stat. at Large*, 82.) The act of Congress requires that the circumstances shall be those in which a discovery would be decreed in Chancery, but it in no respect designates the Chancery practice as the mode by which the law Courts shall execute the power. It also differs from the State statute in limiting the proceeding to cases in which issue is joined, and in which it is made to appear satisfactorily to the Court that the evidence required to be disclosed will be pertinent to such issue.

No method of proceeding being prescribed by Congress, this Court has always considered the purpose of the act best fulfilled by adopting the most simple and expeditious course of procedure, and avoiding the formalities of a bill of discovery in Chancery. A mere notice to the opposite party of the time and place of application, and a plain designation of the documents or pieces of evidence sought for, have been acted upon in this Court as sufficiently fulfilling the terms of the law.

The standing rules of this Court make no direct provision for this proceeding, and the adoption by them of the State rules, to apply in cases where none are specifically established by this Court, may very well embrace the regulations of the Supreme Court of the State governing these applications. The petition in this case, whether considered in that

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view, or only in relation to its constituent parts, is sufficient in substance, and adequate notice has been given to the plaintiff. The objection, therefore, that the petition is defective as a bill of discovery, cannot avail, and the plaintiff must produce and leave with the clerk the papers called for by the petition, or, at his election, serve copies of them on the defendants' attorney.

THE PRESIDENT, DIRECTORS AND COMPANY OF THE CITY BANK
OF NEW YORK

vs.

ELIZABETH SKELTON AND OTHERS. IN EQUITY.

This Court has power, in a proper case, to prohibit a non-resident plaintiff from prosecuting an action against a defendant residing within this State.

A party entitled to sue in this Court by reason of a constitutional qualification, acquires no right to any standing here different from what he would have in any other tribunal competent to take cognizance of his case.

Whenever, therefore, jurisdiction over his case has attached, this Court will proceed with it conformably to the general principles of law, and to the usage and practice of the Court.

The Circuit Courts of the United States have power to control and stay actions pending before them, either by order on the common law side of the Court, or by injunction on the Equity side.

But they will not exercise such authority over actions pending in a State Court, nor will a State Court interfere with actions pending in the Federal Courts.

The decision in this same case, (*ante*, p. 14,) that this is a proper case for this Court to stay by injunction an action at law pending here, reviewed and affirmed.

(Before NELSON and BETTS, JJ., Southern District of New York, July 31st 1846.)

AFTER the injunction in this case was granted, (*ante*, p. 14, the defendant Yonge answered the bill, and now moved for a dissolution of the injunction.

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Erastus C. Benedict, for Yonge.

George William Wright, for the plaintiffs.

BETTS, J. This motion is urged principally upon the ground that this Court has no constitutional power to inhibit a non-resident plaintiff from prosecuting an action against a defendant residing within this State. The Constitution, in designating the parties and subjects over which the Courts of the United States shall take jurisdiction, does not prescribe the manner in which such jurisdiction is to be exercised. It of course devolves upon Congress to regulate the mode of procedure by which the functions of the judiciary are to be executed. This is sometimes done by a specific direction to the Courts, but most commonly by very general provisions, such as are embodied in the process acts; or in § 34 of the Judiciary act of 1789, (1 *U. S. Stat. at Large*, 92.) The Equity powers of this Court, and the practice by means of which such powers are enforced, are, by act of Congress, made substantially the same as those of the High Court of Chancery in England. (*Act of May 8th, 1792*, § 2, 1 *U. S. Stat. at Large*, 276; *Robinson v. Campbell*, 3 *Wheat.* 212, 223.) Whenever, therefore, jurisdiction over a case attaches by virtue of the Constitution, the Court proceeds with it conformably to the general principles of law prescribed by the statute, or established under authority derived from it; and, in this respect, the Courts of the United States stand upon the same footing as those of this State or of Great Britain having general jurisdiction. A party entitled to sue by reason of a constitutional qualification, acquires no right to any standing in this Court different from what he would have in any other tribunal competent to take cognizance of his case. Wherever he is entitled to resort for relief, he must take his remedy, not upon the footing of his capacity to sue, but conformably to the law and usage of the Court. A suitor in this Court must accordingly be subject to such regulation and control as the Court, under authority

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of law, may deem proper to apply to his particular case, or such as may exist in the form of general rules of practice or decision.

This power of Circuit Courts to control and stay actions pending before them is distinctly recognized by the Supreme Court. (*Mallow v. Hinde*, 12 *Wheat.* 193; *Dunn v. Clarke*, 8 *Peters*, 1.) In both of those cases, the suits at law stayed by injunction were pending on the law side of the Circuit Court; and, in the latter case, although the Supreme Court held that the injunction bill could not be maintained for the want of proper parties, yet they ordered a stay of the suit at law in the Circuit Court until the parties should have had time to seek relief from a State Court. The stay of proceedings in the present case might, therefore, have been rightfully made by order on the common law side of the Court, or the Court may, on a proper bill, act on the Equity side, and effect the stay by injunction.

The Supreme Court of the State of New York exercises a broad equitable power over suits and suitors, in staying proceedings on mere motion, when the justice of the case demands such interference. (*Graham's Pr. B.* 3, *ch.* 2.) It is also a common head of Equity to restrain suits at law by injunction from Chancery, whenever the relief at law is inadequate or imperfect, or whenever the Court of Chancery has cognizance of the case already, and is competent to give the parties full relief. (*Thompson v. Brown*, 4 *Johns. Ch. R.* 619, 643; *Denton v. Graves*, *Hopk. Ch. R.* 306.) And no doubt, if Yonge had instituted his actions in a State Court of law, the Chancellor would have enjoined their prosecution. But the Courts of the United States will not exercise such authority over the State Court, (*Diggs v. Wolcott*, 4 *Cranch*, 179,) nor will the State Court of Chancery interfere with actions pending in the Federal Courts.

The case of *Dunn v. Clarke*, before cited, is full authority for staying proceedings in the actions at law in this Court, to await the decision upon the subject-matter in the State Court, the case here being clothed also with the additional feature,

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that the suit in the State Court was first brought and is at issue there between the same persons who are parties to the suits here.

The power of this Court thus to interfere being possessed in ample plenitude, we are satisfied that the facts of this case will warrant and indeed demand the exercise of that power. The motion to dissolve the injunction must, therefore, be denied.

SPARKMAN AND KELSEY

vs.

ELIAS S. HIGGINS AND OTHERS. IN EQUITY.

Where a plaintiff, who had obtained an injunction from this Court restraining a defendant from the infringement of a patent, set on foot a stratagem to lead the defendant to violate the injunction, and immediately made a motion for an attachment, knowing the defendant to be innocent of any wrongful act, and it clearly appeared that there had been no violation of the injunction: *Held*, that the plaintiff must pay the costs of the motion.

Even if there had been an actual violation of the injunction, induced by the stratagem of the plaintiff, an application for an attachment would not, *it seems*, be justified, either in conscience or in law.

(Before BERRS, J., Southern District of New York, October 20th, 1846.)

THIS was a motion for an attachment for an alleged violation of an injunction restraining the defendants from infringing the plaintiffs' patent for a *design* for floor oil-cloth. (See *Sparkman v. Higgins*, 1 *Blatchf. C. C. R.* 205.)

Daniel Lord, for the plaintiffs.

Seth P. Staples, for the defendants.

BERRS, J. A witness on the part of the plaintiffs deposes that he purchased, a few days since, some of the oil-cloth of

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the pattern in question at a store in Pearl street ; that on the same day he applied for oil-cloth at the defendants' store in Broad street, and bought some of the same kind there ; and that the clerk who sold the latter told him that the oil-cloth in Pearl street belonged to the defendants.

On the part of the defendants it is established, by the fullest proof, that they had no interest whatever in the Pearl street store, or in the oil-cloth sold there, and the evidence is strong to show that the plaintiffs were well aware of that fact. It is further proved by the defendants that a person applied to their porter, at their store, to see oil-cloth ; that it was shown him ; and that he selected out of the general stock the particular piece in question, and desired to have it sent to an address, which he gave, at a place designated, and then left the store. Immediately afterwards, one of the defendants went into the sales-room, and, on being informed by the porter of what had happened, forbade his delivering the cloth, and told him it could not be sold. The defendants further prove, that when the injunction was served they gave strict orders to their clerks to stop selling that description of cloth. The person who thus called at their store did not pay for the cloth, and it was not sent to the address. The name he gave was an assumed one, and it appears that he acted for the plaintiffs. The motion for an attachment is made on his affidavit.

The counsel for the plaintiffs very properly admitted that the application could not prevail, and that the evidence fully acquitted the defendants of all blame. But it was urged that probable cause for the motion had been shown, and that costs ought not to be awarded against the plaintiffs.

The proceeding on the part of the plaintiffs was palpably a stratagem to lead the defendants to violate the injunction. This motion is not induced by any acts known to have been done by the defendants, or by any declaration or intimation of theirs that they would disregard the inhibition they were under. Their conduct was in every respect submissive to the mandate of the Court. Even if the plaintiffs' agent had,

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under such circumstances, succeeded in making a valid purchase of the oil-cloth from the defendants' porter, by paying the price or obtaining a delivery of it, such transaction would not, either in conscience or in law, justify an application for an attachment. But there was no sale in fact; and, as the plaintiffs set on foot a scheme to entrap the defendants, and immediately pursued them with a motion for an attachment, knowing them to be innocent of any wrongful act, it is right that the plaintiffs should be charged with the costs of an application so made.

The motion for an attachment is denied, with costs to be taxed.

BENJAMIN G. WILDER *vs.* MICHAEL McCORMICK.

Where it is assigned, as cause of demurrer to a declaration, that it is not properly entitled, but the defect is not pointed out until the argument, and is then alleged to consist in a variance between the declaration and the writ, the Court cannot act upon it on such a suggestion.

But, even if such an objection were properly raised, an amendment of the error would be allowed.

Variances between the declaration and the writ cannot be taken advantage of on general demurrer.

In a declaration on Letters Patent for an invention, it is not necessary to aver at what specific time the invention patented was made; it need only be before the application for the patent.

The grant of Letters Patent is itself sufficient evidence that all the preliminary steps required by law were properly taken by the patentee; and it is not necessary, in a declaration on a patent, to plead the taking of any of those steps.

A declaration on a patent must tender an issue on the novelty and utility of the discovery patented, but it need not show the regularity of the proceedings in the Patent Office preliminary to the grant.

The authority of the Commissioner of Patents in granting a patent is not of the nature of *jurisdiction*, in its common law acceptation, and the doctrine appertaining to the judgments of tribunals of inferior jurisdiction, when pleaded, is not applicable to his acts.

A declaration on a patent, which avers the patent and specification to be "in

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language of the *import* and to the effect following," and then sets them forth *in hæc verba*, is sufficient, and is not open to the objection that the patent is not set forth according to its legal *tenor* and effect.

An averment that the patent and specification are "ready in Court to be produced," is equivalent to a *profert* in its most formal terms.

A reiteration of infringements of a patent may be sued for in one action.

A declaration for the infringement of a patent, commencing in *case*, and concluding by demanding *actual damages* in gross in compensation of the wrong, is good.

Where a declaration on a patent, though not formal, embodies all that is essential to enable the plaintiff to give evidence of his right and of its violation, and affords to the defendant the opportunity to interpose every defence allowed him by law, the Court will not encourage merely critical objections, and will seek, even on special demurrer, to sustain the declaration.

(Before NELSON and BETTS, JJ., Southern District of New York, November 19th, 1846.)

THIS was an action on the case for the infringement of Letters Patent. The defendant demurred to the declaration, assigning fifteen special causes of demurrer. The plaintiff joined. The case is sufficiently stated in the opinion of the Court.

Eugene Casserly, for the defendant.

• *John B. Staples*, for the plaintiff.

BETTS, J. Most of the causes of demurrer in this case are of an extremely technical character, touching very slightly the merits of the action. They can be best disposed of by considering them numerically in their order.

The first cause is, that the declaration is not properly entitled, but the defect or imperfection is not pointed out. It was alleged on the argument that the writ was returnable on the 19th of February, whereas the placita was of the 20th. If this objection was intrinsically of ever so great importance, the Court most manifestly would not act upon it on a suggestion so made. But, if the objection had come up on oyer of the writ, or by setting out the writ in *hæc verba* in the demurrer book, the Court would, under the statute, allow an amendment of an error so trivial. (*Act of Sept. 24th, 1789*,

§ 32, 1 *U. S. Stat. at Large*, 91.) Variances between the declaration and the writ cannot, however, be taken advantage of on general demurrer. (*Duvall v. Craig*, 2 *Wheat.* 45.) This cause of demurrer is overruled.

The second cause assigned is, that the declaration does not aver at what time the invention patented was made. Time is not, in this case, a traversable particular, in the sense of special pleading. The Patent law nowhere requires the patentee to allege or prove the specific time of his invention. It need only be before his application for a patent; and it is wholly immaterial to the validity of the patent, and to the character of the pleading to be interposed by the defendant, whether the invention was long antecedent to the application or directly preceded it. The act of July 4th, 1836, (5 *U. S. Stat. at Large*, 119, § 6,) entitles the person who invents or discovers a new manufacture, &c., not known or used by others before his discovery, to take out a patent. Should evidence be offered by the defendant, tending to defeat the patent, because it was taken out before the discovery was made, it would be clearly sufficient for the patentee, in its support, to prove that he made the discovery at any period, however short, previous to his application for the patent. (*Mellus v. Silsbee*, 4 *Mason*, 108; 2 *Greenl. Ev.* § 492.) The averment demanded by this cause of demurrer is not inserted in approved precedents of declarations for infringements of patents. (2 *Greenl. Ev.* § 487, note 1; *Phillips on Pat.* 520; 2 *Chitty's Pl.* 320.) The second cause must, therefore, be disallowed.

The third and fourth causes cannot be sustained. The third is, that it does not appear that the application for the patent was in writing, nor to whom it was made. The fourth is, that it does not appear that the Commissioner of Patents had any rightful authority to grant the patent. These causes are founded upon supposed requisites of the statute, not averred in the declaration to have been complied with, and are also supposed to be supported by general principles governing proceedings in tribunals of inferior jurisdiction. If

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the matters which it is alleged should be set forth in the declaration would call for the application of those principles in case they were pleaded by way of justification and in defence of acts done, or as a protection to the party pleading them, which would at least be a doubtful proposition, (*Martin v. Mott*, 12 *Wheat.* 19,) it would not necessarily follow that the same method of pleading must be pursued in declaring upon a private title or a grant emanating from functionaries acting under statutory authority. (*Day v. Chism*, 10 *Wheat.* 449; *Bank of the United States v. Smith*, 11 *Wheat.* 171; *Carroll v. Peake*, 1 *Peters*, 18, 23.) The third cause of demurrer rests upon the assumption that the plaintiff must, in his pleading, specify all the acts done by him to obtain a patent, in order that it may appear upon the face of the declaration that the mode of proceeding pointed out by the statute has been pursued. But the case of *The Philadelphia and Trenton Railroad Co. v. Stimpson*, (14 *Peters*, 448,) disposes of this and all the other objections that fall within the same class. The grant of the patent is itself sufficient evidence that all the preliminary steps required by law were properly taken. And, as the plaintiff may make his patent the direct and efficient proof, in the first instance, of his right to the grant, so, *a fortiori*, it would seem to be unnecessary for him to plead any of the particulars which conduced to the grant. It is sufficient to set forth the grant in substance. (*Tryon v. White*, 1 *Peters' U. C. R.* 96.) The fourth cause of demurrer is founded upon a misapplication of a doctrine appertaining to the acts of legal tribunals, where a Court of inferior jurisdiction takes cognizance of a case and renders judgment, and he who sets up such judgment in support of his own interests must aver and prove that the tribunal had jurisdiction in the matter. The authority of the Commissioner of Patents, or of the Commissioner of the Land Office, or of the President, (whose former functions in this behalf are now exercised by those officers,) to issue grants, is not of the nature of *jurisdiction*, in its common law and technical acceptation. As in regard to patents for

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land, so in regard to patents for inventions, the proper officer issues the grant when he has evidence satisfactory to his own mind that the claimant is entitled to receive it. But that adjudges nothing as to the real right. That question is unaffected, and remains to be examined and decided between parties contesting it, without prejudice or advantage from the Letters Patent. We are not aware of any method of pleading by which the Courts can be called upon to settle the regularity of the preliminary proceedings in the Patent Office. Nor does there seem to be any utility in putting in issue the authority of the Commissioner, upon the facts before him, to grant a patent, because, if the decision should negative his authority, it could not revoke or supersede the patent. The declaration must tender an issue upon the novelty and utility of the discovery patented, these being essential to the enforcement of any exclusive privilege under the patent. But the question of the regularity of the proceedings in petitioning for and obtaining the patent, and that of the correctness of the judgment of the officer in awarding it, are not material, and cannot be inquired into.

The fifth and sixth causes of demurrer are founded upon an inaccurate apprehension of the form of the declaration. The fifth cause is, that the declaration sets forth the Letters Patent according to their words and figures, and not according to their legal tenor and effect. The declaration avers the patent and specification to be "in language of the import and to the effect following;" and it cannot be a valid exception that "import" is used instead of "tenor," even if the words are not identical in signification, because the language is that of recital and not of grant. The sixth cause is, that the declaration does not make sufficient profert of the Letters Patent. The declaration says: "as by the said Letters Patent and specification, all in due form of law, ready in Court to be produced, will fully appear." This is equivalent to profert in the most formal and ample terms. It tenders the entire grant to the inspection of the Court and party.

The seventh cause is, that the declaration is bad for duplicity, in setting forth three distinct causes of action in the same count, viz.: three distinct infringements of the said Letters Patent. The patent is for an "improvement in fire-proof chests and safes." The declaration avers, in the same count, that the defendant "made and manufactured and sold five hundred iron safes or chests, in the manner and of the materials described in the said Letters Patent, and in imitation thereof, in infringement and violation of the said Letters Patent, and against the exclusive right so secured by the said Letters Patent;" and also, that he "made and manufactured and sold, and caused to be made and manufactured and sold" five hundred like iron safes or chests; and also, that he "put on sale and offered for sale and sold" five hundred like iron safes or chests. These various averments, which are supposed to constitute three separate causes of action, and thus to render the declaration liable to the objection of duplicity, are no more than a specification of the manner in which the plaintiff's right has been violated. A reiteration of infringements of a patent, like a repetition of torts of any other kind which are of the same nature, may be sued for and recompensed in one action. There is no known doctrine of the law that requires a plaintiff to split up into separate actions grievances of that character. They are properly united in this case, and the demurrer cannot be sustained for that cause.

The eighth cause is, that the declaration has no proper or formal commencement and conclusion, inasmuch as it commences in the form of an action of trespass on the case, and concludes in the form of an action of debt. The conclusion is, that the plaintiff has been injured and deprived of profits which he might otherwise have derived from the improvement, and has sustained actual damages to the amount of five thousand dollars; and that, by force of the statute, an action hath accrued to him to recover of the defendant the said actual damages, and such additional damages, not exceeding, in the whole, three times the amount of said actual

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damages, as the Court may see fit to order and adjudge; and that the defendant, though often requested, has never paid the same nor any part thereof to the plaintiff. If there be any foundation for this cause of demurrer it is of the most technical description, and the defect would be removable by amendment as of course. But we do not perceive that there is any material incongruity between the commencement and the close of the declaration. The gravamen of the suit is the tortious infringement of the plaintiff's patent, and the conclusion of the declaration is a demand of damages in gross. They are averred to be "actual damages," but that allegation does not change the nature of the averment. It is still merely a demand of damages in compensation of the wrong.

The declaration is not formal in its frame. But it embodies all that is essential to enable the plaintiff to give evidence of his right and of its violation by the defendant, and affords to the defendant the opportunity to interpose every defence allowed him by law. In such a condition of the pleadings in a cause, the Court will not encourage objections merely critical and over-nice, and will seek, even on special demurrer, to sustain pleadings substantially sufficient, and thus avoid useless delays and expenses.

The demurrer is overruled on all points, but without costs to either party.

HENRY STEPHENS*vs.*

DAVID FELT AND WILLARD FELT.

On the trial of an action for the infringement of a patent for a writing fluid, no proof was given of the cost of the manufacture of the fluid, or of the sale price, but it was shown that sales were highly profitable, and that the defendants had made and sold very large quantities. The defendants gave no evidence of the amount of their manufacture and sales, or of the cost or

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value of the article. The jury found a verdict of \$2,000 for the plaintiff *Hel?*, that the verdict must stand, it not being one of palpable extravagance. In such a case, a plaintiff is not held to the most exact proof of the amount of his damages, and the jury are warranted in exercising a liberal discretion. If the defendant prefers to leave the damages to general inference and the estimate of the jury, when he might make their amount reasonably certain by evidence on his part, the finding of the jury will not be interfered with, except in a case of palpable extravagance.

(Before NELSON and BETTS, JJ., Southern District of New York, December 2d, 1846.)

THIS was an action at law, to recover damages for the infringement of Letters Patent granted to the plaintiff for a writing fluid. The plaintiff had a verdict for \$2,000, and the defendants now moved for a new trial, on a case, upon the ground that there was no legal evidence authorizing the amount of damages given by the jury.

William Emerson, for the defendants.

George Gifford, for the plaintiff.

BETTS, J. The *actual damages* sustained by the patentee, are, according to the fourteenth section of the act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) to be the sum fixed by the verdict; and the Court is empowered, according to the circumstances of the case, to render judgment for any sum not exceeding three times the amount of the verdict. In this case, there was no proof of the cost of the manufacture of the fluid, or of the sale price. It was in evidence that sales were highly profitable, and that the defendants had manufactured and sold very large quantities, measured not by bottles only, but by hogsheads. It was also proved that they had prepared many thousands of labels, which were affixed to their bottles, and that they were constantly selling these labels and sending them off in large quantities, besides what were sold at retail at their establishment in New York. On these facts the jury assessed the damages. No proof was offered by the defendants, from their books or clerks, tending to limit or qualify the gene-

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rality of the evidence given by the plaintiff in respect to the amount of their manufacture and sales; nor did they offer proof of the cost of the article, or of its value in market, to show that their operations were not seriously injurious to the plaintiff. We do not think that a plaintiff ought, in such a case, to be held to the most explicit and exact proof of the amount of damages sustained, and that the jury are warranted in exercising a liberal discretion. A patentee may never be able to prove the extent of his actual damages, but a defendant can almost invariably, if he is disposed to do so, show the character of his own acts, and prevent any excessive valuation of damages against him. If, however, a defendant prefers to leave the matter to general inference and the estimate of a jury, when he might make it reasonably certain, by evidence on his part, we do not think the judgment and valuation of the jury should be weighed over-scrupulously, or that the Court should interfere with their finding, except in a case of palpable extravagance. We do not think the verdict in this instance is of that character, and, in our opinion, it ought to stand.

The motion for a new trial is accordingly denied.

JOSEPH F. ATWILL

vs.

EDMUND FERRETT AND OTHERS. IN EQUITY.

A special demurrer to a bill in Equity is insufficient unless it points out specifically, by paragraph, page, or folio, or other method of reference, the parts of the bill to which it is intended to apply.

Where an action at law for the infringement of a copyright was brought against G., and then the plaintiff filed a bill in equity against G., F. and A., charging them, as copartners, with having committed the acts for which G. was sued at law, and seeking a discovery from all of them in aid of the suit at law: *Held*, that G. could not, by demurrer, object to the bill as multifarious in respect to his co-defendants, especially as it appeared by the bill that they resided out of the jurisdiction of the Court.

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It seems, too, that the charge in the bill that the defendants committed the acts complained of as copartners, would be an answer to the objection of multifariousness, provided the bill contained other proper allegations connecting them with the object and purpose of the discovery prayed.

A defendant cannot be compelled to make discoveries in answer to a bill which seeks to enforce penalties and forfeitures against him by means of such discoveries.

Where a bill in Equity claimed a forfeiture of pieces of music under § 7 of the Act of February 3d, 1831, (4 *U. S. Stat. at Large*, 438,) and also sought a discovery from the defendants of the number of pieces printed by or for them, and of the number on hand: *Held*, that the bill was bad, on special demurrer.

If the forfeiture had been waived in the bill, the discovery might be compelled in aid of the recovery of damages in a suit at law.

And *it seems* that, on such discovery, Equity might compel the defendants to deliver up to the plaintiff the forfeited copies.

But the defendants cannot be directly required to convict themselves of the act which carries with it the forfeiture.

The objections which may be taken by general demurrer to a bill founded on a copyright, and seeking a discovery in regard to its infringement, in aid of a suit at law, are: (1.) That the plaintiff sets forth no title in himself to the subject-matter of the copyright; and (2.) That the bill lays no legal foundation for the discovery sought.

To constitute a person an *author* under the copyright Act of February 3d, 1831, (4 *U. S. Stat. at Large*, 436,) he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself.

He may arrange or compile a new production from materials before known, or obtained for him by the labors of others, but he cannot obtain a copyright for those materials in the same state in which they are furnished to him.

A person cannot appropriate as his own, by copyright, alterations and improvements made in a musical composition by others at his procurement and for him.

Where a bill in Equity contains allegations which constitute an assertion of authorship under the copyright Act in terms sufficiently explicit to constitute a perfect title at law in the plaintiff, the bill will be held good on *general demurrer*, notwithstanding the defectiveness and inconsistency of other allegations in the bill as to the authorship.

An action on the case is the proper form of remedy to recover damages for the violation of a copyright, and *trespass* will not lie for such violation.

To obtain a discovery in Equity in aid of a suit at law, the bill must show it to be necessary for the plaintiff, and that, when made, it can be used to his advantage.

Such a discovery will not be granted where it is sought in aid of an action of *trespass* for the violation of a copyright.

And a bill seeking such discovery will be held bad, on general demurrer.

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It seems, too, that such a bill is defective in substance, where it seeks a discovery from three defendants, and the action at law is against only one of them.

Where a bill in Equity against three defendants showed title in the plaintiff to a copyright, and a wrongful violation of it by all the defendants, and injuries inflicted and apprehended from such violation, and prayed for an injunction against all the defendants, and also for a discovery from all in aid of a suit at law against one for the same violation: *Held*, on general demurrer to the whole bill, that the relief by injunction was not dependent on the discovery prayed, and that, although the bill was bad as a bill of discovery, yet it was good as an injunction bill, and that the demurrer must be overruled.

A general demurrer to the whole bill must be overruled if any independent part of the bill is sufficient.

Nor will a formal protestation accompanying the demurrer avoid the force of the rule.

(Before NELSON and BETTS, JJ., Southern District of New York, December 2d, 1846.)

THE bill in this case was filed by the plaintiff against Edmund Ferrett, Timothy S. Arthur and Elijah B. Galusha, copartners in Philadelphia and New York, under the name of Ferrett & Co. It set forth that, in December, 1844, an opera was produced at the Park Theatre in New York, for the first time in America, entitled "The Bohemian Girl," the music of which was composed by one Balfe, in Europe; that, soon afterwards, the plaintiff undertook to adapt, arrange and publish such music, and, in doing so, gave to particular pieces of the music titles differing from those they bore as composed and represented in Europe and in New York, and made many alterations of and additions to said music, and arranged trios as duetts, and duetts as solos, and gave names to nameless waltzes and gallops; that six pieces of music in the opera, whose titles were given, were expressly adapted and arranged *for or by* the plaintiff for publication; that the whole of the music of the opera, as written and published in Europe and performed in New York, was adapted, arranged and published *by or for* the plaintiff, and, as adapted by him, was essentially different from the music as arranged and published in Europe and performed in New York; that, prior to the publication by him of the several

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pieces of music of the opera so arranged and adapted by or for him, and with such additional matter, new titles, and new names, the plaintiff caused a printed copy thereof to be deposited in the clerk's office of the District Court for the Southern District of New York, in which District he then resided, and obtained from said clerk's office a copy of the record of said titles, and caused a copy of such record to be inserted at full length upon the title-page or frontispiece of each of the copies of each of the editions of each piece of music, by causing to be printed, in a conspicuous place, on each piece, the following words: "Entered according to act of Congress, A. D. 1845, by J. F. Atwill, in the clerk's office of the Dist. Court of the Southern Dist. of New York;" that, within three months after the publication of the same a copy thereof was delivered to the Secretary of State of the United States, to be preserved according to law; and that thus the plaintiff secured a copyright for the said pieces of music, and for the titles of the same.

The bill then averred that the defendants had, without permission, sold at New York, to a considerable extent, copies of the several pieces of music so copyrighted, printed from and in exact imitation of the music as arranged and published by the plaintiff, and with the plaintiff's original matter introduced therein, and with his titles to some of them, and in violation of his copyright; that the defendants had on hand a large quantity of said infringing pieces of music; that the plaintiff had sustained damages to the amount of fifteen thousand dollars; that, in July, 1845, the plaintiff brought a suit at law in this Court against the defendant Galusha, (the only one of the partners residing in New York,) in a plea of *trespass* to recover damages for the said infringement, in which said Galusha was held to bail in \$5,000; that said suit was still pending, and the plaintiff intended to bring the same to trial, and expected to recover heavy damages therein; and that a discovery from Galusha and his partners was necessary in order to enable the plaintiff safely to try said cause.

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The bill then called on the defendants to answer the specific allegations contained in it, and also to discover how many of the infringing pieces of music they had sold, and how many they had on hand, and to set forth an account of their sales, with the rate at which each piece had been sold, and of the number of copies printed by or for them.

The prayer of the bill was, that all the infringing copies in the possession of the defendants, and the plates from which they were printed, might be delivered to the plaintiff; that the discovery prayed for, when made, might be used by the plaintiff as evidence on the trial of the action at law; and that the defendants might be enjoined from further infringements.

The defendant Galusha demurred to the bill on the grounds set forth in the opinion of the Court.

Randolph W. Townsend, for Galusha.

Marshall S. Bidwell, for the plaintiff.

BETTS, J. Three separate demurrers are filed to the bill in this case by the defendant Galusha. The other two defendants have not entered their appearance, and it does not appear that they have been served with the subpoena.

The defendant attempts to call in question distinct parts of the bill by severing his demurrers, and also takes objection to the whole by general demurrer. The special causes of demurrer are excepted to by the plaintiff as informal and insufficient, in not pointing out precisely the parts of the bill intended to be embraced by them. They adopt the general formulary, "that, as to so much of the bill as seeks," &c., without specifying, by paragraph, page, or folio, or other method of reference, where the objectionable matter is to be found. We think this mode of demurring to the statements of a long and involved bill is too obscure and indefinite to be admissible. (*Mitford's Pl.* 214; *Robinson v. Thompson*, 2 Ves. & B. 118; *Weatherhead v. Blackburn*, *Id.* 121.) The

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business of a special demurrer is to point out, by the clearest indications, the features alleged to be defective in the pleading, and to relieve the Court from the labor and delay incurred by repeated searches for the parts to which the demurrer may apply. (*Story's Eq. Pl.* §§ 457 to 459; *Devonsher v. Newenham*, 2 *Schoales & Lefroy*, 199.) In the present case the Court have abridged the bill paragraph by paragraph, and in that way have been enabled to select various statements which were undoubtedly intended to be embraced by the special demurrers; but we are not inclined to sanction so loose a mode of pleading. We, therefore, hold the special demurrers to be informal and insufficient, except in respect to the multifariousness of the bill, and to its demand of discoveries involving penalties and forfeitures against the defendant. In those particulars we think that the causes of demurrer assigned designate, with sufficient explicitness, the parts of the bill to which they are intended to apply.

(1.) The bill is objected to as multifarious by the defendant Galusha, on the ground that it makes charges against and exacts answers from his co-defendants in regard to matters involved in the suit at law commenced against him, which do not concern them, they not being parties to the suit at law. But the matters referred to concern him, and he cannot make the objection of irrelevancy in respect to his co-defendants, more especially as it appears, on the face of the bill, that they reside out of the jurisdiction of the Court. (*Story's Eq. Pl.* § 544, note 3.) Another feature of the bill might also probably rescue it from this objection, inasmuch as it charges the acts complained of to have been committed by the three defendants as partners and in their copartnership character, provided they are all connected by other proper allegations with the object and purpose of the discovery prayed for. (*Mitford's Pl.* 181, 183.) The demurrer for multifariousness is overruled.

(2.) It is an incontrovertible principle of Equity law, that a defendant cannot be compelled to make discoveries in answer to a bill which seeks to enforce penalties and forfeitures

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against him by means of such discoveries. (*Story's Eq. Pl.* § 521, note 3, and §§ 522, 575, 598; *Mitford's Pl.* 194 to 197.) In this case, the bill claims a forfeiture, under § 7 of the act of February 3d, 1831, (4 *U. S. Stat. at Large*, 438,) of the plates and pieces of music on hand. Had the forfeiture been waived by the plaintiff, the defendants might be compelled to disclose the number of their publications, the quantity on hand, and the amount realized from sales, in aid of the recovery of damages in a suit at law. So, probably, on such discovery, Equity might compel the defendants to deliver up to the plaintiffs the forfeited copies. But the bill is clearly faulty in directly requiring the defendants to convict themselves of the act which carries with it the forfeiture sued for.

The decision of these two points leaves untouched, however, the principal features of the bill which are supposed to be brought in question by the demurrers, and to the discussion of which the argument was mainly directed; and it, therefore, remains to be considered whether advantage can be taken of those matters by general demurrer.

The objections which may be taken on general demurrer are: 1. That the plaintiff sets forth no title in himself to the subject-matter of his alleged copyright; *and 2. That the bill lays no legal foundation for the discovery sought.

1. The insufficiency of the plaintiff's title on the face of the bill is claimed to be this—that he alleges the musical composition, or considerable portions of it, to have been arranged, adapted, printed, and published *by or for* him, instead of averring that it was composed *by* himself. The plaintiff, on the other hand, contends, that even admitting this to be so, his title is complete, upon the legal adage, *qui facit per alium facit per se*, and that he can appropriate as his own the alterations and improvements of the music made by others at his procurement and for him.

The act of Congress, (4 *U. S. Stat. at Large*, 436, § 1,) secures by copyright to any person who is *the author of any musical composition* the exclusive property in his composition

for a term of years. The statute contains a more detailed description of the subjects of copyright than is given in the English acts of 8 Anne and 54 Geo. 3, (*Godson on Pat. App.* 384 and 422;) but the construction given to those acts by the English Courts makes them include, under the name of *books*, pieces of music, &c. So that our system has no broader operation in this respect than the English, and, no doubt, a just construction of both statutes will render their provisions concurrent. The counsel for the plaintiff insists that the doctrine of the English law enables a man to secure to himself as his own composition whatever he has had prepared for him by the labors of others. We think, however, that the cases of *Tonson v. Walker*, (3 *Swanst.* 672, 680,) *Nicoll v. Stockdale*, (*Id.* 687,) *Cary v. Longman*, (3 *Esp.* 273, 274,) and *Mawman v. Tegg*, (2 *Russ.* 385), rest upon wholly different principles. They recognize the right of authorship, although the *materials* of the composition were procured by another, and also an equitable title in one person to the labors of another, when the relations of the parties are such that the former is entitled to an assignment of the production. But, to constitute one an author, he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself. (*Gray v. Russell*, 1 *Story*, 11.) And the rules of the common law and of Equity are the same upon this subject. (*Cary v. Longman*, 1 *East*, 358; *Sayre v. Moore*, *Id.* 361, *note*; *Jeremy's Eq.* 322.) The title to road-books, maps, &c., rests upon this principle, (2 *Story's Eq. Jur.* § 940;) and the cases cited by the plaintiff's counsel have relation to new productions arranged or compiled from materials before known, or obtained by others for the author, and not to the appropriation by copyright of those materials in the same state in which they are furnished.

If, therefore, the plaintiff's title rested only upon the allegation referred to, we should hold the bill to be defective on general demurrer. But we find repeated averments in the bill, to the effect that "he made many alterations of and additions to the said music"—that "he added new matters of his

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own, not in the original opera"—that he affixed a copy of the record on the title-page "of each piece of music composed, arranged and adapted by him for publication"—and that a copyright was taken out for such pieces "as arranged, adapted, and published by the plaintiff, with the new titles and original matter introduced therein by him," whereby he became entitled to vend the music "as arranged and adapted by him, and to the original matter introduced by him therein;" and the bill charges the defendants with having sold such music "printed from and in exact imitation of the music so arranged and adapted and published by the plaintiff, with the original matter introduced therein by him, and with his titles to some of such pieces of music." These allegations amount to an assertion of authorship in terms sufficiently explicit and full to constitute a perfect title at law, and, the facts being admitted by the demurrer, we must hold the right of the plaintiff established upon these averments, notwithstanding their defectiveness and their inconsistency with others contained in the bill. (*Mitford's Pl.* 212.) Such imperfect pleading is matter of form, and can be taken advantage of only by special demurrer. The general demurrer in this behalf must, therefore, be overruled. (*Verplank v. Caines*, 1 *Johns. Ch. R.* 57; *Higinbotham v. Burnet*, 5 *Id.* 184; *Kuypers v. The Reformed Dutch Church*, 6 *Paige*, 570.)

2. The discovery prayed for is to aid the plaintiff in his suit at law prosecuted against the defendant Galusha; and the averment in the bill is, that he has commenced an action of *trespass* against that defendant for the violation of his copyright. The demurrer raises the question whether the bill alleges such a suit at law as will afford foundation for the discovery sought, no relief consequent on the discovery being prayed for. It is clear that the plaintiff has adopted a form of action at law which cannot be supported. The English statute of 54 Geo. 3, § 2, gives specifically an action on the case as the remedy for the violation of a copyright. Our act (4 *U. S. Stat. at Large*, 438,) only indicates the form

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of action when a manuscript is published without the consent of the author, (§ 9,) or when a suit is brought to recover the pecuniary penalty given by the sixth section. On general principles of law, however, it is clear that *trespass* cannot be brought for an injury merely consequential in its character, unaccompanied by force as against the person or property, or by wrongful intermeddling with the possession of property. (1 *Chitty's Pl.* 126, 127.) The act of 8 Anne, ch. 19, did not designate the form of action, yet no doubt was ever expressed that *case* was the appropriate one. (*Beckford v. Hood*, 7 *T. R.* 616; *Cary v. Longman*, 1 *East*, 358; *Roworth v. Wilkes*, 1 *Campb.* 94.) To obtain a discovery in aid of a suit at law, the bill must show it to be necessary for the plaintiff, and that, when made, it can be used to his advantage. (*Jeremy's Eq.* 161; *Story's Eq. Pl.* §§ 319, 321.) It necessarily follows, from these principles, that a discovery will not be decreed in aid of an action at law, where it is manifest that the plaintiff cannot avail himself of it in the suit he is attempting to prosecute. It is, perhaps, also to be regarded as a substantive defect in the bill that it seeks a discovery from three defendants to aid a suit instituted against one alone. In so far, then, as the maintenance of the bill depends upon the plaintiff's right to a discovery, we think it defective in substance, and bad on general demurrer.

The bill, however, prays for an injunction, and, making title on its face in the plaintiff to the copyright set forth, and showing a wrongful and wilful violation of the copyright by the defendants, and serious injuries inflicted by and apprehended from such violation, it is sufficient in substance and form to entitle the plaintiff to an injunction. This relief is not dependent upon the discovery prayed, but rests on the equities set forth in the bill, and may be refused or granted, irrespective of the discovery. A general demurrer to the whole bill takes exception, therefore, to this branch of it, and the principle of Equity pleading is universal, that a general demurrer to the whole bill must be overruled if any independent part of the bill is sufficient. *Higinbotham v. Burnet*

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5 *Johns. Ch. R.* 184; *Kuypers v. The Reformed Dutch Church*, 6 *Paige*, 570; *Story's Eq. Pl.* § 443.) The formal protestation accompanying the demurrer is of no avail to protect it against this defect, as it cannot serve the purpose of a plea or answer, or form an excuse for not putting in the one or the other. (*Story's Eq. Pl.* §§ 452, 457, 458.) We think, therefore, that the general demurrer must be overruled on both points.

As faults in pleading have occurred on both sides, each party may amend without paying costs to the other.

BENJAMIN TATHAM, JR., AND OTHERS

vs.

ROBERT W. LOWBER AND OTHERS. IN EQUITY.

An American assignee of an alien inventor, who obtains Letters Patent in his own name from the United States, under § 6 of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 193,) is not within the alien clause of § 15 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) which requires the patentee, if an alien at the time the patent was granted, to put and continue on sale to the public, on reasonable terms, the invention for which the patent issued. That clause applies only to an alien patentee.

It is not necessary, under that clause, for an alien patentee to prove that he hawked the patented invention to obtain a market for it, or that he endeavored to sell it to any person.

But it rests on those who seek to defeat the patent, to prove that the patentee neglected or refused to sell the patented invention for reasonable prices when application was made to him to purchase.

(Before NELSON and BETTS, JJ., Southern District of New York, April 21st, 1847.)

THIS was an application for a provisional injunction to restrain the infringement of re-issued Letters Patent granted to the plaintiffs, March 14th, 1846, for fourteen years from August 31st, 1837, for "improvements in the machine for making or manufacturing pipes and tubes from lead, or other

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metallic substances." The invention was one made by John Hanson and Charles Hanson, of Huddersfield, England, and for which Letters Patent were granted to them in England dated August 31st, 1837. The original patent in the United States was issued on the 29th of March, 1841, to Benjamin Tatham, Jr., and Henry B. Tatham, two of the plaintiffs, as assignees of the Hansons. The other plaintiff, George N. Tatham, became interested in the patent before the re-issue. The plaintiffs were all citizens of the United States.

In opposition to the motion, it was attempted to be shown that application had been made to the plaintiffs to purchase an interest under their patent, but that they refused to sell, desiring themselves exclusively to manufacture lead pipe under their patent, and to control the business. It was insisted that the plaintiffs had thereby subjected themselves to the operation of the clause in § 15 of the Patent Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) which provides that a defendant, in an action on the case for an infringement of a patent, may, under a previous notice to that effect, show that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued, and that, in that case, judgment shall be rendered for the defendant, with costs.

The plaintiffs offered evidence to show that they had not neglected or refused to sell rights under their patent in a manner to bring themselves within the statute.

Seth P. Staples and *George C. Goddard*, for the plaintiffs.

Daniel Lord and *William Curtis Noyes*, for the defendants.

THE COURT held, that the plaintiffs, on the grant of the patent to them upon the assignment of the alien inventors, took and held it with all the privileges belonging to American patentees, and that the alien clause in § 15 of the Act of

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1836 applied only to alien patentees, and not to American patentees who became such as assignees of alien inventors under the sixth section of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 193;) that even if the plaintiffs took their right with the condition attached to alien patentees, yet they had satisfied the statute; that they need not prove that they hawked the patented improvement to obtain a market for it, or that they endeavored to sell it to any person; but that it rested upon those who sought to defeat the patent, to prove that the plaintiffs neglected or refused to sell the patented invention for reasonable prices when application was made to them to purchase.

AMANDA L. PONSFORD

vs.

WILLIAM JOHNSON, ADMINISTRATOR, &C., OF JAMES PONSFORD,
DECEASED, AND OTHERS. IN EQUITY.

As a general rule, the capacity or incapacity to marry depends on the law of the place where the marriage is contracted, and not on the place of the domicil of the parties.

Prior to 1826, P. was married in New York to H., who, in that year, obtained from the Court of Chancery of New York a decree of divorce on account of the adultery of P. The decree dissolved the marriage, and freed each of the parties from the obligations of the same. The Act under which the divorce was granted provided, that the party convicted of adultery should not marry again until the other should be actually dead. In 1837, while H. was still living, P. and A., both then residing in New York, were married to each other in New Jersey, in due form and according to the laws of that State. A. then knew nothing of the divorce or of H., and had only heard that P. had had a wife who was dead. A. was married in New Jersey in compliance with the wishes of P., and with no intention on her part of evading any law of New York. P. died in 1845, intestate, domiciled at the time in New York. Under the laws of New York, A., if his widow, was entitled to a share of his personal estate. The defendant J. obtained administration in New York on P.'s estate, and received assets to a large amount, but refused to pay any portion of them to A. A bill filed by A. to compel such

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payment, having been demurred to on the ground that the marriage between P. and A. was void: *Held*, that the decree of divorce was an absolute dissolution of the marriage contract as to both parties; that the disability to marry imposed by the statute of New York attached to P., by way of penalty, only within that State; that the marriage between A. and P. in New Jersey was valid; that A. was entitled to all the rights of the lawful widow of P. under the laws of New York; and that J. was bound to pay over to her her share of P.'s estate.

Semble, that the validity of the New Jersey marriage would not have been affected if both parties had resorted to that State to evade the prohibitory law of New York. And clearly, where one party was innocent and ignorant of such purpose, the *mala fides* of the other could not impeach the marriage, if it was lawful in other respects.

(Before NELSON and BETTS, JJ., Southern District of New York, July 2d, 1847.)

THE plaintiff in this case, a citizen of New Jersey, filed her bill against William Johnson and others, citizens of New York. She claimed to be the widow of James Ponsford, deceased, the defendant Johnson was his administrator, and the other defendants were his next of kin. The facts were these: Some time prior to 1826, James Ponsford was married in New York to one Hannah Stanton, who, in that year, obtained from the Court of Chancery of the State of New York a decree of divorce on account of the adultery of Ponsford. He appeared in the suit brought by her, and the Court had full jurisdiction, both of the subject-matter and of the parties. The decree of divorce was, that the marriage between the parties "be and the same is hereby dissolved, and that each of the said parties be freed from the obligations of the same, according to the provisions of the Act of the Legislature of the State of New York in such case made and provided." The Act under which the divorce was decreed was entitled, "An Act concerning divorces and for other purposes," passed April 13th, 1813. The 4th section of the Act was the only one particularly involved, and was as follows: "If it shall satisfactorily appear to the Court of Chancery that the defendant has been guilty of the adultery charged in the bill, it shall be lawful for the said Court to decree that the marriage between the parties shall be dissolved, and each party freed from the obligations thereof,

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but such dissolution shall not in any wise affect the legitimacy of the children thereof. And it shall be lawful for the complainant, after such dissolution of the marriage, to marry again, as though the defendant was actually dead. But it shall not be lawful for the defendant, who may be so convicted of adultery, to marry again until the complainant shall be actually dead." (2 R. L. 198, § 4.)

In September, 1837, the plaintiff and James Ponsford were married to each other, both then residing in New York. The marriage, however, took place in due form in New Jersey, in conformity to the laws of that State. From the time of this marriage until the death of Ponsford, he and the plaintiff lived together as husband and wife. The plaintiff, at the time of the marriage, knew nothing of said decree of divorce, or of the suit in which it was obtained. She had heard that Ponsford had been married, but was informed by him, prior to her marriage, that his former wife had been dead for many years. When Ponsford proposed to the plaintiff to go to New Jersey to be married, he assigned to her as a reason that he did not wish his friends to know of his marriage, and she was married in New Jersey in compliance with his wishes, and not with any intention on her part of evading or defeating any of the laws of New York. The plaintiff, at the time of her own marriage, was not acquainted with Hannah Ponsford or her family, or with James Ponsford's family, and heard nothing of Hannah or of her said marriage, (except as before stated,) until some time after her own marriage. Hannah was still living when this bill was filed.

James Ponsford died in June, 1845, intestate, leaving no descendant or parent, but leaving the plaintiff, his widow, and a sister, and nephews and nieces, children of deceased brothers and sisters, as his next of kin. In July, 1845, the defendant Johnson, who was the husband of one of the nieces, obtained letters of administration on Ponsford's estate from the Surrogate of the city of New York, where Ponsford left property, and received assets to the amount of

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over \$32,000. By the laws of New York, where Ponsford was domiciled at the time of his death, the plaintiff, as his widow, would be entitled to one-half of his personal estate after the payment of his debts, to the whole of the residue if under \$2,000, and, if the residue exceeded \$2,000, then to \$2,000 in addition to the one-half. The bill averred that Johnson would not pay the plaintiff any portion of the estate of Ponsford, but was about to pay it to the next of kin, and refused to recognize the plaintiff as the widow of Ponsford, pretending that she was never lawfully married to him, and that they could not and did not make a lawful contract of marriage in New Jersey. The bill prayed an account by Johnson, the payment to the plaintiff of her share of the estate, and an injunction.

The defendants demurred to the bill, assigning for cause that the plaintiff founded her claim on a pretended marriage between her and Ponsford, contracted while his wife Hannah was in full life, and while Ponsford had no capacity, by the laws of New York, where he was then domiciled and resident, to contract any such marriage during the life of Hannah.

Royal H. Waller, for the defendants. 1. The dissolution of the marriage of Ponsford, by the decree of divorce under the Statute of New York, was not operative as to him. His subsequent marriage with the plaintiff was, therefore, void. 2. The marriage domicile in this case was not New Jersey, where the marriage ceremony was performed, but New York, where the parties intended to reside. The contract of marriage was, in the eye of the law, made in New York. 3. But, if made in New Jersey, it was a nullity, having been made in fraud and evasion of the law of New York. (*Story's Conf. of Laws*, §§ 86, 123; *Jackson v. Jackson*, 1 Johns. 424; *West Cambridge v. Lexington*, 1 Pick. 506.) 4. The plaintiff makes her claim in this case under the New York statute of distributions. (2 R. S. 96, § 75, *subd.* 3.) The question of the distribution, and consequently the question whether

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she is the widow of Ponsford, must be governed by the local law of New York. (*Story's Confl. of Laws*, §§ 380, 481, 482 a.) She cannot claim in violation of the marriage laws of the place of distribution. (*Haydon v. Gould*, 1 Salk. 119; *Hubback's Ev. of Succession*, 309, 310; *Story's Confl. of Laws*, §§ 18, 51, 54, 65; *Doe v. Vardill*, 5 B. & C. 438; *S. C. 9 Bligh*, 32; *Shelf. on Marr. & Div.* 126, 128.)

William Bliss, for the plaintiff. The divorce was an entire dissolution and extinction of the former marriage, as to both parties. The restriction imposed by the statute on Ponsford against his marrying again until Hannah should be actually dead, created a mere personal disability. The statute was designed to act on a second marriage by a defendant convicted of adultery, only when such marriage should be contracted in New York. The 4th section of the Act concerning divorces, construed in connection with the Act of February 7th, 1788, (1 R. L. 113,) could operate on such second marriage only by way of punishment of the defendant, if he should enter into it. Being thus a penal statute, it only prohibited the re-marriage if it took place in New York.

George Wood, on the same side. Is the plaintiff's marriage to be regarded in New York as a valid marriage? For, if not, she cannot claim as the widow of Ponsford. 1. The validity of the marriage is to be determined by the law of the place where it was contracted. (*Hubback's Ev. of Succession*, 330, 331; *Dalrymple v. Dalrymple*, 1 Hagg. C. R. 59.) 2. Ponsford was entirely divorced by the decree from his former marriage. The decree and the statute, (§ 4,) both of them declare the divorce to be perfect and entire. The same statute, (2 R. L. 199, § 7,) gives to the husband, where he is complainant and obtains a divorce for the adultery of his wife, the same rights in the wife's real and personal property "in like manner as though the marriage had continued," thus implying that the marriage is dissolved by a decree of divorce for adultery. The only cases where the *lex*

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loci contractus has not seemed to prevail on the question of the validity of a second marriage after a divorce, is where the first marriage was not completely dissolved by the divorce. (*Shelf. on Marr. & Div.* 128; *Beazley v. Beazley*, 3 *Hagg. Ecc. R.* 639.)

Marriage is a social relation, governed in part by the principles which govern contracts merely civil, but yet going further, and calling in other principles to regulate and determine its character. In this aspect, the law of marriage is a branch of the *jus gentium*. The present case must be considered by the rules of that law.

The objections to the validity of the plaintiff's marriage are: (1.) That the parties were bound to marry according to the law of New York; (2.) That the personal disability on Ponsford followed him into New Jersey.

(1.) The *lex loci actus* governs as to the validity of the marriage. (*Story's Conf. of Laws*, §§ 79, 81, 82, 86, 87, 89; *Shelf. on Marr. & Div.* 123; *Hubback's Ev. of Succession*, 330, 331, and *authorities there collected*.) To this rule the only exception is, where the marriage violates principles of natural morality. (*Id.* 332, 333.) The American doctrine is, that if a person, divorced from his first wife, is rendered by the law of the place of the divorce incapable of contracting a second marriage, still, if he contracts marriage in another State, where the same disability does not exist, the marriage is valid; and this, although the marriage was celebrated in the foreign State in order to evade the law of the place of domicil. (*Story's Conf. of Laws*, §§ 89, 123, 123a, 123b; 2 *Kent's Comm.* 91 to 93, 3d edit.; *Id.* 458, 459; *Putnam v. Putnam*, 8 *Pick.* 433; *West Cambridge v. Lexington*, 1 *Pick.* 506; *De Couche v. Savetier*, 3 *Johns. Ch. R.* 190.) If, however, the evasion can in any event affect the validity of the marriage, both parties must concur in the evasion. The evasion, if the cause of the invalidity, must be determined by inquiring into the motives of the parties. It is not an intrinsic but an extrinsic cause. In this case, the plaintiff did not concur in the evasion.

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(2.) The personal disability of Ponsford did not prevent his marrying in New Jersey. It was a mere personal disability. If a penalty, the penal laws of one country cannot be taken notice of in another. They are strictly local. Thus, a criminal sentence of attainder in the Courts of one sovereign, although it creates a personal disability to sue there, does not carry the same disability with the person into other countries; and a person convicted of an infamous offence in one State is not thereby rendered incompetent as a witness in other States. (*Story's Conf. of Laws*, §§ 620, 621.)

Daniel Lord, for the defendants, in reply. The question involved in this case is one not covered by any decision in the United States, except the case of *Putnam v. Putnam*, (8 *Pick.* 443,) cited for the plaintiff, which is of no weight. If the doctrine of that case be sound, a man may have an unlimited number of wives.

1. Ponsford's first marriage was lawful and created an incapacity in him to marry again while it continued. The divorce under the New York statute, (2 *R. L.* 198, § 4,) did not relieve Ponsford from this incapacity. The marriage was not dissolved for all purposes. It was only dissolved so far as Hannah was concerned, and the statute expressly empowered her to marry again, which she could not otherwise have done. The decree of divorce released the civil obligations of the parties to the first marriage, but it only released the civil incapacity of Hannah. The policy of the statute was to extinguish the force of the first marriage only as to the aggrieved party. The statute (§ 4) imposed no disability on Ponsford, but merely left him where it found him, laboring under the disability created by his first marriage. In this view, the provision was not penal. The second marriage took place while the following provision of the Revised Statutes of New York was in force: "No second or other subsequent marriage shall be contracted by any person during the lifetime of any former husband or wife of such person, unless the marriage with such former husband or wife shall

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have been annulled or dissolved for some cause other than the adultery of such person. Every marriage contracted in violation of the provisions of this section shall be absolutely void." (2 R. S. 139, § 5.) This provision is not limited to the State of New York. The language is positive and universal, and applies to all marriages, wherever contracted.

2. The plaintiff cannot set up a claim under the New York statute of distributions, and at the same time set up a right under the decree of divorce in this case as the foundation of that claim. The evasion of the law of New York by the husband was direct and intentional, and the marriage was as much a violation by both the parties of the policy of that law as if the contract had been made in New York.

The *lex loci actus* is invoked as governing in the case. But the plaintiff's right to her distributive share, as the widow of Ponsford, is the creation of positive law, and is not in the nature of a contract. That right accrues to her, if at all, merely as an incident of her marriage. And, if the marriage was void, of course no incident could follow from it. The plaintiff is claiming rights that follow from a New York domicile, against the law of that domicile. In *Haydon v. Gould*, (1 Salk. 119, cited in *Hubback's Ev. of Succession*, 309,) it was decided, that where the husband demanded a right to himself as husband under the ecclesiastical law, he ought to prove himself a husband by that law.

BETTS, J. This case has been carefully considered by the Court, and we are prepared to pronounce judgment in it. The urgency of other engagements since the argument has not allowed us time to draw up at length the reasons in support of the decision. The Court is about to adjourn, and the judges cannot have opportunity for further conference previous to November; and, if we defer the decision to that period, a year's delay to the parties may be caused, should an appeal be taken. We shall therefore order judgment to be entered for the plaintiff on the demurrer, only indicating the general grounds upon which the decision is placed.

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1. We consider that, as a general principle, the capacity or incapacity to marry depends on the law of the place where the marriage is contracted, and not on that of the domicile of the parties. This principle need not be asserted as absolute in all cases. Incest, polygamy, and practices outraging the moral sense and the usages of civilized nations, may be excepted from the rule, without impairing its justness and efficacy.

2. We regard the decree of divorce pronounced by the Court of Chancery of the State of New York to be, in its purport and by force of the statute of the State, an absolute dissolution of the marriage contract as to both parties, and that the disqualification or disability to marry declared by the statute, attached to Ponsford, by way of penalty, only within the State of New York, and did not incapacitate him from contracting a sound and valid marriage in the State of New Jersey, where the same disability did not exist.

3. We think that the validity of the marriage in New Jersey would not have been affected if both parties had resorted there to evade the prohibitory law of New York. And clearly, where one party was innocent and ignorant of such purpose, the *mala fides* of the other could not impeach the marriage, if it was lawful in all other respects.

Judgment for the plaintiff.

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THE UNITED STATES vs. RAPHAEL SCHOYER.

An indictment for forgery under § 19 of the Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 120,) in altering a certificate issued under § 41 of the Act of March 3d, 1799, (1 *U. S. Stat. at Large*, 659,) alleging that the certificate was issued by the collector *ex officio*, is bad on demurrer.

By the Act of 1799, the certificate was to be issued by the *supervisor* of the revenue, and the indictment ought to allege that the collector was designated

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by the President to fulfil the duties of supervisor, under the Act of March 3d, 1803, (2 *U. S. Stat. at Large*, 243,) and that the certificate was granted by the collector in that capacity.

(Before NELSON and BETTS, JJ., Southern District of New York, November 12th, 1847.)

INDICTMENT for forgery. The 41st section of the revenue Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 659,) provides that, in addition to a general certificate to be given to an importer of spirits, wines or teas, the surveyor or chief officer of inspection shall give to him a *particular certificate*, which shall accompany each cask, chest, &c., wherever the same may be sent within the limits of the United States, as evidence that the same was lawfully imported, and gives the form of such certificate. The 42d section of the same act (*Id.* 660) provides, that "the *supervisors* of the several districts shall provide blank certificates, under such checks and devices as shall be prescribed by the proper officers of the treasury, and shall number, sign and deliver the same to the officers who may perform the duties of inspectors of the revenue for the several ports in their respective districts; which blank certificates shall be filled up and countersigned by the inspectors of the revenue aforesaid, who shall be accountable therefor to the supervisors; and the said inspectors shall make regular and exact entries of all certificates which shall be granted as aforesaid, as particularly as therein described." The 44th section of the same act, (*Id.* 660,) provides, that every person who shall obliterate, counterfeit, alter or deface any of such certificates, shall, for each and every such offence, forfeit and pay one hundred dollars, with costs of suit. By the Act of March 3d, 1803, (2 *U. S. Stat. at Large*, 243,) it is provided, that the President may attach the duties of the office of *supervisor*, in any district, to any other officer of the Government of the United States within such district. By the 19th section of the Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 120,) it is provided, that any person who shall falsely make, forge or counterfeit, or shall falsely alter, any instrument in imitation of or purporting to be a permit, debenture or other official document,

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granted by any collector or other officer of the customs by virtue of his office, or shall knowingly pass or attempt to pass as true any such counterfeited instrument or any such falsely altered certificate, with intent to defraud, shall be deemed guilty of felony.

The defendant was indicted, under the Act of 1825, for forgery, in altering *a particular certificate* issued under the Act of 1799. The indictment alleged the certificate in question to have been issued by the collector of the port of New York, *by virtue of his office*. The defendant demurred to the indictment.

James R. Whiting, for the defendant.

Francis F. Marbury, for the United States.

BERRS, J. The instrument charged to have been forged was one which the supervisor of the revenue was authorized to issue by the Act of 1799. The Act of 1803 authorized the President to designate any other officer to fulfil the duties of supervisor. The indictment alleges that the collector issued the certificate *ex officio*. But no Act of Congress is shown, making him, as collector, supervisor also. If, from the fact of the collector's acting in the capacity of supervisor, it is to be presumed that he was designated, under the Act of 1803, to perform the duties of that office, the indictment is still bad, in averring that he issued the certificate *ex officio*. It should have averred his substitution in place of the supervisor, and the granting of the certificate by him in that capacity.

Judgment for the defendant.

Waldron v. Chastaney.

BENJAMIN WALDRON AND SALLY ANN HIS WIFE AND JOHN L.
WILSON

vs.

EDWARD CHASTENEY.

E. made his will in 1819, devising real estate to R. his wife, for life, or during her widowhood, for the support of herself, her three daughters, and one P.; and, on the death or re-marriage of R., the estate was devised to P. for his life, for the support of himself and the daughters; and, after the death or re-marriage of R. and the death of P., the estate was devised to the three daughters in fee. The will gave power to R., so long as she should remain single, and to P. after her death or marriage, to sell and convey the real estate, *provided that B. should in writing, signed with his hand, approve and consent to such sale*, without which approbation and consent no such sale should be valid. The moneys arising from the sale were directed to be invested in such manner as B. should direct, for the purposes of the will. R. was appointed executrix: *Held*, that R. had only a naked power in respect to the disposition of the estate, and that the power could be rightfully exercised only by a sale of the estate in fee.

The testator having died, and the will having been proved, R., in 1825, leased the real estate, as executrix and trustee, to N., setting forth the will at large in the lease, for 21 years, the lessee to pay to R., her heirs and assigns, yearly during the term, if she should so long live and remain the widow of E., and, after her death or marriage, during the residue of the term then unexpired, unto P., a certain rent: *Held*, that the lease, as a conveyance under the power of sale in the will, was void, as not fulfilling the intent of the testator, and not a sale of the estate for cash, or something which could be invested as its representative.

But *held, also*, that R., having an absolute estate for her widowhood, could lease that, independently of the power of sale, and that the lease given was good for the interest she had, and only void for any surplus of the term unexpired at her decease.

R. having, in 1827, sold and conveyed the same real estate in fee to H., the conveyance purporting to be made by her as executrix and trustee under the will and in pursuance of the power of sale: *Held*, that the lease to N. was no impediment to the exercise of the power of sale.

In ejectment brought by the remainder-men under the will, to recover the real estate, after the death of R. and P.: *Held*, that questions touching the discreet exercise of the power of sale belonged to a Court of Equity, and that the deed to H., if valid on its face, must operate as such at law.

The approbation and consent of B. to the deed to H. were given by his writing

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at the foot of the deed, and directly following the signature of R. : "I consent to the above," and subscribing his name thereto : *Held*, that the requirement of the proviso in the power of sale was thereby satisfied, and that the consent of B. imported his *approbation*.

(Before NELSON and BETTS, JJ., Southern District of New York, November 16th, 1847.)

EJECTMENT for premises in the city of New York. Medceef Eden, the younger, made his will in July, 1819, devising all his real and personal estate to Rachel his wife, for life, or *durante viduitate*, for the maintenance and support of herself, her daughters Sally Ann, (one of the plaintiffs,) Elizabeth, and Rebecca, and also of John Pelletreau ; and, on the death or re-marriage of his wife, he devised said estates to Pelletreau, during his natural life, for the support of himself and the three daughters ; and, after the death or re-marriage of his wife, and the death of Pelletreau, he devised all his said landed estates to Sally Ann, Elizabeth and Rebecca, in fee. The will then proceeded : "I give to my wife, so long as she shall remain single, and to the said John Pelletreau, after her death or marriage, full power and authority to sell and convey all or any part of my real estate, provided that the said Aaron Burr shall in writing, signed with his hand, approve and consent to such sale ; but no such sale shall be valid without such approbation and consent." The moneys arising from such sale were directed to be invested in such manner as Burr should direct, for the purposes of the will. He appointed his wife executrix so long as she remained single and unmarried, and declared that, after she should die or be married, Pelletreau should be his executor.

On the 1st of January, 1825, the testator having died, and his will having been duly proved, Rachel Eden executed a lease of the premises in question, which were a part of those devised by the will of her husband, to one Norsworthy. The lease purported to be executed by her as executrix and trustee, and set forth the will at large. The *habendum* clause of the lease was : "To have and to hold the premises, from the 1st day of January, 1825, for and during the full

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end and term of twenty-one years thence next ensuing, yielding and paying to the said Rachel Eden, her heirs and assigns, yearly and every year during the said term of twenty-one years, if she shall so long live and remain the widow of the said Medcef Eden, and, from and after her death or marriage, yielding and paying, for and during the residue of the said term which may be then unexpired, unto the said John Pelletreau, the yearly rent," &c.

On the 29th of January, 1827, Rachel Eden sold and conveyed the same premises in fee to Halsey Rogers. The conveyance purported to be made by her as executrix and trustee under the will, and in pursuance of the power of sale contained therein. The approbation and consent of Burr to this sale was given by his writing, at the foot of the deed, and directly following the signature of Rachel: "I consent to the above," and subscribing his name thereto.

Rachel Eden died in 1830, and Pelletreau in 1833. Elizabeth died in 1832, intestate and without issue. The plaintiff Waldron was the husband of the plaintiff Sally Ann. The plaintiff Wilson represented the interest of Rebecca. The defendant set up the lease to Norsworthy, and the deed to Halsey. At the trial a verdict was taken subject to the opinion of the Court, on a case to be made.

Ambrose L. Jordan, for the plaintiffs.

George Wood and *Daniel Lord*, for the defendant.

BETTS, J. The points considered and decided by the Court are: (1.) The due execution of the power under the will, in the conveyance of the premises in question in fee to Halsey Rogers, on the 29th of January, 1827; (2.) The sufficiency of the endorsement made by Col. Burr on the deed to Rogers, as a compliance with the directions of the will.

(1.) We regard it as settled, by the Courts of this State, on the effect of the will of Medcef Eden, that Rachel Eden had only a naked power in respect to the disposition of the estate,

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and that the power could be rightfully exercised only by a sale of the estate in fee. (*Waldron v. McComb*, 1 *Hill*, 111; *McComb v. Waldron*, in error, 7 *Hill*, 335; *Bloomer v. Waldron*, 3 *Hill*, 361.) If the demise to Norsworthy, on the 1st of January, 1825, was intended as a conveyance under the power in the will, it would be void, as not fulfilling the declared intent of the testator, because not a sale of the estate for cash, or something which could be invested as its representative. (*Bloomer v. Waldron*, 3 *Hill*, 361.) But Rachel Eden, having an absolute estate for her widowhood, could lease that, independently of the power of sale; and, whether she demised it in gross by a description appropriate to her special interest, or conveyed it for a term of years which might outrun the duration of her interest, the demise would be good for the interest she had, and only void for any surplus of the term unexpired at her decease. (*Bacon's Ab. Leases*, I. 2; 4 *Com. Dig. Day's Ed.* 63, note s; *Sinclair v. Jackson*, 8 *Cowen*, 543; *Clarke's Lessee v. Courtney*, 5 *Peters*, 319.) The lease purports to be executed by her, as executrix and trustee, but it also sets forth at large the will by which her personal interest is created, and the conveyance will, upon settled principles of law, be supported to the extent of her authority to make it as donee of the estate. (*Sugden on Powers*, 298.) She being tenant for life, unless she should re-marry, the demise was good for the amount of her interest, and she would never have been allowed to reclaim the premises from the lessee during her life, or before the expiration of the twenty-one years, on the allegation that she had no rightful power, as executrix and trustee, to execute a lease, even though it had been executed by her with a formal declaration that she acted solely under the power of sale in the will. But the lease, though inartificially drawn, in no way limits the grant to the power of sale. On the contrary, it indicates, with a distinctness that can leave no doubt, an intention to grant the interest of the lessor, as well as to exercise a supposed power to convey a term beyond that. There was clearly nothing in the power of sale in the will which author-

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ized the limitations as to rent contained in the lease, and, as those limitations are in consonance with the actual interest of Rachel Eden and Pelletreau, the instrument would naturally be construed so that the grantee might be assured of all the interest the widow had in her own right, and so as to correspond with honest and fair dealing on her part. These considerations show that the lease, operating only to convey the vested interest of the lessor during her widowhood, created no impediment to the exercise of her power of sale; and that the sale in fee, on the 29th of January, 1827, to Rogers, became valid and effectual, if so executed in point of form as to give it operation under the will.

It is contended that the outstanding term of years granted by the trustee to Norsworthy was injurious to the devisees, in preventing a sale for the full value of their interests, and also that the sale to Rogers was in fact for an inadequate consideration. Questions touching the discreet and beneficial exercise of the power of sale belong to a Court of Chancery, and not to one of law. The devisees might, by bill, have had relief against the trustee, if she executed her trust improvidently and to their prejudice, and against the purchaser, also, if he knowingly induced such act and colluded with her in its commission. (*Franchot v. Leach*, 5 Cow. 506; *Champion v. White*, Id. 510; *Jackson v. Hills*, 8 Id. 290, 293; *Taylor v. King*, 6 Munf. 358.) But, upon its face, the conveyance to Rogers is valid, in so far as Mrs. Eden's capacity to execute it is concerned, and must so operate at law against the remainder-men, unless its execution was defective for want of compliance in form with the directions of the will.

(2.) The power to sell is given by the will, with a proviso, "that Aaron Burr shall, in writing, signed with his hand, approve and consent to such sale, but no sale shall be valid without such approbation and consent."

The argument for the defendant concedes, as broadly as the plaintiffs contend, that this power must be strictly pursued, so far as it is directory as to persons, time and mode of

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execution. It is needless to rehearse the authorities for this doctrine, which is fundamental on this point. There can be no question that the deed by the trustee was inoperative and void, unless Aaron Burr, in writing, signed with his hand, approved and consented to the sale. His consent and approbation in writing was made a vital part of the power. No form or method of conveyance could be devised omitting such consent, which would satisfy the special qualification of the power. No consent or approbation could be given by Col. Burr which would render the deed efficacious, except in the specific mode pointed out by the will. (*Sugden on Powers*, 264; *Hawkins v. Kemp*, 3 *East*, 410; *Taylor v. Horde*, 1 *Burr*. 60, 120; *Daly v. James*, 8 *Wheat*. 495; *Clarke's Lessee v. Courtney*, 5 *Peters*, 319, 349, 350; *Sinclair v. Jackson*, 8 *Cow*. 543.) It is, perhaps, not going too far to say, that the cases at law demand a precise and literal exercise of the power, to satisfy the rule. (*Daly v. James*, 8 *Wheat*. 495, 535; *Hawkins v. Kemp*, 3 *East*, 410; *Sugden on Powers*, 210, 212.)

Whenever a particular form is prescribed, no other may be adopted as equivalent to it, and the only question here is, whether the will has declared the formula with which the consent and approbation of Col. Burr shall be expressed. The manner must be in writing, and the writing must be signed by him. Both of these particulars have been fulfilled in this case, and we think that these are the only directions in the will which need be literally and exactly complied with. The conveyance is perfect in all its formalities when so framed, and, if the writing, so signed, expresses the consent and approbation of Col. Burr to the sale, there is no limitation to the use of those precise words in order to convey the consent. The will manifestly shows that the testator intended to secure the concurrence of Col. Burr to the conveyance and the investment of the proceeds, and it defines the manner in which his concurrence shall be communicated. This, however, does not necessarily import that the consent and approbation itself—the assent of Col. Burr's mind—must

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be shown by the employment of those very expressions. Otherwise, any departure from those identical words would vacate the deed, although the consent and approbation of Col. Burr were expressed with a fulness and certainty beyond all question. Suppose Col. Burr had written and subscribed a declaration on the deed, that he well knew its terms and purpose and had advised the sale, and that it met his fullest concurrence, and was in all respects satisfactory to him—could any Court deny that this was consent and approbation on his part? We are satisfied that no more is requisite on this point, than for the grantee to show that the writing signed by Col. Burr does give his consent and approbation to the sale, and that the omission to employ that precise phraseology is not decisive of the inquiry.

At the foot of the deed, and directly following the signature of the trustee, Col. Burr wrote: "I consent to the above," and subscribed his name to it. We think that *consent* in this connection involves *approbation* also, even if the two expressions are not of equal and common value. Indeed, if any distinction can be made in the import and force of the words, it would appear that the testator used *consent* as the most significant and effective. If, as the Supreme Court intimate in *Clarke's Lessee v. Courtney*, (5 *Peters*, 319, 350,) over-niceties and refinements are not to be disregarded in construing powers to sell and convey lands, certainly no more extreme rigor of construction will be applied to defeat a *bonâ-fide* attempt to execute a power, than to uphold it. In both cases, the intention of the party creating the power is to control its construction, and the substantial fulfilment of that intention is all that will be required. (*Wilson v. Troup*, 7 *Johns. Ch. R.* 25, 33; *Pomery v. Partington*, 3 *T. R.* 665; *Griffith v. Harrison*, 4 *Id.* 737, 743, 748, 749.) In view of these principles, whatever stress of interpretation is applied to *approve*, no sound and satisfactory distinction can be stated carrying its meaning beyond that of *consent*. Especially, as the words are used in the will—"approve and consent to such sale"—*consent to* is grammatically, if not in-

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trinsically, the positive and operative phrase. For, *approve* can have no sense, as it is placed in the clause, without the transposition of *such sale* or of *approve* itself, so as to bring the three words in direct connection. As it stands, and literally construed, *approve* is valueless, having no grammatical connection with *sale*. Although the Court, in effectuating the intent of the testator, and looking to the substance of the power, would certainly not suffer a fault in syntax to work its destruction, yet, upon a nice point of synonymy or tautology, the criticism made may not be without influence in indicating whether the intent and direction of the testator are not wholly conveyed by the word *consent*. Aside from such hypercriticism, we think that the written *consent* of Col. Burr to the sale necessarily imports his *approbation*, and that the requirements of the power are thereby satisfied. We do not perceive that any further significance would be afforded by using both words. No import or effect is pointed out as legally applicable to both terms, which *consent*, as employed, does not of itself express. We are to assume that the trustee and Col. Burr acted in good faith towards the grantee, and intended that the deed should be executed conformably to the power, and the *consent* of Col. Burr to the sale and conveyance for that purpose must be regarded as involving his *approbation* of both.

Judgment for the defendant.

 BLANCHARD'S GUN-STOCK TURNING FACTORY vs. LABAN JACOBS.

The rule that the verdict of a jury will not be set aside where evidence was given on both sides, and there was no misdirection as to the law, is applicable to an action on the case for the infringement of a patent.

Where, in such an action, it was submitted to the jury, as a question of fact, whether the defendant was concerned in using the infringing machine, or was merely a purchaser of the articles manufactured by it, and the jury, having been instructed that the defendant was not liable if he was only the

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purchaser of the articles after they were manufactured, found for the plaintiff: Held that, as there was evidence on both sides of the question, and the verdict was not clearly against the weight of evidence, it must stand.

(Before NELSON and BETTS, JJ., Southern District of New York, November 16th, 1847.)

THIS was an action on the case for the infringement of Letters Patent, granted to Thomas Blanchard for "a machine for turning and cutting irregular forms." (See *Blanchard's Gun-Stock Turning Factory v. Warner*, 1 *Blatchf. C. C. R.* 258.) The alleged infringement consisted in the use of the patented improvements in the manufacture of handles for hatchets. At the trial the plaintiffs had a verdict, and the defendant now moved for a new trial, on a case. The points raised sufficiently appear from the opinion of the Court.

W. R. Allen, for the defendant.

Seth P. Staples, for the plaintiffs.

BETTS, J. The defendant moves to set aside the verdict rendered against him, as being without evidence to support it. It appears that one Pike, a sub-tenant of the defendant, had used a machine for turning hatchet-handles, which was a violation of the Blanchard patent. The handles were manufactured for the defendant. Pike had come to the place at the instance of the defendant, and there was evidence of a relationship by marriage between them. The defendant gave evidence for the purpose of showing that he purchased the hatchet-handles from Pike at fixed prices, and that he had no other connection with the manufacture than as a contract purchaser. The plaintiffs gave other evidence, conducing to show a concert between the defendant and Pike in the manufacture, and that it was under their mutual charge. The Court instructed the jury that the action could not be maintained against the defendant, if he was no more than the purchaser of the articles after they

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had been manufactured by Pike, but that it was a question of fact for them to find from the evidence, whether or not the defendant was concerned with Pike in using the machine. There was testimony tending to show a common coöperation in working the machine and infringing the patent, and it belonged to the jury to determine the credibility and weight of that evidence. The rule laid down in *Ward v. Center*, (3 *Johns.* 271,) that the verdict of a jury will not be set aside where there has been evidence on both sides of a question of fraud, and no misdirection as to the law, is applied with like strictness to all cases of tort. (*Jarvis v. Hatheway*, 3 *Johns.* 180.)

A new trial will not be granted in any case unless the verdict is clearly without evidence or against the weight of evidence. (*Brown v. Wilde*, 12 *Johns.* 454; *Trowbridge v. Baker*, 1 *Cow.* 251; *Lewis v. Payn*, 4 *Wend.* 423; *Smith v. Hicks*, 5 *Id.* 48; *Alsop v. The Commercial Ins. Co.*, 1 *Sumn.* 451.) Nor for the purpose of introducing new evidence to points before in controversy. (*Williams v. Baldwin*, 18 *Johns.* 489; *Douglass v. Tousey*, 2 *Wend.* 352; *Chatfield v. Lathrop*, 6 *Pick.* 417.) The evidence to support the action in this case was not very full or direct, and the circumstances were not in their character decisive against the defendant, but they all had a legal bearing upon the issue. The testimony offered by the defendant in his exoneration was met by counteracting facts, and we think the jury were well warranted in drawing, from the whole evidence considered together, the conclusion which they adopted.

New trial denied.

Parkhurst v. Kinsman.

STEPHEN R. PARKHURST

vs.

ISRAEL KINSMAN AND JAMES W. HALE. IN EQUITY.

Under Rule 57 in Equity, requiring notice to be given on an application for leave to file a supplemental bill, it is not necessary that the petition for leave should embrace the averments intended to be inserted in the supplemental bill, but only that it should advise the opposite party and the Court of the ground on which the relief is applied for.

All that the Court inquires into, on such a petition, is to see whether probable cause exists for granting the leave, and whether the petition states facts or circumstances which, if properly pleaded, would sustain a supplemental bill.

Where the original bill was against K., and was founded mainly on an agreement between the plaintiff and K., in relation to a machine patented to the former, which gave to K. the right to make and vend the machines on certain conditions, and, on filing the bill, an injunction was issued against K., prohibiting his further making or selling the machines: *Held*, that a petition alleging that since the filing of the bill G. had, *as the plaintiff was informed and believed*, become in some way interested in the machines, and was, *as the plaintiff believed*, acting in collusion with K. in making and vending them, and represented himself as so interested, was sufficient to authorize the plaintiff to make G. a party to the same suit by supplemental bill.

Where the same petition asked leave to insert in a supplemental bill new matters in regard to K.: *Held*, that although most of them would be proper subjects of amendment to the original bill, and could not lay the foundation for a supplemental bill, yet, as a discovery was sought from K. in regard to particulars not stated in the original bill, and K. had already answered that bill, the leave ought to be granted.

Circumstances stated under which laches will not be imputed to the plaintiff as a ground for denying him leave to file a supplemental bill.

(Before BERRS, J., Southern District of New York, January 25th, 1848.)

THIS was an application, by petition, for leave to file a supplemental bill, making one Calvin L. Goddard a party to the suit, and adding new charges against the defendant Kinsman, based partly on facts which had occurred since the original bill was filed, and partly on facts existing at that time, but not then known to the plaintiff, and also an amended prayer for a Receiver. No additional proceeding was prayed against the defendant Hale. Notice of the application was

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served on Kinsman and Goddard, and they opposed it. Kinsman objected that the plaintiff had been guilty of laches, in not speeding the cause, as a plea in bar to the bill, and an answer supporting the plea. had been filed nearly two years before; and that it was unreasonable to allow him now to introduce new averments and a new prayer, and thus open and enlarge the field of litigation, which ought to have been closed upon the pleadings before the Court.

The original bill was founded mainly upon an agreement between the plaintiff and Kinsman, in relation to a burring machine patented to the plaintiff, (see *Parkhurst v. Kinsman*, 1 *Blatchf. C. C. R.* 488,) which gave to Kinsman the right to make and vend the machines on certain conditions. A provisional injunction was granted against Kinsman, on the filing of the bill, prohibiting his further making or selling the machines. The petition now alleged that, since the bill was filed, Goddard, who was formerly a clerk or agent of Kinsman's, had, as the plaintiff was informed and believed, become in some way interested in the machines, and was, as the plaintiff believed, acting in collusion with Kinsman in making and vending them, and represented himself as so interested, and was issuing circulars to invite purchasers, &c. Goddard objected, that the cause of action against Kinsman set up in the bill was wholly foreign to him, being based on a contract between those parties, and seeking redress upon the spirit and equity of that contract, with which he was in no way connected in terms, and in which he had no interest; that, if the plaintiff had any cause of action against him for the violation of the patent, the remedy was by an action for the tort, and such violation had no connection with the agreement set up in the bill.

Seth P. Staples and *George Gifford*, for the plaintiff.

James W. Gerard, for Goddard.

Ambrose L. Jordan, for Kinsman.

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BETTS, J. It seemed to be supposed, on the argument, by the counsel for the defendant, that the Supreme Court, in requiring, by Rule 57, notice to be given on an application for leave to file a supplemental bill, had put the petition upon the footing of the bill itself when filed, and that the application could be defeated by showing that the petition did not make a case establishing the propriety of the bill, and the legal liability of the party sought to be brought in, to the remedy sought by the suit. Such, however, is not the effect of the rule. It does not essentially change the practice as it before existed. In England and in this State, supplemental bills were allowed to be filed only by leave of the Court; (*Dan. Ch. Pr.* 1655, *Am. ed. and notes*; *Eager v. Price*, 2 *Paige*, 333; *Lawrence v. Bolton*, 3 *Id.* 294;) and the Court, in addition, frequently ordered notice to be given of the application. (*Eager v. Price*, 2 *Paige*, 333.) The design of notice is to avoid precipitation and a needless accumulation of pleadings. But the Court inquires no further than to see whether probable cause exists for the new proceeding. The petition, accordingly, need not embrace the averments intended to be inserted in the supplemental bill, but need only advise the opposite party and the Court of the ground on which the relief is applied for. The Court may, therefore, deny leave to file a supplemental bill, and yet permit an amendment of the original bill; and this ability to shape and abridge the pleadings may be the reason of the practice which requires the assent of the Court to the filing of a supplemental bill. In my opinion, then, all that the Court looks to on motions of this description, is to see that the plaintiff states facts or circumstances which, if properly pleaded, would sustain a supplemental bill.

The allegations in the petition in regard to Goddard would, undoubtedly, be insufficient as averments in a supplemental bill, but they embrace matters which, if well pleaded, may charge him as a party to the suit. The Court will not decide this motion on the technical rules applicable to a demurrer. The petition is sufficiently definite in charging that Goddard

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has become connected with the subject-matter of the suit against Kinsman since the original bill was filed, and is, in that connection, doing those acts in relation to the interests of the plaintiff which this Court, by injunction, has restrained Kinsman from doing; and that is, in substance, sufficient, according to all the authorities, to authorize the plaintiff to bring Goddard before the Court, in the same suit, to answer for his proceedings. On these points, the plaintiff is entitled to a discovery from Goddard. It is a mistake to construe the petition as setting up, as the ground of complaint, an independent infringement by Goddard of the plaintiff's rights under his patent. Its bearing and manifest intent is to charge on Goddard a combination with Kinsman, and an acting in concert with him to defeat the right the plaintiff has to restrain Kinsman on the equities of the original bill. It is enough, on this motion, to allege such concert and combination on information and belief, whether such a charge would or would not be sufficient in the bill itself. The leave prayed for must, therefore, be granted in respect to Goddard.

Most of the matters sought to be inserted in the supplemental bill in respect to Kinsman would be proper subjects of amendment to the original bill, and could not lay the foundation for a supplemental bill. (1 *Hoff. Ch. Pr.* 393, 398; *Story's Eq. Pl.* § 333.) But, as a discovery is sought from Kinsman in regard to particulars not stated in the original bill, and an answer to that has been already put in by him, the course of practice will justify the filing of a new bill. (*Mitf. Pl.* 62, 3d *Amer. ed.* 99, and note.)

The laches imputed to the plaintiff, in not pushing forward his suit since Kinsman's plea and answer were put in, might perhaps call for a fuller excuse, before the Court would allow the plaintiff to change the issues by amending the original bill. Even then, however, the objection would not stand upon the ground of any essential injury to the defendant to arise from permitting such amendment, for it is not shown that any proofs have been taken by either party under the issues, or that the defendant has availed himself of his privi-

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lege under our practice of speeding the cause. But a supplemental bill may be filed at any stage of a cause, even after decree rendered, (*Story's Eq. Pl.* § 338,) and the nature of the present litigation would induce the Court to lend all reasonable aid to have every dispute between the parties in respect to their rights as involved in it, definitively settled, and to leave nothing to be called up and pursued hereafter. Upon these considerations, I shall authorize the supplemental bill to be filed as prayed for, with the insertion, as against Kinsman, of the allegations referred to in the petition, and which might not, if brought forward by themselves, justify more than an order for amendment.

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vs.

ISRAEL KINSMAN AND JAMES W. HALE. IN EQUITY.

A plaintiff, in moving for an attachment against a defendant for contempt of Court in not obeying an injunction, must state, in the proofs on which the application is founded, the specific acts of omission or commission which constitute the alleged contempt.

When, in such a proceeding, the defendant is ordered to answer interrogatories to be filed, such interrogatories must be limited to the particular offences so alleged, and must not inquire in regard to matters not charged specifically in such proofs.

Nor can the plaintiff require the defendant to answer interrogatories as to particulars which are charged on information and belief, and are not established by direct evidence.

Interrogatories which were unauthorized having been demurred to by the defendant, and he having answered taking issue upon others: *Held*, that he was entitled to recover his costs on the demurrer, but the enforcement of the costs was stayed until the issues on the interrogatories answered should be disposed of.

Held, also, that the proper mode of proof on such issues was by testimony taken orally before a Master.

(Before BETTS, J., Southern District of New York, February 16th, 1848.)

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AN injunction having been granted against the defendant Kinsman, on the filing of the bill, restraining the sale by him of certain machines constructed according to a certain patent issued to the plaintiff, (see *Parkhurst v. Kinsman*, 1 *Blatchf. C. C. R.* 488, and *ante*, p. 72,) it was served upon him, and afterwards, on the filing of affidavits charging a violation of the injunction by sales of the machines, an attachment was issued against him. On his arrest, twenty-five interrogatories were filed by the plaintiff. To two of the interrogatories and part of a third the defendant answered, taking issue on them. He in substance denied or alleged matter in avoidance of a fourth, and demurred to twenty-two and part of another. The only interrogatories which related directly to the specific acts of contempt on the part of the defendant, in violation of the injunction, which were charged in the affidavits for the attachment, were two of those on which the defendant took issue. Three of the interrogatories demurred to inquired as to collections and receipts of money by the defendant generally, from sales of the patented machine, but did not apply directly to the collections and receipts on the sales specified in the said affidavits. The questions arising as to the proper mode of procedure on the issues of fact so joined and the demurrers so taken, were now argued.

James W. Gerard, for the defendant.

Seth P. Staples and *George Gifford*, for the plaintiff.

THE COURT held: 1. The proper mode of proof by the parties on the facts in issue between them in this case, is by testimony taken orally before a Master.

2. It is incumbent on a plaintiff, in moving for an attachment against a defendant for contempt of Court in not obeying its process of injunction, to state, in the proofs on which the application is founded, the specific acts of omission or commission on the part of the defendant which constitute the alleged contempt.

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3. When, in such a proceeding, the defendant is ordered by the Court to answer interrogatories to be filed by the plaintiff, such interrogatories must be limited to the particular offences so alleged against the defendant; and it is not competent for the plaintiff to file interrogatories inquiring in regard to matters not charged specifically against the defendant in the proofs furnished on the application for the attachment.

4. The plaintiff is not entitled to require the defendant to answer interrogatories as to particulars which are charged on the information and belief of the plaintiff or of other witnesses, and are not established by direct evidence.

5. The several interrogatories demurred to by the defendant are unauthorized by law, and are bad in substance; and the defendant must be exonerated from answering them, and is entitled to recover against the plaintiff his costs on the demurrers to be taxed, but the enforcement of such costs must be stayed until the matters in issue between the parties on the interrogatories answered shall have been disposed of.

6. There must be a reference to a Master to take the proofs of the respective parties upon the issues joined, and report the same to the Court with all convenient speed.

STEPHEN R. PARKHURST

vs.

ISRAEL KINSMAN AND OTHERS. IN EQUITY.

Where, on the filing of a bill against K. to restrain him from violating the plaintiff's patent, a provisional injunction was granted, and afterwards the Court allowed a supplemental bill to be filed, bringing in, as a party to the suit, G., who it was alleged had become interested in the subject-matter of the suit since its commencement, and also allowed new charges in regard to K. to be inserted in the supplemental bill, so as to embrace transactions not covered by the injunction: *Held* that, as the transactions of K. set forth in the supplemental bill were of the same character with those first enjoined, the injunction must be extended so as to include them.

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It appearing that G., who was so made a party by supplemental bill, was the clerk of K. from the commencement of the suit to the hearing of the application for the injunction against K., and knew of the existence of the suit and of the proceedings for the injunction, and, on the day the application was heard, became assignee of K. of his rights in litigation in the suit: *Held*, on a motion for a provisional injunction against G., that he took the subject-matter assigned to him, with no higher or other rights, as respected the plaintiff, than K. possessed, but was chargeable with the liabilities of K., and did not stand before the Court as an independent infringer.

Held, further, that as G. was a sheer volunteer in the controversy, and the mere substitute for K., the like injunction as against K., must issue against him, and that he could not be allowed to give security and keep an account till the hearing.

The peril of a fund in litigation is cause for the interference of the Court to secure and protect it by the appointment of a Receiver.

(Before BETTS, J., Southern District of New York, March 11th, 1848.)

IN pursuance of the leave granted, (*ante*, p. 72,) a supplemental bill was filed in this case, making Calvin L. Goddard a defendant, and enlarging the charges in the original bill against the defendant Kinsman, so as to embrace transactions of his not covered by the injunction originally awarded against him. On the supplemental bill and proofs offered in support of its allegations, the plaintiff now moved for an injunction against both Kinsman and Goddard, and also for a Receiver, to collect and hold the outstanding moneys payable to them, and which were the subject of litigation in the suit. The material facts appearing on the motion are stated in the opinion of the Court.

Seth P. Staples and *George Gifford*, for the plaintiff.

James W. Gerard, for the defendants. •.

BETTS, J. As the transactions of Kinsman, set forth in the supplemental bill, are of the same character with those heretofore enjoined, they come within the scope of the former injunction, and it must be extended as to him so as to include them.

It is contended that Goddard's case stands on independent

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ground, and that he is entitled to make an original defence to the plaintiff's motion, on its merits. He claims the privileges of a *bonâ-fide* purchaser from Kinsman of his interest in the tools and materials for the manufacture of the machines in question, and insists that the plaintiff cannot ask the equitable interposition of the Court against him, except upon the ground of his being an infringer of the plaintiff's patent; and that, as to that charge, he is entitled to defend himself, without regard to the condition of Kinsman, who, as was held by the Court on the granting of the original injunction, was precluded, by his agreements, from denying the validity of the patent. But I think that Goddard is not entitled to these grounds of defence, and that he stands before the Court, at this stage of the action, chargeable with the liabilities of Kinsman, and in no respect entitled to a higher or different order of defence.

The original bill rested on two grounds: the right of the plaintiff as patentee, and the special agreements made with him by Kinsman, as part owner of the patent, in relation to its use and enjoyment; alleged a violation of the plaintiff's rights in both respects; and demanded the restraining of Kinsman from the further use of the invention, and a discovery and account from him in respect to his past doings under the agreements. On all these points the decision of the Court, on the motion for the injunction, was in favor of the plaintiff.

Goddard, from the commencement of this suit to the close of the application for the injunction, was the clerk of Kinsman, keeping his books, and knowing his transactions under the agreements, and was personally cognizant of the existence of the suit, having furnished his own affidavit on behalf of Kinsman to resist the application, and attended in Court during the hearing. On the very day the argument closed, Goddard became assignee of Kinsman of all the rights of the latter, and now sets up that assignment as his protection. The order of the Court granting the injunction was made two days afterwards. Here, then, the interest of Goddard

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was acquired, not only *pendente lite*, in the ordinary sense of the phrase, but with a full knowledge in fact of the nature and state of the litigation, and after some degree of personal participation in it; and, on well-settled principles, he took the subject-matter assigned to him, with no higher or other rights, as respected the plaintiff, than Kinsman possessed. (*Story's Eq. Pl.* §§ 156, 342; 2 *Story's Eq. Juris.* § 908.) To uphold such a transaction would, in the language of Chancellor Walworth, enable parties, by successive assignments, to render a litigation interminable. (*Sedgwick v. Cleveland*, 7 *Paige*, 287.) The plaintiff here might have enforced his decree against Goddard, without any new proceedings, (3 *Dan. Ch. Pr.* 1894,) but he had also the option to bring him into the cause as a party, by supplemental bill, and there was reasonable cause for so doing, in order to enforce an account against him, and have the additional remedy of a Receiver as to outstanding moneys on sales made by him.

The Court was most strenuously urged not to make the injunction peremptory against Goddard, and thus completely close his business, and involve him in ruinous losses. At first, I was inclined to seek some mode, by exacting security and the keeping of an account, by which his operations might be continued till the final hearing. But, upon the whole, as he is sheerly a volunteer in the controversy, and intermeddled in the business after the decision of the Court in Kinsman's case was known, he in truth stands before the Court chargeable in every particular with the liability of Kinsman himself to submit to that decision, and cannot justly claim any exemption from its full design and effect. Most assuredly Kinsman would not be permitted to resume the manufacture of the machines, until the dissolution of the injunction; and Goddard stands in no other light than his substitute, acting with full knowledge of the decision of the Court, and, in many instances, as appears by the proofs, professedly continuing operations in the name and under the authority of Kins-

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man. Under these circumstances, an injunction must be issued against Goddard, as prayed for.

A proper case is established against both defendants for the appointment of a Receiver. It is shown that both of them have debts outstanding to a very large amount, for machines sold by them since the granting of the former injunction. The plaintiff, if his right is finally established, will be entitled to a large part of these moneys, and both defendants are proved to be irresponsible in their circumstances. The peril of a fund in litigation, is cause for the interference of the Court to secure and protect it by the appointment of a Receiver. (*Edwards on Receivers, chap. 1; 3 Dan. Ch. Pr. 1667 to 1669, 1949 to 1965; 2 Story's Eq. Juris. §§ 829, 831.*)

 ISAAC D. BAKER AND CHARLES SCRIBNER

vs.

JOHN S. TAYLOR. IN EQUITY.

Under the copyright Act of February 3d, 1831, (4 *U. S. Stat. at Large*, 436,) the deposit of the title-page in the proper clerk's office, the publication of notice according to the Act, and the delivery of a copy of the book, are indispensable conditions precedent to a title to a copyright.

Where the title-page of a book was deposited in 1846, and the notice of the entry, as printed in the copies of the book, stated the entry to have been made in 1847: *Held* that, under § 5 of the Act, the error was fatal to the title.

Whether the error arose from mistake or not, makes no difference.

A sale of a book naturally imports publication, and the presumption is, that the purchaser exercised his right to know the contents of the book and to make them known to others, and that an actual publication followed the sale.

Hence, where copies of a book were sold prior to the date of the deposit of a copy of the title-page: *Held*, that such sale was evidence of a publication of the book at the time of the sale.

And, where a printed copy of the book, then complete, was deposited in the clerk's office at the same time the title-page was deposited there: *Held*, that these facts, in connection with the fact of such prior sale, warranted the inference of an actual publication of the book prior to the date of such deposit.

Under § 4 of the Act, a person is not entitled to the benefit of a copyright, unless he deposits the title-page *before* the publication of the book.

(Before BETTS, J., Southern District of New York, March 20th, 1848.)

Baker v. Taylor.

THIS was an application for a provisional injunction to restrain the defendant from infringing an alleged copyright of the plaintiffs to a book entitled "The Sacred Mountains, by J. T. Headley, author of Napoleon and his Marshals, etc.: Illustrated." The bill alleged, that the plaintiffs, being sole owners of the said work, which was composed and written by said Headley, but had not then been published, on the 10th of November, 1846, deposited in the office of the clerk of the District Court for the Southern District of New York, a printed copy of the title-page of the book, and on the same day delivered to the said clerk a printed copy of the book itself; and that, previous to its publication, they caused to be printed on the page immediately following the title-page, in each copy published: "Entered according to the act of Congress, in the year 1847, by Baker & Scribner, in the Clerk's Office of the District Court of the Southern District of New York." The bill alleged that the year 1847 was printed by mistake for 1846.

The defendant opposed the application, on an affidavit of his own, stating that, at the time the title of the book was deposited, he was a clerk of the plaintiffs, and made known to them the said error in the imprint before the book was published, but that they declined having it corrected; and that he personally knew that the plaintiffs, by themselves and their clerks, sold divers copies of the book prior to the 10th of November, 1846.

Seth P. Staples, for the plaintiffs.

Hiram P. Hastings, for the defendant.

BETTS, J. The Act of Congress, entitled "An Act to amend the several Acts respecting copyrights," passed February 3d, 1831, (4 *U. S. Stat. at Large*, 436,) embodies the provisions of the Acts of May 31st, 1790, and of April 29th, 1802, on the subject, and imposes on persons claiming the privilege of a copyright the same duties and liabilities which attended

the right under the prior statutes. It is quite useless to go into the general learning appertaining to the subject, or to state at large the decisions rendered in Great Britain under the English statutes. The Supreme Court of the United States, in the case of *Wheaton v. Peters*, (8 *Peters*, 591,) has given an exposition of our statutes, which is obligatory on this Court, and essentially covers the main question raised on this motion. The principle declared by that decision is, that under the laws of the United States a copyright title is not perfected without a strict compliance with the provisions of the statute. Those requirements which, in England, are generally regarded as directory, and not as conditions precedent to title, (1 *Dan. Ch. Pr.* 419; *Curtis on Copyright*, 198, 205; *Godson on Pat.* 211,) are, under our laws, important and indispensable pre-requisites to a perfect title. Depositing the title-page in the proper clerk's office, publishing a notice according to the Act, and delivering a copy of the book, are held to be conditions, the performance of which is essential to the title. On that authority, I think the point is placed beyond question, that the failure, in the present case, to publish the notice demanded by the Act, in the manner directed, creates a fatal defect in the plaintiffs' title. Even though the failure to publish the statutory notice arose from mistake, this Court would have no power to accept the intention of the party, in place of a performance, any more in respect to the insertion of that notice on the proper page, than in respect to the deposit of the title of the book.

But there was no mistake in this case. The plaintiffs knew of the error before the book was published. They, however, regarded it as trivial, and not worth the expense and trouble of correction. But Congress, in the 5th section of the Act of 1831, have seen fit to make the copyright dependent upon the particular act of giving the notice, and, to mark its importance, the statute sets forth the words in which the notice shall be given. The direction must be strictly complied with.

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The affidavit of the defendant, which, on a motion for an injunction, is competent evidence against the oath of the plaintiffs to the bill, proves sales of the work by the plaintiffs prior to the 10th of November, 1846, when the title of the book was deposited. It is argued for the plaintiffs, that these alleged sales were only consignments of the work in advance of the publication, and that publication, by putting the book in circulation, was not made until after the date of the deposit of the title. There is no proof to support this version of the facts. A sale naturally imports publication. The purchaser having the right to know the contents of the book, and make them known to others, no presumption can be raised that the right was not exercised, or that an actual publication did not follow the sale. On the contrary, the presumption is the other way. And the inference is strong, that actual publication was made, as sworn to by the defendant, anterior to the 10th of November, from the fact that a printed copy of the work, then complete, was on that day deposited in the clerk's office, the deposit of the book, complete for circulation, and the deposit of the title being simultaneous acts. The 4th section of the act, in express words, denies all benefit to a person, under the act, unless he shall, *before* the publication of his work, deposit the title-page, &c.

The plaintiffs have failed to show themselves entitled to the injunction prayed for.

 WILLIAM VAN HOOK

vs.

JOHN PENDLETON AND JONATHAN LEACH. IN EQUITY.

The principles which govern the practice of the United States Courts in Equity, considered.

The practice as to examining witnesses in suits in Equity, considered.

The Circuit Courts of the United States have power to appoint Examiners in suits in Equity.

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It is a matter of discretion whether such Examiners shall be standing Examiners, or be designated as the occasion arises for their services in any cause.

Where the plaintiff in a suit in Equity proceeded, after the cause was at issue, to take proofs before one of the standing Examiners of the Court, without his having been specially appointed as Examiner or Commissioner *in the suit*: *Held*, that the Examiner was competent to take the evidence.

An oral examination before an Examiner, without any agreement between the parties to waive written interrogatories, is irregular.

Such agreement ought to be in writing.

But, where a party has due notice that such an oral examination is to be taken or has been taken, and acquiesces in it, he waives his right to require written interrogatories.

Where, more than ten months after such an oral examination, and nearly five months after publication, the defendant, who had due notice of the time and place of the examination, moved to set the proofs aside because they were not taken on written interrogatories: *Held*, that he was guilty of laches, and that it was too late for him to raise the objection.

Under Rule 78 of the Rules in Equity of 1842, it is a matter of discretion with the Court whether it will or will not stay the proceedings in a cause to allow a party to cross-examine or take a new deposition of a witness already examined by deposition for the opposite party under § 30 of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 88.)

The practice in taking depositions under that Act, considered.

(Before NELSON and BETTS, JJ., Southern District of New York, April 4th, 1848.)

THIS was a suit in Equity for an account and an injunction for the infringement of Letters Patent. After the cause was at issue, the plaintiff proceeded to take proofs before one of the standing Examiners of the Court, without his having been specially appointed as Examiner in the cause, or as commissioner therein; and the testimony was taken before him upon oral examination and not by written interrogatories. The defendants had written notice, previous to the examination, of its time and place, and of the names of the witnesses to be examined. There was no written stipulation between the parties that the testimony should be taken on oral examination. The defendants now moved to set aside the proofs for irregularity. The testimony was taken more than ten months previous to the motion, and the depositions were filed in the clerk's office nearly five months before the motion.

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The plaintiff also took depositions, under the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 88, § 30,) of witnesses residing more than one hundred miles from the place of holding the Court. Such depositions were taken in different States, and at places remote from each other, and more than one hundred miles from the defendants. Prior to taking them, the plaintiff gave notice to the defendants of the names and places of residence of the witnesses intended to be examined in that way, and also notified them that, if they would designate agents at those places on whom fuller notices could be served, the particular times and places of the several examinations should be communicated to them, as soon as the officers who were to take the depositions should fix such times and places. The defendants refused to designate any agents, and declined taking any part in the proceedings. The plaintiff took the depositions without serving any further notice on the defendants, and without their being present. The defendants now moved for leave to cross-examine the witnesses whose depositions had been so taken, and that the hearing be stayed for that purpose.

Edwin W. Stoughton, for the defendants.

Seth P. Staples and *George C. Goddard*, for the plaintiff.

BERRS, J. (1.) Under the first motion now made, it is insisted that the Rules in Equity adopted by the Supreme Court in 1842, (1 *How.*,) regulate the entire subject of taking testimony in suits in Equity, and exclude all modes of taking proof other than such as are prescribed by those rules; that they authorize proofs to be taken by an Examiner, only when he is specifically appointed in the cause; and that the parties must proceed by written interrogatories, unless they mutually consent to an oral examination.

It will tend to a clearer view of the subject, to recapitulate briefly the principles governing the practice of the United States Courts in Equity. The 2d section of the Act of Septem-

ber 29th, 1789, (1 *U. S. Stat. at Large*, 93,) declared, that the forms and *modes of proceedings* in causes of Equity jurisdiction should be according to the course of the civil law. *Modes of proceeding*, or *processes*, comprehend the entire practice applicable to the subject. (*Wayman v. Southard*, 10 *Wheat.* 1; *Bank of the United States v. Halstead*, *Id.* 51.) The 2d section of the Act of May 8th, 1792, (1 *U. S. Stat. at Large*, 276,) limited the terms of the direction in the Act of 1789, in respect to proceedings in Equity, by declaring that they should be conformable "to the principles, rules and usages which belong to Courts of Equity, as contradistinguished from Courts of Common Law." This Act has always been understood to adopt the principles, rules and usages of the Court of Chancery in England, subject to alterations by the United States Courts. (*Manro v. Almeida*, 10 *Wheat.* 473; *Hinde v. Vattier*, 5 *Peters*, 398; *Rule 7 of Supreme Court*, Aug., 1791; *Rule 33 in Equity*, March, 1822; *Rule 90 in Equity*, March, 1842.) The terms of the rule last cited are: "In all cases where the rules prescribed by this Court, or by the Circuit Court, do not apply, the practice of the Circuit Court shall be regulated by the *present* practice of the High Court of Chancery in England," &c. It is obvious, therefore, that the code of rules adopted by the Supreme Court was not intended, to exclude, by implication, other rules and usages of the Circuit Courts, but that the operation and effect of that code are limited to the specific regulations which it makes.

Three points of inquiry, therefore, arise: 1. What were the usage and practice of this Court in taking proofs in causes in Equity, when the rules in Equity of March, 1842, were promulgated? 2. What was then the practice in the English Chancery? 3. What express regulation is made on the subject by those rules?

The first published rules of this Court were promulgated October 27th, 1828. Rule 60 of those rules appointed a Master and Examiner in Chancery in causes depending on the Equity side of the Court, but no other regulation in re-

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spect to Chancery practice was adopted. Accordingly, the course of procedure in Equity suits was governed by the rules of the Supreme Court and the English practice. Rule 73, adopted on the 15th of January, 1833, provided, that "if a general commission is not issued pursuant to the 25th rule" in Equity "of the Supreme Court," (of 1822,) "within ten days after replication filed, either party may give notice of the examination of witnesses before the standing Examiner of this Court; and three months from the time of the replication shall be allowed the parties for taking their depositions before the Examiner." This rule was incorporated in the revision of 1838 as rule 108. The rules in Equity of 1822 of the Supreme Court upon this head were rules 25, 26 and 28, and they recognize, rather than adopt or direct, three methods of taking proofs: 1. According to the Acts of Congress; 2. Under a commission; 3. Before a Master or Examiner appointed in the cause, where the witnesses live within the District. And it may be remarked, in this connection, that the Supreme Court, by rules 67, 68 and 78 of the rules in Equity of 1842 re-adopt in effect the provisions of those prior rules 25, 26 and 28—clearly so, so far as the present point of inquiry in regard to the rule of the Circuit Court for taking proofs is concerned.

It is manifest that the Supreme Court did not consider it necessary, in the first instance, to provide or create any of the officers referred to. They instituted neither commissioners, Masters nor Examiners. Those officers were referred to as adjuncts to the Court, and incidental to it in the exercise of its powers, whenever its business should demand their agency.

The mode of proceeding in England was familiar to the profession in this country, and had been of immemorial usage in the English Chancery. After issue joined, either party, on filing interrogatories with the clerk in Court, could sue out a commission for the examination of witnesses out of London. The commissioners were designated on the nomination of both parties. (1 *Harr. Prac.* 140; 2 *Madd. Prac.*

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405.) The same practice in substance was in force when the Supreme Court promulgated the rules of 1842, (2 *Dan. Ch. Pr.* 1070,) and it is manifest that the commission authorized by those rules is the same in general purpose and effect with that granted by the English Chancery, except that, upon their face, the rules might import an obligation on parties to take all their proofs under such a commission or under the Act of Congress. The 28th rule in Equity of 1822 restricted the taking of testimony by commission to witnesses residing out of the District, and left it optional with either party to summon his witnesses residing within the District before "the commissioners appointed to take testimony, or before a Master or Examiner appointed in any cause," &c. Rule 78 in Equity, of 1842, is in nearly the same terms.

In this case, the plaintiff examined his witnesses before a standing Examiner of the Court. Two exceptions are taken to the regularity of this method of proceeding: 1. Because no appointment of an Examiner in the cause was made by the Court; 2. Because the examination was taken orally and not upon written interrogatories.

1. An Examiner is not, in the course of Chancery practice, created or appointed at the instance of suitors, any more than a Master, register or clerk. He is an official attached to the Court, permanently in commission, to execute the functions appropriate to his office. He was originally regarded in England as a clerk of the Master of the Rolls, delegated by him to take examinations formerly had before him personally. (2 *Dan. Ch. Pr.* 1069.) Yet there, as in the United States, he is an officer of the Court, created for the purpose of taking proofs, however his appointment may be made. (1 *Barb. Ch. Pr.* 277.) No statutory provision seems to have been made in this State for the appointment of Examiners, prior to the Constitution of 1821. (*Const.* 1821, art. 4, sec. 12.) Under the Constitution of 1777 they were, in practice, commissioned by the Governor and Council of Appointment. (*Const.* 1777, art. 23.) The Court of Chancery had power, under that Constitution, to appoint its regis-

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ter and clerks only, (*Art. 27.*) but the Legislature recognized Examiners as permanent officers of the Court, and conferred on them power to administer oaths to witnesses and to take affidavits to be read in Court. (1 *Kent & Radc. Laws*, 444, § 16; 1 *R. L.* 491, § 13.) However the appointment of Examiners may have been first made in England, from the time they became recognized standing officers of the Court of Chancery, acting in place of the Court in taking testimony, they received their appointment from the Court. (*Turner v. Burleigh*, 17 *Ves.* 354.) Under the process Act of May 8th, 1792, (1 *U. S. Stat. at Large*, 275,) and the Act of August 23d, 1842, (5 *U. S. Stat. at Large*, 516,) the same power of appointment devolves upon the United States Courts, in Equity, to be exercised by the Circuit Courts, pursuant, however, to the directions of the Supreme Court when given. Under this general authority commissioners are appointed to take testimony. They are named in each cause separately, because it is important to designate them with reference to the residence of witnesses, very generally out of the District; and that this is the reason for authorizing a commission at all, would seem probable from the rule dispensing with it at the election of parties where the witnesses reside in the District. The same power which enables the Court to name commissioners, suffices for the appointment of Masters and Examiners, they being all officers auxiliary to the Court in aid of the exercise of its jurisdiction. In regard to Masters and Examiners no reason exists for limiting their appointment to particular causes, and there is a manifest convenience and propriety in confiding trusts which demand much legal knowledge and experience in Chancery proceedings, to standing officers, whose capacity and places of business may be known to the community.

The rules in Equity of 1822 left these appointments wholly to the Circuit Courts, without direction or suggestion on the part of the Supreme Court. In the rules in Equity of 1842, it was thought proper to sanction (*Rule 82*) the appointment by the Circuit Courts of standing Masters, and of Masters

pro hac vice. But there is no trace in this District of any previous limited appointment of Masters. They were undoubtedly made permanent officers, in consonance with the usage of the English Chancery; and it is difficult to perceive any reason supporting their appointment in either way, that does not uphold it in both. As the Circuit Courts could, no doubt, without the aid of Rule 82, have appointed Masters *pro hac vice*, at their discretion, when the course of business demanded it, so, with the same object in view, they could have designated standing Masters. The power had been so interpreted in this District. Masters have been standing officers of this Court since 1822, and Examiners since 1828. Previous to the adoption of the Rules of 1828, the usage of the Circuit Court within this District seems to have been, to refer subjects appropriate to a Master's office to a standing Master of the State Chancery, which in effect was equivalent to appointing him a Master *pro hac vice*. Congress, by conforming the powers of the United States Courts in Equity to those of the High Court of Chancery in England, must be supposed to have contemplated the naming of agents to carry out those powers, as well in matters incidental to the business of the Courts, as in the course of proceedings in suits.

It is argued that the authority given by Rule 78 of 1842, in Equity, to take testimony before an Examiner, is expressly limited to one appointed in the particular suit. The language of the rule, however, would be satisfied, by designating in a common order, or by mere notification, the officer with whom the interrogatories were to be filed or the examination was to be had. That would be in effect appointing him Examiner in the cause, although he should not be commissioned anew. And the course of practice is tantamount to what is called appointing a Master or Examiner in the cause, for both parties are not required to take their testimony before the same Examiner, each being at liberty to designate his own Examiner, both for the direct and the cross-examination of witnesses. (*Turner v. Burleigh*, 17 Ves. 354; *Troup v. Haight*, 6 Johns. Ch. R. 335.)

We have no doubt of the authority of this Court, under the acts of Congress and the rules of the Supreme Court, to appoint Examiners, and it then becomes wholly a matter of discretion, whether they shall be appointed standing Examiners or be named as the occasion arises for their services in any cause. We therefore hold, that the Examiner employed in this case was competent to take the proofs.

2. The point touching the irregularity of the proceedings in the Examiner's office might probably have been conclusive against the plaintiff, if it had been raised in due time. The examination of witnesses was taken on oral interrogatories, conformably to the practice of the State Court of Chancery. (1 *Hoff. Ch. Pr.* 462.) The English method is different, and no express rule of this Court has authorized a dispensation with written interrogatories, in an examination before a commissioner or Examiner. The 67th rule in Equity of the Supreme Court, of 1842, provides, that "if the parties shall so agree, the testimony may be taken upon oral interrogatories by the parties or their agents, without filing any written interrogatories." There is great practical convenience in that mode of examination, and, as it is the established practice in the State Chancery to take examinations *viva voce*, (2 *R. S.* 180, § 83; *Chancery Rule* 85,) the Courts of the United States would be disposed to apply the most liberal intentions to uphold examinations of witnesses so taken, without evidence of any written stipulation or consent between the parties to that end. If it be out of the usual course to give effect to a mere verbal agreement between parties or their attorneys, out of Court, affecting the cause, yet a waiver of objections to mere matter of form may be implied, and the Court may safely hold, that a party who had notice that an examination was to be taken, or had been taken, orally, and acquiescèd in it, should be considered to have waived his legal right to require written interrogatories to be filed. The testimony in this case was taken nearly a year ago, on written notice to the defendants of the time and place of taking,

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and of the names of the witnesses to be examined. Publication was made nearly five months ago.

We do not put our decision upon the ground that the defendants were bound to move for the suppression of the proofs before the depositions were placed on file; although, good faith and liberal practice should have induced them to apprise the plaintiff that they intended to treat the proceedings as irregular. But we hold the defendants to have been guilty of laches in not moving the Court, or a judge out of Court, to suppress the proofs, immediately on their being filed or published. By Rule 1 of the Rules in Equity of 1842, the Circuit Court is always open for motions of that character, and probably, under Rule 3, and other rules, a judge at chambers can hear such a motion at any time. It is an elementary doctrine in the practice of all Courts, that parties shall take advantage of irregularities at the first opportunity after acquiring knowledge of them, or be deemed to have waived all objections to them. (*Graham's Pr. Book 3, ch. 21*; *Hinde v. Tubbs*, 10 Johns. 486; *Rowan v. Lytle*, 4 Cow. 91; *Brasher's Exrs. v. Van Cortlandt*, 2 Johns. Ch. R. 247; *Skinner v. Dayton*, 5 Id. 191.) Here, there has been a delay since actual publication of nearly five months, a time abundantly sufficient for the plaintiff to have re-examined his witnesses in season for a hearing at this term, if his former proceedings had been held irregular; and a delay of more than ten months since the examination was had. We think the defendants are precluded from now raising this objection. .

(2.) The motion by the defendants for leave to cross-examine the witnesses whose depositions were taken under the Act of Congress, and that the hearing be stayed for that purpose, must also be denied. The defendants had all the notice of the time and place of taking the depositions that was necessary or reasonable. They contend, however, that Rule 78 of the Rules in Equity of 1842 entitled them to refuse, as they did, to designate agents, or to take any part with the plaintiff in the proceedings; and that, as the plaintiff took his depositions without serving on them notice of the time and place

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of taking, they can now have the cause stayed to enable them to cross-examine the witnesses. But we think Rule 78 does not justify the interpretation insisted on, and that, as the defendants intentionally took their stand upon a legal point, they must bear the consequences of its determination against them. The rule in question allows a party the opportunity of an after cross-examination, or of taking a new deposition of the witness, only where "a Court or judge shall, under all the circumstances, deem it reasonable." No facts are laid before us showing the necessity or propriety of a further examination of the witnesses. It is not stated that they gave testimony adverse to the defendants, or that there are facts within their knowledge, not stated, which might be important in the cause. We are not furnished with any circumstances to guide our discretion in this respect. On both grounds, the motion must be denied.

We do not intend to intimate that there is any objection to the defendants' proceeding, at their own expense and risk, to take the evidence of the witnesses already examined, or of others. The point is not so presented that we are called upon to decide whether they can now bring in testimony on their part.

 MARIA DE VARAIGNE vs. EDWARD FOX.

The right of eminent domain empowers the Legislature to devote private property to public use.

An Act of the Legislature of New York, reciting that certain lands were needed by the Corporation of the city of New York for the purpose of extending the Alms-House Establishment of the city, and providing that, on the ascertainment and payment to the owner of the lands, of the loss and damage for taking them, the Corporation should be seised of the lands in *fee-simple absolute*, does not exceed the rightful authority of the Legislature.

In the exercise of its power to devote private property to public use, the Legislature are the exclusive judges of the degree and quality of interest which are proper to be taken, as well as of the necessity of taking it.

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Where the Legislature has conferred an estate in *fee-simple absolute* in the premises taken, it must be assumed that they judged it necessary to do so, to answer the public use contemplated.

Such a grant of a *fee-simple absolute* will not be construed as a conditional fee or usufruct, leaving the possibility of a reverter to the original owner on the lapse of the particular use, but will be held to have vested the entire property forever in the grantee.

If a change in the destination of the property granted, after a continuance for twenty-six years of the use of it first contemplated, raises any interest or right on the part of the original owner, it is of an equitable character, cognizable only in Chancery, and not at law.

(Before NELSON and BETTS, JJ., Southern District of New York, September 30th, 1848.)

EJECTMENT. In February, 1818, the Mayor, Aldermen and Commonalty of the city of New York were possessed of certain premises in that city, occupied by them as an Alms-House Establishment, and presented to the Legislature of New York a memorial praying that a law might be passed authorizing them to enter upon and take possession of certain lands contiguous to the said premises, and hold the same for the use of the said Alms-House Establishment. On the 21st of April, 1818, an Act was passed, entitled "An Act authorizing the Mayor, Aldermen, and Commonalty of the city of New York to take possession of certain lands." The Act recited that the corporation was desirous of taking possession of certain lands, the bounds of which were specified, for the purpose of extending the Alms-House Establishment of the city, and provided that it should be lawful for the corporation, whenever they should judge proper, to take possession of all or any part of the said lands, in the manner prescribed by a prior Act in relation to taking lands, passed March 29th, 1816. (*Laws of 1818, chap. 244.*) This Act of 1816 provided for the estimate, by Commissioners, of the sums to be paid to the owners of the lands to be taken, for their loss and damage, and for a report thereon to the Supreme Court, and its confirmation of the same; all according to certain prescribed forms. The Act of 1818 provided that, on the final confirmation of the report of the Commissioners, and the pay-

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ment of the sums which might be awarded by them, the corporation should become and be seised *in fee-simple absolute* of the said lands, or of so much thereof as might be described in the report. The requisite steps were taken in due form for estimating the amount to be paid to Mrs. Ann Rogers, then the owner in fee-simple of a portion of the said lands, and the amount was reported at \$13,090. On the 14th of May, 1819, the report was confirmed by the Court, and that amount was paid to Mrs. Rogers on the 1st of July, 1819. The corporation then took possession of the said lands of Mrs. Rogers, and occupied them for the use of the Alms-House Establishment until April, 1845, when they ceased to use them for that or any other public purpose, but caused them to be divided into lots and sold at auction. The defendant purchased on such sale, and received from the corporation a warranty deed for a part of the said lands of Mrs. Rogers, being the premises of which an undivided share was claimed by the plaintiff, and held the same under that title and no other. On the 15th of June, 1833, Mrs. Rogers devised to the plaintiff, and to her heirs and assigns, in fee-simple, one undivided eighth part of all her real estate, and died soon afterwards. The will was duly proved, and the plaintiff brought this suit to recover one undivided eighth part of the premises so purchased by the defendant. At the trial, a special verdict was taken, finding the foregoing facts.

William W. Van Wagenen, for the plaintiff. 1. The act of 1818 purported to take from Mrs. Rogers the fee of her land. But, if it be construed according to the intent of all the parties, the estate to be taken was limited to the quality and quantity of estate necessary to the public use that was designed. Only a limited estate was necessary for that public use. The circumstances attending the passage of the Act must be regarded in its construction. (*Livingston v. Harris*, 11 Wend. 329, 338; *Dwarris on Statutes*, 701; *Jerome v. Ross*, 7 Johns. Ch. R. 315, 344.) 2. The Legislature, by virtue of the right of eminent domain, could take away so

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much of Mrs. Rogers' estate as the public necessity required, and no more. (*Vattel*, p. 111; *Gardner v. Village of Newburgh*, 2 Johns. Ch. R. 162; *Beekman v. Saratoga and Schenectady R. R. Co.*, 3 Paige, 45, 72; *Boston Water Power Co. v. Boston and Worcester R. R. Co.*, 23 Pick. 360, 394.) Nor can private property be taken by the Legislature for other use than that of the public. (*Beekman v. Saratoga and Schenectady R. R. Co.*, 3 Paige, 45, 72; *Varick v. Smith*, 5 Id. 137, 159; *The People v. Morris*, 13 Wend. 325, 328; *Charles River Bridge v. Warren Bridge*, 11 Peters, 420, 641; *Bonaparte v. The Camden and Amboy Railroad Co.*, 1 Baldu. 205, 220; *Sharp v. Johnson*, 4 Hill, 92, 99; *Taylor v. Porter*, Id. 140.) 3. The act of 1818 purported to divide the estate that was taken from Mrs. Rogers into two distinct parts—the one devoted to the public use, and the other given over in perpetuity to the corporation. So far as it is constitutional and regards the public use, the Act will be sustained, though it is void for all beyond that. (*Jackson v. Mancius*, 2 Wend. 357, 363; *Jackson v. Cory*, 8 Johns. 301; *Jackson v. Catlin*, 2 Id. 248; *In the Matter of Albany street*, 11 Wend. 152; *In the Matter of John and Cherry streets*, 19 Id. 659; *Taylor v. Porter*, 4 Hill, 140; 147; *Varick v. Smith*, 5 Paige, 137, 159; *Bloodgood v. Mohawk and Hudson R. R. Co.*, 18 Wend. 9.) 4. The plaintiff is not estopped by the fact that Mrs. Rogers received the compensation awarded. The grant made in virtue of the act was only of the use of Mrs. Rogers' estate for an unlimited time, and her acceptance of the money can be held to imply no more than an assent to such a grant and use of the estate. 5. The title being valid in the corporation until the public use ceased, in 1845, the statute of limitations has no application.

Charles O'Conor, for the defendant.

THE COURT held: 1. The right of eminent domain empowers the Legislature to devote private property to public

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use, and the acts in question in this case did not exceed the rightful authority of the Legislature.

2. In the exercise of that power, the Legislature are the exclusive judges of the degree and quality of interest which are proper to be taken from an individual and dedicated to the public use, as well as of the necessity of taking it.

3. It must be assumed that the Legislature judged it necessary, in the present case, to confer on the Mayor, Aldermen and Commonalty of the city of New York an estate in fee-simple absolute in the premises in question, to answer the public use contemplated.

4. The grant cannot, under the terms of the act of 1818, be construed as a conditional fee or usufruct, leaving the possibility of a reverter to the original owner on the lapse of the particular use, but must be held to have vested the entire property forever in the corporation.

5. If a change in the destination of the property, after a continuance for twenty-six years of the use of it first contemplated, raises any interest or right on the part of the original owner, her heirs or devisees, it is of an equitable character, cognizable only in Chancery, and not at law.

6. We do not pass upon the effect of the acceptance by Mrs. Rogers of the full consideration of the fee value, as an estoppel or otherwise, nor upon the question as to the power of devising a possible reverter.

Judgment for defendant.

DAVID HENSHAW AND OTHERS

vs.

THE MUTUAL SAFETY INSURANCE COMPANY.

These points are settled in the construction of policies of insurance: First, They are to have a liberal and benign interpretation in behalf of the insured;

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Second, They are to be construed and enforced according to the plain intent of the parties, if no settled rule of law interposes to prevent; Third, Whether or not, by the general rules of insurance law, the fact that the insured party had no insurable interest in the subject insured at the time it was intended the contract should commence its operation, although he possessed such interest at the time of the loss, would render the policy invalid, yet it is competent for the parties to contract with a view to such a condition of things.

There is strong color, however, for the doctrine, that the party intended to be insured will be protected, if he had an interest at the time of the loss, without any express stipulation to that effect, although he had no interest at the commencement of the risk.

A time policy, against marine risk, on a steam-vessel, for a succession of voyages, each voyage to bear its own average, made at the instance of N., on account of whom it may concern, the loss payable to H., for the sum of \$15,000 is an agreement by the underwriters to insure all the interest to that amount which shall be owned in the vessel at the time of her loss within the policy, and to pay the loss to H., for the benefit of the actual owners.

Such a contract is legal, and H., in his own right, or as trustee, is competent to enforce it.

The policy might, also, be construed as intending each separate trip of the vessel to be a distinct voyage, the risk on which would commence at its inception, and thus the party interested at the time of the loss would also be interested at the commencement of the risk.

Where the declaration on such a policy averred that, at the time of the loss of the vessel, H., the plaintiff, was interested in her to the amount of the said insurance: *Held*, that it need not aver that H. was interested in her at the time of the insurance, or at the time of the commencement of the risk.

And, where it averred that the insurance was for the use and benefit of H., as trustee for N., and that, as such trustee, H. was interested in the vessel at the time of her loss: *Held*, that it need not set forth the nature or extent of the trust, they being matters of evidence.

(Before NELSON and BETTS, JJ., Southern District of New York, November, 1848.)

ASSUMPSIT on a policy of marine insurance. The declaration averred, in some of its counts, that on the 15th of July, 1846, at New York, the Norwich and Worcester Railroad Company, according to the usage and custom of merchants, caused a policy of insurance to be issued by the defendants, purporting and containing that the said Railroad Company, on account of whom it might concern, loss payable to the plaintiffs, insured, from the 15th of August, 1846, until the

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15th of August, 1847, the steamer Atlantic, each passage subject to its own average, against marine risk only, for the sum of \$15,000; that the plaintiffs were, *at the time of the loss of the steamer*, interested in her to the amount of the said insurance; and that she was totally lost on the 26th of November, 1846, on her passage from Allyn's Point, in Connecticut, to the city of New York. To these counts the defendants demurred specially, assigning for cause, that it did not appear that at the time of the insurance, or at the time of the commencement of the risk under the policy, the plaintiffs were interested in the vessel.

Other counts averred that the insurance was for the use and benefit of the plaintiffs, as trustees for the Railroad Company, and that, as such trustees, they were interested in the vessel at the time of her loss. To these counts the defendants demurred specially, assigning for cause, that they contained no sufficient, distinct or intelligible description of the trust referred to, or of the title of the plaintiffs as such trustees.

John Duer and Theodore Sedgwick, for the defendants.

Benjamin F. Butler and Daniel Lord, for the plaintiffs.

BETTS, J. The essential point upon which it is claimed by the defendants that the decision of the Court should be in their favor is, that the policy is not obligatory on them, because the plaintiffs had no interest in the subject-matter of the insurance at the time the policy was executed, nor when it was to take effect. The policy contains no statement touching the interest of the plaintiffs in the subject of the insurance. The character of that interest must accordingly be indicated by averments in the declaration, and each count must contain such as are essential to the maintenance of the action. The declaration here must, therefore, be held to be defective in some of its counts, if, to uphold the policy, it be necessary for the plaintiffs to show an interest in themselves

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in the subject insured, either at the date of the contract or at the commencement of the risk.

We do not propose to review the various cases cited on the argument, which declare the necessity of a subsisting interest on the part of the insured at the inception of the contract, because, in our opinion, this case does not fall within the principle involved in those decisions.

We consider these points in the construction of policies of insurance to be incontestably settled: First—They are to have a liberal and benign interpretation in behalf of the insured; Second—They are to be construed and enforced according to the plain intent of the parties, if no settled rule of law interposes to prevent; Third—Whether or not, by the general rules of insurance law, the fact that the insured party had no insurable interest in the subject insured at the time it was intended the contract should commence its operation, although he possessed such interest at the time of the loss, would render the policy invalid, yet clearly it is competent for the parties to contract with a view to such a condition of things. (3 *Kent's Comm.* 258, 6th ed.; 1 *Duer on Ins.* 159, 160, note 1; *Rogers v. Traders' Ins. Co.*, 6 *Paige*, 583, 596.) There is, however, strong color at least for the doctrine, that the party intended to be insured will be protected if he had an interest at the time of the loss, without any express stipulation to that effect, although he had no interest at the commencement of the risk. (*Hughes on Ins.* 42; 2 *Duer on Ins.* 49, § 31; *Sutherland v. Pratt*, 11 *Mee. & W.* 296; *Hancox v. Fishing Ins. Co.*, 3 *Sumn.* 132, 140, 142.)

But we place our decision in this case upon the manifest purpose of the parties, as expressed in the policy. It was a time policy on a steam-vessel, for a succession of voyages, each voyage to bear its own average. It was made at the instance of the Norwich and Worcester Railroad Company, on account of whom it might concern, the loss payable to the plaintiffs, and the interest was vested in them when the loss occurred. (*Aldrich v. Equitable Ins. Co.*, 1 *Woodb. & M.* 272, 276; 1 *Duer on Ins.* 159, 160, note 1.) Upon the state-

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ments of the contract, set forth in the declaration, we think that no stronger form of stipulation can be necessary, to render it palpable that the underwriters intended, by their agreement, to insure all the interest, to the extent of \$15,000, which should be owned in the vessel at the time of her loss within the policy, and to pay the loss to the plaintiffs for the benefit of the actual owners. The authorities are abundant to show that such a contract is legal, and that the plaintiffs, in their own right, or as trustees, are competent parties to enforce it. (*Cox v. Parry*, 1 T. R. 464; 2 *Duer on Ins.* 10, § 9; *Id.* 17, § 15; 1 *Phillips on Ins.* ch. 4, note a; *The Jefferson Ins. Co. v. Cotheal*, 7 Wend. 72; *Buck v. The Chesapeake Ins. Co.*, 1 Peters, 151; *Sutherland v. Pratt*, 11 Mee. & W. 296.) If the suit is avowedly in the name of an agent, it is only necessary for the declaration to disclose who the real parties in interest are. (*Rider v. Ocean Ins. Co.*, 20 Pick. 259; 2 *Duer on Ins.* 48, § 30.) In this case, however, there is a positive averment that, at the time of the loss, the interest was in the plaintiffs, and that fact stands admitted by the demurrer.

It was conceded, on the argument, that a policy upon an interest to be acquired after the execution of the contract is valid. This is the ordinary, and, perhaps, the most serviceable class of insurances. Cargoes can be purchased and laden from port to port, on trading voyages, under the protection of policies already in existence, without waiting for the means of obtaining satisfactory insurance after the interest is acquired. The same principle applies to the changeable proprietorship of vessels; and we have no difficulty in expounding the present policy as contemplating a succession of ownerships in the steamer, and as intended by the underwriters to cover the interest in the vessel, in whomsoever it might be vested when a loss should occur. Such a contract, explicitly entered into, is, as we have already shown, recognized as valid both by the English and American law. (*Rogers v. Traders' Ins. Co.*, 6 Paige, 583, 596; 2 *Duer on Ins.* 29, §§ 21, 22, 24; *Id.* 41, § 28; *Id.* 49, § 31; *Hughes on Ins.* 54, Am. ed. 42.)

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There would be no incongruity in this case in construing the policy as intending each separate trip of the vessel to be a distinct voyage, the risk on which would commence at its inception, because it is a time policy, in reference to a succession of voyages or passages, each of which is subject to its separate average. That interpretation of the contract would satisfy the formal rule indicated in some of the cases, that the insured must be interested at the commencement of the risk and at the time of the loss. (*Seamans v. Loring*, 1 *Mason*, 127; *Hancox v. Fishing Ins. Co.*, 3 *Sumn.* 132, 140; *Rider v. Ocean Ins. Co.*, 20 *Pick.* 259.) We are not, however, prepared to say that the propositions of law laid down in the cases just cited, necessarily flowed from the points involved in those cases. But, in our view of the present case, it is not important to scan the force of those decisions, as the defendants here are responsible upon their express undertaking, and not upon any liability implied from the relation of the parties or the subject-matter of the contract.

We think that the plaintiffs are not bound to set forth with more particularity the nature and extent of their trust. They aver that they are trustees, that the insurance was for them, and that they were interested in the vessel at the time of her loss. (*Grant v. Howard Ins. Co.*, 5 *Wend.* 200, 202.) The amount of the interest and the value of the trust are matters of evidence only, when it becomes important to inquire into either of those facts.

Judgment for plaintiffs.

THE UNITED STATES vs. CHARLES H. PARSONS.

The 22d section of the Post-Office Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 103,) which makes it an offence for any person to open any letter which shall have been in a Post-Office, or in the custody of a mail-carrier, before it shall be delivered to the person to whom it is directed, with a design to obstruct the correspondence, and for any person to secrete, embezzle or destroy any

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such letter, does not look beyond a possession of letters obtained *wrongfully* from the Post-Office or from a mail-carrier.

After the voluntary termination of the custody of a letter by the Post-Office or its agents, the rights of the real proprietor of the letter are under the guardianship of the local law, and not of that of the United States.

Where a letter, mailed at Boston and directed to a person at New York, reached the Post-Office there, and was taken by a letter-carrier for delivery: *Held* that, under § 41 of the Act of July 2d, 1836, (5 *U. S. Stat. at Large*, 89,) such letter-carrier was a mail-carrier within § 22 of the said Act of March 3d, 1825.

But, the letter-carrier having given the letter to a person in the defendant's house, the defendant not being present, and not participating in the delivery, and that person having subsequently and at a different place delivered it to the defendant, and the defendant having opened it and embezzled money from it, it not being intended for him, but for another person of the same name, the letter, however, not having come into the possession of the defendant within view of the letter-carrier, or with his knowledge, or while he remained at the place where he left it: *Held*, that the defendant was not liable to indictment under § 22 of the said Act of March 3d, 1825.

All action and authority of the Post-Office Department, in respect to the letter, terminated with its delivery to the third person, and § 22 of the Act applies only while the letter is within the power and control of that Department.

Whether Congress has power to pass laws governing the conduct of persons in respect to letters which have been mailed, after such letters have become strictly disconnected from the Post-Office Department, *quære*.

(Before NELSON and BETTS, JJ., Southern District of New York, April, 1849.)

THE defendant was indicted under § 22 of the Post-Office Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 108,) which provides that any person who shall open any letter or packet which shall have been in a Post-Office, or in custody of a mail-carrier, before it shall have been delivered to the person to whom it is directed, with a design to obstruct the correspondence, or to pry into another's business or secrets, or shall secrete, embezzle or destroy any such mail, letter or packet, shall, on conviction, be fined not exceeding five hundred dollars, and be imprisoned not exceeding twelve months.

At the trial, a special verdict was found by the jury, that a letter was put into the Post-Office at Boston, directed to Charles H. Parsons, at the city of New York, and containing another letter addressed to Ann M. Parsons; that in the

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letter were inclosed thirty-three dollars in bank bills; that the mailed letter reached the Post-Office in New York, was taken by a letter-carrier for delivery, and was given by him to a person in the house of the defendant, the defendant not being present, and not participating in the delivery; that that person subsequently, and at a different place, delivered it to the defendant; that the defendant opened both letters, and embezzled the money enclosed; that the letter addressed to Charles H. Parsons was not intended for the defendant, but for another person bearing the same name; and that the letters did not come into the possession of the defendant within view of the letter-carrier, or with his knowledge, or while he remained at the place where he left them.

Lorenzo B. Shepard, (*District Attorney*), for the United States.

Alanson Nash, for the defendant.

BETTS, J. The facts found by the special verdict are within the *letter* of the statute. The letters had been in a Post-Office, and were opened, and their contents embezzled by the defendant, before they had been delivered to the persons to whom they were directed. The special verdict, however, raises the question, whether the intent and proper construction of the 22d section of the Post-Office Act of March 3d, 1825, embraces the case.

The 41st section of the Act of July 2d, 1836, (5 *U. S. Stat. at Large*, 89,) gives to persons entrusted with the delivery of letters the character of mail-carriers, within the meaning of the 22d section of the Act of 1825. Therefore, the letters in question in the present case, while in charge of such letter-carrier, are to be regarded as in the Post-Office, or in the custody of a mail-carrier. What, then, is the true import and force of the phrase, "shall have been in a Post-Office or in custody of a mail-carrier," and of the phrase, "before it shall have been delivered to the person to whom it is direct-

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ed"? Are they of unlimited extent, covering every condition of a letter, until it reaches its rightful destination? To give the language this construction, would be to continue letters which had been once in the mail still under the power and control of the Federal Government, in every change and transfer from person to person and place to place, and without limitation of time. Legislation of such scope and extent would clearly not be in furtherance of the functions and duties of the Post-Office Department, but in protection of the private property of individuals, after it had become detached from that Department, and was wholly out of the charge of its agents. Such legislation would thus necessarily take the quality and form of a municipal regulation, governing the relations and responsibilities of individuals to each other, in respect to letters and their contents which had been in the Post-Office, although not obtained from the Post-Office or any of its agents, or in the possession of a party through any act of fraud or deceit against the Post-Office laws. And Congress would thus in effect be invested with the power to compel every person into whose possession a letter which had been in the Post-Office should come, to take upon himself the responsibility of carrying and delivering it to the person to whom it should be directed.

We think that the object of this 22d section does not look beyond a possession of letters obtained wrongfully from the Post-Office or from a letter-carrier. Its design is to guard the Post-Office and its legitimate agents in the execution of their duties, in the safe-keeping and delivery of letters. After the voluntary termination of the custody of a letter by the Post-Office or its agents, the property in and right of possession to it belong wholly to its real proprietor, and his rights are under the guardianship of the local law, and not of that of the United States.

The delivery of the letter in the present case by the letter-carrier was to a person at the house, as was supposed by both, of the person to whom it was directed. The defendant was not then at the house, and in no way participated in

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the delivery. The person who received the letter supposed that it belonged to the defendant, and afterwards carried it and delivered it to him at a different place, as being rightfully his. All action and authority of the Post-Office Department, in respect to the letter, terminated with its delivery to that third person; and, in our opinion, it was not intended that the act of Congress in question should apply any longer than while the letter should be within the power and control of that Department. From that time the law of the State takes authority over it, as the property of one of its citizens.

A question was raised on the argument, as to the power of Congress to legislate on the subject indefinitely, and to pass laws governing the conduct of persons in respect to letters which have been mailed, after such letters have become entirely disconnected from the Post-Office Department. But the construction we have given to the act, limiting its operation to letters yet remaining under the authority of the Department, renders it unnecessary to consider this question.

Judgment for defendant.

THE UNITED STATES vs. NELSON C. MARSELIS.

To constitute a *Post-Office* under § 22 of the Post-Office Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 108,) the place where the business of keeping, forwarding and distributing mailable matter is conducted need not be a building set apart for that use, or any apartment or room in a building; but, according to the extent of the business done, may be a desk, or a trunk or box carried about a house, or from one building to another.

The place of the deposit of the mailable matter would, in this sense, constitute the *Post-Office*, and anything taken out of that place of reception or keeping would be taken *from or out of the Post-Office*, within § 22 of said Act, without regard to the distance of removal, or to circumjacent enclosures or rooms.

If a person takes a letter containing money, in a Post-Office building, from and out of that part of it appropriated to the deposit of the letter, with intent to convert its contents to his own use, he is guilty of *stealing the letter from and out of the Post-Office*, within § 22 of said Act, even though he only trans-

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fers the letter to his pocket, and does not remove it beyond the building containing the Post-Office.

But, whether he is guilty of *stealing the mail*, under the same section, *quære*.

And he is liable to be convicted under § 22 of said Act, although he was a clerk employed in the Post-Office at the time of the larceny, and although he might, perhaps, be subject to indictment for the same offence under § 21 of said Act.

(Before NIXSON and BERR, JJ., Southern District of New York, April 1849.)

THE defendant was indicted under § 22 of the Post-Office Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 108,) which provides that any person who shall steal the mail, or shall steal or take from or out of any mail, or from or out of any Post-Office, any letter or packet, shall be punished by imprisonment not less than two years and not exceeding ten.

At the trial, a special verdict was found by the jury, that the defendant was a clerk employed in the Post-Office in the city of New York, in distributing and forwarding one line of mails; that his general station was at what was called the East table, and his duty to put into the bags for the East, mailable matter, chiefly newspapers, destined for that direction; that his business was not at the city distribution table, on which letters received were placed, when taken out of the bags, to be arranged for distribution; that he was detected going from his own table to the city distribution table, taking from it two envelopes, each containing a letter, enclosing a twenty-five cent piece in silver, and putting the two letters into his pocket; that he was arrested, and the two letters were taken from his pocket; that the envelopes were addressed to the New York Post-Office, and the two letters were each post-marked at interior towns, addressed to persons in the city of New York; and that a post-bill accompanied each letter.

Lorenzo B. Shepard, (*District Attorney*), for the United States.

James T. Brady, for the defendant.

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BETTS, J. The points raised on the special verdict in this case are, whether, within the meaning of the twenty-second section of the Act of 1825, the defendant stole the mail, or the letters from or out of the Post-Office.

The terms *mail* and *Post-Office* seem, each of them, to bear, in the Acts of Congress and in general acceptance, both a generic and a specific sense. Instances are presented in sections 2, 4, 11 and 22 of the Act of 1825, of the employment of the term *mail* as embracing the whole body of mailable matter transmitted from Office to Office, and also the particular packets addressed from and received at different Post-Offices. The instructions of the Postmaster-General under the Act are to the same effect. So, also, the term *Post-Office* is applied by section 1 to the Department, which is not at all concerned in receiving and delivering letters. In its ordinary use, the term embraces the *business* of keeping, forwarding and distributing mailable matter, equally with the *place* where such business is conducted. And, manifestly, such place, to constitute a Post-Office, need not be a building set apart for that use, or any apartment or room in a building; but, according to the extent of business done, may be a desk, or a trunk or box carried about a house, or from one building to another. The place of the deposit of the mailable matter would, in this sense, constitute the *Post-Office*, and anything taken out of that place of reception or keeping would be taken from or out of the Post-Office, without regard to the distance of removal, or to circumjacent enclosures or rooms.

We do not feel called upon to define the exact signification of the word *mail*, or to determine whether the packets taken by the defendant are properly described under that denomination; for, in our opinion, judgment must, on the other point, be rendered against him upon the special verdict. He took the letters in the Post-Office building, from and out of that part of it appropriated to their deposit, with intent to convert their contents to his own use. This was an asportation sufficient to constitute larceny at common law, and consummated the offence of *stealing*, denounced by the Act of

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Congress. Furtively and feloniously removing a letter from and out of the place where it is kept in a Post-Office, is *stealing* it from and out of the Post-Office, whether the removal be beyond the building containing the Post-Office, or the abduction be no more than the transfer of the letter to the pocket of the person taking it.

We concur in the conclusion of the District Court of this District in a case heretofore pending in that Court against this same defendant,* that he is liable to conviction under

* The case referred to is that of *The United States v. Marselis*, tried in the District Court in March, 1848, in which the question arose at the trial, whether the defendant, who had, while a clerk employed in the Post-Office, taken therefrom a package enclosing a letter, with intent to steal it, was liable to indictment for that offence, under the 22d section of the Act of 1825.

In delivering the opinion of the Court upon the point, BETTS, District Judge, said :

"The United States Attorney claims to sustain the indictment in this case solely under the 22d section of the Act of 1825. It is, therefore, unnecessary to examine the provisions of the 21st section, to determine whether they comprehend the state of facts charged against the defendant.

"The cardinal objection urged against the indictment is, that Congress, in sections 21 and 22 of the Act, intended to range offenders against the Post-Office law into two classes—one class consisting of persons employed in the Post-Office, or entrusted with the custody or transportation of the mail; and the other of strangers, standing in no relation of trust or confidence to the mail or the Post-Office. If this position is sound, the defendant cannot be prosecuted under the 22d section; and, even if his offence falls within the 21st section, yet, the indictment not being framed on that section, he must be acquitted.

"The words of the 22d section embrace all persons. The terms are the most ample that could be employed:—*if any person shall steal the mail*. Now, although, in the construction of statutes, language will be understood in relation to the subject-matter, and general terms may be restricted to a very limited signification, yet the rule is, to take words in their fair and natural import, unless there be something indicated by the legislature showing an intention to employ them in a qualified sense. That intention is inferred in this case, because the 21st section is supposed to have designated every offence for which those employed in the Post-Office are subject to criminal punishment, and to have imposed on them special and aggravated penalties therefor. But, whatever force the argument might have under other circumstances, it cannot be received as of controlling weight here, because the particular offence of stealing a mail or a packet or letter from the Post-Office, does not appear to be

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the 22d section of the Act, although he was employed in the Post-Office, and might, perhaps, be subject to indictment under the 21st section of the Act.

Judgment of conviction must be rendered against the defendant upon the special verdict.

provided for in the 21st section. In that respect, therefore, the 22d section introduces a new crime, and then the legislature, in subjecting to punishment every person who commits it, must be understood to have used the language in its broadest sense. The offence is not one of a special nature, to be committed only by a particular class of persons, but it can be committed equally by every one who gains access to the mail or the letters, whether he is employed in the Post-Office or is an intruder there.

"As the enacting clause in the 22d section plainly includes in terms the case of a clerk in a Post-Office who steals a letter or packet, there must be clear ground shown for excepting him from its operation. This rule of interpretation is familiarly applied in the exposition of statutes, and has the solemn sanction of the Supreme Court of the United States. (*United States v. Fisher*, 2 Cranch, 358.) The case of *The United States v. Pearce*, (2 McLean, 14,) was an indictment under both of these sections against a person who held the appointment of Assistant Postmaster. The Court, in delivering its opinion, examined with considerable minuteness the provisions of the law, and intimated no doubt that the defendant was subject to indictment under both sections, if proper facts were proved against him; but it held him not chargeable for stealing letters under the 22d section, because he had taken them away without a felonious intent, claiming a legal right to take them from the mail or Post-Office on his appointment as deputy or assistant, although that authority had been revoked by the Postmaster.

"My opinion is, that the defendant is subject to indictment for an offence under the 22d section of the Act, and that the offence is consummated by stealing a letter, or packet containing a letter, from the Post-Office, or by taking away and embezzling such letter or packet. It is for the jury to determine whether the act is proved to have been done, and also the intent with which it was done, whether such intent be found on the proof of extraneous facts, or be implied and inferred from the act itself."

The Rhode Island.

THE RHODE ISLAND.

Whether a libellant, in Admiralty, is entitled to damages, in a case of collision, for the delay and loss of trips while his vessel is undergoing the necessary repairs, *quære*.

There is no settled rule as to whether anything should be allowed, or as to the measure by which the allowance, if any, should be determined.

In a case where no vessel was hired to supply the place of the libellant's vessel, and the District Court allowed to the libellant interest, at the rate of six *per cent. per annum*, upon the value of his vessel before the collision, for the interval after the collision until she was repaired and fitted to resume her trips, the allowance was upheld against an appeal by both parties, not as being founded on any established principle, but as being just in the particular case and as high a measure of damages as was warranted.

(Before NELSON, J., Southern District of New York, October, 1849.)

A LIBEL *in rem* was filed in the District Court against the steamboat Rhode Island, to recover for damage done to a propeller by a collision. The Court decreed in favor of the libellant, and ordered a reference to a Commissioner to ascertain the damages. The Commissioner included in the award of compensation the sum of twenty dollars a day for each day after the collision, until the damaged vessel was repaired and fitted to resume her place in the line in which she was running, as being an amount which, according to the evidence, would have enabled her owner to supply her place with a vessel to perform her trips during such interval. No vessel was hired to supply her place. On exception, the District Court set aside that allowance, and sent the report back to the Commissioner, with a direction to ascertain the value of the damaged vessel before the collision, and to allow upon that amount, as capital invested in her, interest at the rate of six *per cent. per annum* for such interval, instead of the former allowance. A decree having been entered upon that basis in the District Court, both parties appealed to this Court.

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Francis B. Cutting and Edward H. Owen, for the libellants.

Washington Q. Morton and Alexander Hamilton, Jr., for the claimants.

NELSON, J. The principal question in this case is, whether a libellant is entitled to damages, in a case of collision, for the delay and loss of trips while his vessel is undergoing the necessary repairs. I do not understand the direction given to the Commissioner by the Court below, as intended to be laid down as a general rule to govern all cases of the kind, but as an approximation to an indemnity in the particular case, under its peculiar circumstances. It was an allowance for a supposed or apparent loss, incident to the damage done by the collision, in regard to which no settled rule can be found; opinions being conflicting whether anything should be allowed, and, if anything, by what measure the allowance should be determined. The difficulty is intrinsic, arising out of the nature of the loss; as its precise amount, or even a reasonable approximation to it, cannot be ascertained by the application of any known or fixed rule. On this ground, the damage was denied altogether in an analogous case in the Supreme Court of New York. (*Blanchard v. Ely*, 21 Wend. 842.) That some loss enters into the general damage to the vessel, on account of the time necessarily consumed in making repairs upon her, is obvious enough; and that loss results directly from the injury. But the difficulty lies in finding any rule by which to ascertain the amount with the certainty required by law; it being contingent and speculative, and depending upon the profits of the business in which the vessel is engaged.

If, in this case, the owners of the injured vessel had hired another one of the kind, for a reasonable compensation, to supply her place while she was undergoing repairs, there might be something tangible in the amount thus actually paid for the purpose of continuing the business. I do not say that the allowance would then be free from difficulty, or

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that it could be brought within any fixed rule of law. All I mean to say is, that there would then be less embarrassment in the allowance than there is in the case before me, where the party did not see fit to assume the risk and responsibility of a substitute. The character and profits of the business were, doubtless, the grounds upon which the owners of the injured vessel were to determine whether it was expedient for them to go to the expense and trouble of procuring another vessel. If they had chosen to do so, the risk of profit or loss therefrom would, perhaps, have been one which they would have had a right to assume. And, in such a case, as the expense of procuring the new vessel would have been occasioned by the collision, there would have seemed to be some propriety in allowing it as an item of damages. But these considerations do not enter into the case when no substitute has been procured.

I do not intend, however, to determine how far the Court would feel itself justified, where another vessel had been actually employed, in allowing the sum paid for her hire. There are difficulties attending the question, which should lead to caution and hesitation in the adoption of that sum as the measure of compensation. The inquiry might arise, for instance, in a case where another vessel was not procured, whether it was practicable to procure one; for, if it was not, after a fair endeavor, an allowance upon the basis of the sum necessary to procure one, would seem to be as reasonable as the allowance of the sum actually paid where one had been in fact obtained.

Upon the whole, I am not inclined to interfere with the allowance as made; not because I think it founded upon any established principle, but because it is just enough in itself, and I have not been able to find any principle that would justify the adoption of a higher measure of damages in the case.

Decree affirmed.

JOHN A. BRADSTREET vs. JAMES HERAN AND OTHERS.

Where a bill of lading of bales of cotton describes them as "in good order and well-conditioned," those words have reference to the external condition of the cotton, and import that it was in good shipping condition at the time it was received on board of the vessel, but do not warrant the internal condition of the cotton in the bales.

Where cotton in bales was shipped at New Orleans for New York, and the master of the vessel gave a bill of lading for the cotton as "in good order and well-conditioned" when received on board the vessel, and it was in bad shipping condition when it arrived at New York, a large part of the bales being old and rotten, and badly torn and damaged, and the cotton being consequently soiled and damaged by exposure, and it appeared that the effects of this damage upon the external state of the cotton were developed at New Orleans before it was shipped: *Held*, on a libel *in personam*, in Admiralty, by the master against the consignees of the cotton, to recover the freight, that, as the damage to the cotton exceeded the freight, the libel must be dismissed.

Held, also, that as the consignees had made large advances upon the cotton on the faith of the representation in the bill of lading, that it was shipped "in good order," their security, as *bona-fide* purchasers, ought not to be lessened or impaired by permitting the master to contradict that representation.

Held, also, that although the cotton might have been sold for an excess beyond the advances, sufficient to cover the freight, the consignees were entitled to it in the condition described in the bill of lading, as security for their advances, without regard to the fluctuations of the market, or to sales to be made at any particular state of it.

(Before NELSON, J., Southern District of New York, October, 1849.)

JOHN A. BRADSTREET, master of the bark Lowell, filed a libel *in personam* in the District Court, against Heran, Lees & Co., of New York, to recover a balance due him for freight on five hundred and seven bales of cotton shipped by that vessel from New Orleans to New York, and consigned to the respondents. The libellant had signed a bill of lading for the cotton on its shipment, which admitted that it was received on board the vessel at New Orleans "in good order and well-conditioned," and stipulated that it should be delivered "in the like good order and condition at the port of

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New York, the danger of the navigation only excepted." The respondents, who had advanced a large amount upon the cotton on the faith of the bill of lading, set up, in answer to the libel, that the cotton was not delivered at New York in good order and well-conditioned, and that the damage to it exceeded the balance of the freight. The District Court held that the libellant was responsible to the respondents for the damage to the cotton, and, that being proved to equal the balance of freight claimed, the libel was dismissed. The libellant then appealed to this Court. All the material points of the evidence are stated in the opinion of the Court.

Edwin Burr, for the libellant.

Oscar W. Sturtevant, for the respondents.

NELSON, J. It is admitted that the words, "in good order and well-conditioned," in the bill of lading, have reference to the external condition of the cotton, importing that it was in good shipping condition at the time it was received on board of the vessel, but not referring to or warranting the internal quality or condition of the cotton in the bales. The question, therefore, is, whether the damage sustained by the cotton arose from defects in the bagging of the bales or the manner of securing them from external injuries while being transported, or existed in the shape of external damage, at and previous to the loading of the cotton on ship-board, having been occasioned by its exposure to rain or wet, without proper protection, or by any other ill usage in its interior transportation before it reached the ship, and which was readily visible on inspection; or whether the damage was occasioned by the internal bad condition of the cotton, which was invisible to the eye at the time of shipment, and could only be detected by cutting and inspecting the bales.

The damage to the cotton was what is called "country damage," which results often from the bad condition of the cotton when it is baled, or from its exposure to bad weather,

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or from ill usage in its interior transportation, and is not discoverable from an inspection of the bales at the time of shipment. Upon the question, from what the damage in this case arose, the testimony is somewhat conflicting; but it establishes generally, that the cargo was in bad shipping condition when it arrived and was delivered at New York, and that a large part of the bales were old and rotten, and badly torn and damaged, and the cotton therein consequently broken and disordered, and to some extent soiled and damaged by exposure in the shipment and delivery. The picker, who overhauled some two hundred of the bales and put them in order, states, that the cotton was in bad order; that some of the bales were rotten; that several had burst open for want of proper ropes; that others had the bagging torn; and that a portion of the bagging was old and rotten, and a portion damaged by wet. What is termed "country damage" arises, in many instances, out of the condition of the cotton at the time it is baled, being wet, or not properly fitted for transportation, and is invisible to the eye on inspection at the time of shipment. But, in this case, the weight of the evidence shows satisfactorily that the effects of the "country damage" upon the external state of the cotton were developed at New Orleans before the cargo was put on board, and that the master was negligent and inattentive to its shipping order in this respect, or he would not have accepted it as "in good order and well-conditioned." The voyage was but some twenty days—a period of time hardly sufficient to account for the condition of the bales at the time of their delivery at New York, on the ground of concealed "country damage." On this ground, therefore, the decree of the Court below should be affirmed.

The consignees made large advances upon the cotton, on the faith of the representation in the bill of lading that it was shipped in good order. They were justified in doing so, and their security should not be lessened or impaired by permitting the master to contradict his own representation in that instrument. It might be otherwise if the question arose

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between the master and the owner of the cotton. The question of damage might, in that case, be well limited to that accruing in the course of the voyage, notwithstanding the bill of lading. But the respondents stand in the light of *bonâ-fide* purchasers, who become such on the faith of the representations of the master. It is true, that it may be shown that the cotton could have been sold for an excess beyond the advances, sufficient to cover the amount in controversy. But that does not satisfy the principle; for the respondents were entitled to the cargo in the condition described in the bill of lading, as security for their advances, without regard to the fluctuations of the market, or to sales to be made at any particular state of it.

Decree affirmed.

 THE UNITED STATES vs. THE SHIP RECORDER.

Where a vessel was seized by a Collector for an alleged violation of the navigation laws of the United States, but was discharged from arrest by this Court on a hearing of the libel filed against her, on the ground that the statute had not been violated, and the Collector afterwards applied to the Court, under § 1 of the Act of February 24th, 1807, (2 *U. S. Stat. at Large*, 422,) for a certificate of reasonable cause for the seizure, and it appeared that the vessel was seized upon a construction of the statute adopted by the Secretary of the Treasury, in conformity with the opinion of the Attorney-General, and that the Collector acted under the instructions of the former officer in making the seizure: *Held*, that the certificate must be granted.

It makes no difference whether the Collector acted under a mistake as to facts on which he had reason to rely, or as to the law.

A reasonable ground of suspicion is reasonable cause for a seizure.

Where the application for the certificate was not made until more than two years and four months after the decision of the cause, and until after the claimant had brought suit against the Collector for the seizure: *Held* that, although the lapse of time was not a bar to the application, yet, as there had been laches in not making it until after the claimant had brought such suit and incurred consequent expenses, those costs must be paid him.

(Before NELSON and BETTS, JJ., Southern District of New York, November 28d, 1849.)

THIS was an application on the part of the Collector of the port of New York, for a certificate of reasonable cause of seizure. The application was made in pursuance of the provisions of the 1st section of the Act of February 24th, 1807. (2 *U. S. Stat. at Large*, 422.) The vessel had been seized by the Collector as forfeited to the United States under the Act of March 1st, 1817, (3 *U. S. Stat. at Large*, 351,) for an alleged violation of that Act, and a libel filed praying her condemnation. On demurrer to special pleas, the vessel was ordered to be discharged from arrest and delivered up to the claimants. (1 *Blatchf. C. C. R.* 218.) This application was not made until more than two years and four months after the decision of the cause, and until after the claimants had brought suit against the Collector for the seizure.

BETTS, J. The omission to apply for this certificate on the decision of the cause, or for the period which has since elapsed, is not set up as a bar to the application; and the motion must stand, as to its merits, on the same footing as if it had been made at the earliest appropriate opportunity.

The seizure of the vessel was made upon a construction of the Act of March 1st, 1817, adopted by the Secretary of the Treasury, in conformity with the opinion of the Attorney-General. This Court decided, on the hearing of the cause, that there had been no violation of the statute, and discharged the vessel from arrest. The case turned upon the construction of the statute, and of the Convention between the United States and Great Britain, of July 30th, 1815, (8 *U. S. Stat. at Large*, 228,) and presented points of considerable intricacy and difficulty. The official opinion of the law officer of the Government to the head of a Department, and the instructions of that Department to the Collector, afforded to that officer a fair reason for believing that the law had been infringed, and will, in a moral point of view certainly, excuse his having obeyed those instructions in seizing the vessel.

It makes no difference whether the Collector acted under a mistake as to facts on which he had reason to rely, or as to

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the law. This has been explicitly settled by the Supreme Court. (*The United States v. Riddle*, 5 *Cranch*, 311.) The Court say: "A doubt as to the true construction of the law is as reasonable a cause for seizure as a doubt respecting the fact." A reasonable ground of suspicion, less than evidence which would justify a condemnation, is probable cause for a seizure. (*Munns v. Dupont*, 3 *Wash. C. C. R.* 31; *Locke v. The United States*, 7 *Cranch*, 339; *The George*, 1 *Mason*, 24.)

We think that the Collector is entitled to a certificate of probable cause. But, as there has been laches in not applying for it until after suit has been brought by the claimants and expenses have consequently been incurred by them, we shall direct that those costs be paid them.

BRISSAC & DE FONTAINE vs. CORNELIUS W. LAWRENCE.

In an action against a Collector of the customs, to recover the value of goods lost while on deposit in a Custom-House warehouse, under the provisions of the Act of August 8th, 1846, (9 *U. S. Stat. at Large*, 53,) no recovery can be had unless it appears that the defendant was guilty of actual personal negligence in regard to the safe-keeping of the goods, and that, in consequence of such personal negligence, they were lost.

Such negligence in the Collector cannot be inferred from the mere loss of the goods. Whether such inference would be proper in an action against the store-keeper who had charge of the goods, *quære*.

The Collector is not personally responsible for the negligence of his subordinates in the Custom-House department.

The rule stated, as to the responsibility of a Collector for losses occurring through defects in the regulations established by the Treasury Department for the transaction of the business of the customs.

The fact that the bookkeeper in the warehouse was intoxicated daily, is not enough to render the Collector liable for a loss of goods stored in the warehouse, but it must be shown that the goods were lost from that particular cause.

(Before NELSON, J., Southern District of New York, June, 1850.)

THIS was an action tried before NELSON, J., to recover the value of a case of goods that was lost while in one of the

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Custom-House warehouses in New York, during the time the defendant was Collector of that port. The facts were these: The goods were shipped by the plaintiffs, at Havre, consigned to a firm in New York, and, on their arrival, were deposited in one of the Custom-House warehouses there, under the provisions of the Act of August 6th, 1846, (9 *U. S. Stat. at Large*, 53,) and were either lost or mislaid therein, or were delivered therefrom to some person not entitled to them. For the purpose of establishing personal negligence on the part of the defendant, the plaintiffs, on the trial, gave evidence tending to show, that the manner in which the books containing the accounts of goods received at and delivered from the warehouse were kept was imperfect, and they claimed this to have been carelessness on the part of the defendant, as the head of the customs department. They also proved that the bookkeeper at the warehouse was a person of intemperate habits, and unfit for that situation. The defendant proved that the books were kept in conformity with the mode usually adopted at the time for keeping books of that kind; that the intemperate bookkeeper had been discharged; and that, during a period of nineteen months, out of two hundred thousand packages of goods which had been received at the warehouse in question, only two packages had been lost.

Francis B. Cutting and *William Emerson*, for the plaintiffs.

Benjamin F. Butler and *William Allen Butler*, for the defendant.

NELSON, J., charged the jury in substance as follows:

There is but one question of fact for you to determine, on the ground assumed by the plaintiffs as entitling them to recover. It is, whether or not the Collector was guilty of personal negligence in respect to the case of goods which was lost. The question is not, whether there was any negligence

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which resulted in the loss of the goods. No doubt there may have been such negligence. But the question is, whether the defendant himself, as Collector, was personally guilty of negligence in regard to the safe-keeping of the goods, and whether, in consequence of such personal negligence, they were lost. The Act of August 6th, 1846, (9 *U. S. Stat. at Large*, 53,) makes it imperative on the Collector to order goods to be deposited in a warehouse, if the importer desires it. The Collector has no discretion in the matter, because the importer has the right to have his goods so deposited in order to suspend the payment of duties on them. Under this law, the goods in question were deposited in the warehouse by the plaintiffs, and were lost.

The evidence of such negligence on the part of the defendant as will sustain the plaintiffs' right to recover, must be made out by testimony on the part of the plaintiffs. The fact of such negligence must not be inferred from the mere loss of the goods. The Collector is not personally responsible for the negligence of his subordinates in the Custom-House department, and, therefore, he is not responsible for the negligence of persons employed in the warehouse department. Negligence, as an inference of law from the fact of the goods having been lost, might be the rule, if the action were against the storekeeper who had charge of the goods; but, in order to charge the defendant with the loss, it is necessary that the plaintiffs should satisfy you, by affirmative and reasonable testimony, that the Collector was personally guilty of negligence in the discharge of his duty, either by misdeed or by omission.

It has been urged by the counsel for the plaintiffs that this case is substantially one between the plaintiffs and the Government, that the defendant has no personal interest in the matter, and that, if a recovery is had against him, he will be indemnified by the Government. Such a suggestion does not properly belong to the case. It is possible that, if a recovery is had against the Collector, and if the Government shall regard the recovery as wrong, it may think itself bound

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to indemnify its officer. But it requires only a moment's reflection to see, that no Government could ever adopt, acknowledge or practice the general principle of standing by its officers in every case where, by their own personal wrong, they become liable to loss. The plaintiffs ask for a verdict on the ground that the officer has been negligent of his duty, and yet, at the same time, they assume that the Government will indemnify him for the consequences of his negligence. Such a principle would sap the foundation of all government, and would not only sanction negligence, but would offer a bounty for it. Therefore, the ground on which the plaintiffs claim to recover against the defendant necessarily repudiates the idea that he will be indemnified by the Government. You must, then, assume the correct principle in regard to public officers thus prosecuted to be, that if they are made responsible on the ground of negligence, they must not expect indemnity from the Government, but must pay out of their own pockets any recovery that is had against them. You must consider this case as if it were one between the plaintiffs and a private individual against whom an action had been brought for a personal wrong against his neighbor. In that aspect, you must inquire whether the plaintiffs have sufficiently satisfied your consciences and judgments, as indifferent jurors, that the defendant was guilty of actual personal negligence respecting the goods in question.

It is urged by the plaintiffs that the Collector had, in his public official capacity, the entire superintendence, control and management of the warehouse department; that all his subordinates were directly responsible to him; that he was the person charged with the establishment of the regulations under which the business was to be conducted; and that, if those regulations contained any defects or imperfections which might lead to the loss of goods, the neglect or omission or failure on his part to establish such a system as would cause the business to be carried on with perfect regularity, should render him responsible. The Collector is, indeed, the head officer of the Custom-House department, with whom the

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Secretary of the Treasury corresponds in relation to the duties of the department. And the Collector has considerable power in his official capacity. But he executes his duties in subordination to the Treasury Department of the Government, and the instructions of the Secretary of the Treasury are controlling upon him. What, then, is the ground on which the defendant is sought to be charged with actual negligence as regards the goods in question? It is said, and the fact may be conceded, that the system created by the Act of 1846 was an imperfect one. According to the provisions of that Act, it was the duty of the Secretary of the Treasury to make regulations and require obedience to them. Now, assuming that there were defects in the system when it was first established, is that any proof of malfeasance or negligence on the part of the defendant? The system went into operation in March, 1847, and it was in a short time reduced to better order, under the experience of the storekeeper. It required some time to apply the law practically to the business conducted under it, so as to secure the safe-keeping of the goods. It does not appear that there was any great delay in discovering the want of a better system and in supplying it. And yet the plaintiffs contend that the fact that at the very commencement the most perfect system was not put in operation by the Collector, who is subordinate to the Secretary of the Treasury, lays the foundation for inferring personal negligence on the part of the Collector.

The other ground urged, as showing negligence on the part of the defendant is, that the bookkeeper was intemperate and was discharged. This would seem to be an item of testimony, showing diligence on the part of the defendant in the discharge of his duties. But, according to the counsel for the plaintiffs, if, out of the whole number of subordinates whom the Collector selects, there is one who, without the Collector's knowledge, is an intemperate person, that fact alone is to be taken into account to prove the Collector guilty of actual negligence. And it is urged that, even though the man may have been a sober man when he was employed, yet if,

during his employment, he acquires habits of intemperance, the fact that the Collector selected a man who was capable of becoming intemperate, goes to show that he was guilty of negligence. But, assuming that a case of intemperance is made out as respects the bookkeeper, the fact that he was intoxicated daily would not alone render the Collector responsible for the loss of the goods. The plaintiffs must go further, and must show that the goods were lost from that particular cause. But the proof shows that the books were well kept, according to the system then in use. The ledger contained an entry of the receipt of the goods, being the usual record in cases of the kind. There was no entry of the delivery of the goods.

These are the grounds on which the Collector is charged with negligence, and it is necessary to distinguish between the negligence of the Collector and that of his subordinates. In a suit against the storekeeper, or against a subordinate officer who had the care of the goods, it might with more reason be urged that there must have been negligence, or the goods could not have been improperly delivered. But this is a suit against the Collector, who did not have charge of the goods, and, in order to render him liable, you must find him to have been guilty of personal neglect, misfeasance or wrong. Even as regards the subordinate who had charge of the goods, the testimony shows that, during nineteen months, two hundred thousand packages of goods were received into and delivered from that particular warehouse, and but two packages, or only one out of one hundred thousand, were lost or mislaid. This is evidence of diligence and care on the part of the person who had the immediate charge of the goods, and a jury would undoubtedly hesitate before they would be willing to charge with negligence any person in the department. But, in view of the fact that the Collector of New York has charge of all the business from which two-thirds of the entire revenue of the United States is collected, and has thousands of subordinates, and upon the evidence that only one package out of every one hundred

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thousand which passed through the hands of those subordinates has been lost, it is strange that this case has been so urgently pressed, with the idea that, upon any principle of equity, much less of law, there could be any liability on the part of the Collector.

The jury found a verdict for the defendant.

THE UNITED STATES, PLAINTIFFS IN ERROR,

v8.

ABEL B. SMITH, DEFENDANT IN ERROR.

The 1st section of the Act of March 2d, 1821, (3 *U. S. Stat. at Large*, 616,) as re-enacted by the Act of March 3d, 1823, (*Id.* 781,) which imposes a penalty for bringing into the United States from adjacent territory goods subject to duty, and not delivering a manifest thereof at the nearest Collector's office, is not repealed by § 19 of the Act of August 30th, 1842, (5 *Id.* 565.)

The first two Acts and the last Act provide for a very different class of offences. The former attach the penalty to the mere neglect to deliver a manifest, no matter what the intent. In the latter, there must be an intent to defraud the revenue, and either smuggling or an attempt to pass a fraudulent invoice.

The Act of 1821 does not require either a formal entry at the Collector's office or an invoice, and the system established by it is a distinct one, applicable to the frontiers adjacent to foreign territories.

The Act of 1842 is aimed at frauds on the revenue, in cases where an entry of goods and an invoice are required, as prescribed by the Act of March 1st, 1823, (3 *U. S. Stat. at Large*, 729.)

(Before NELSON, J., Northern District of New York, October 7th, 1850.)

THIS was a writ of error to the District Court. The action was debt, brought by the United States against Smith, to recover a penalty under the Acts of Congress passed March 2d, 1821, and March 3d, 1823, (3 *U. S. Stat. at Large*, 616 and 781.)

The declaration set forth, in substance, that the defendant brought from Canada into the United States, in the collection district of Cape Vincent, certain goods and merchandise

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subject to duty, and neglected and refused to deliver a manifest thereof at the nearest Collector's or Deputy-Collector's office, and passed by and avoided such office, contrary to the provisions of the Acts of Congress above referred to; and claimed the penalty of four times the value of said merchandise. The defendant pleaded *nil debet*.

On the trial, the counsel for the defendant admitted that a cause of action had been made out, and that the United States were entitled to recover according to the case as presented by the declaration; but insisted that the penalty imposed under the Acts of 1821 and 1823 had been abrogated by the 19th section of the Act of Congress of the 30th of August, 1842. (5 *U. S. Stat. at Large*, 565.) The Court so ruled, to which ruling the plaintiffs excepted, and, after verdict and judgment for the defendant, they brought a writ of error.

James R. Lawrence, (*District Attorney*), for the plaintiffs in error.

Bernard Bagley, for the defendant in error.

NELSON, J. By the 1st section of the Act of March 2d, 1821, it is made the duty of the masters of vessels, except registered vessels, and of every person having charge of any boat, &c., and of the conductor or driver of any carriage or sleigh, and of every other person coming from any foreign territory adjacent to the United States, into the United States, with merchandise subject to duty, to deliver, immediately on his arrival within the United States, a manifest of the cargo or loading of such vessel, boat or carriage, or of the merchandise so brought from the foreign territory, at the office of any Collector or Deputy-Collector which shall be nearest the boundary line, &c.; and every such manifest shall be verified by the oath of the person delivering the same, which shall state that such manifest contains a full, just and true account of the kinds, quantities and values of

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all the merchandise so brought from the foreign territory ; and it is provided that, in case of neglect or refusal, or of passing by or avoiding the office, the said merchandise, together with the vessel, boat or carriage, shall be forfeited to the United States, and the person offending shall be subject to a penalty of \$400.

The Act of March 3d, 1823, substantially re-enacts this provision, changing the penalty of \$400 to a penalty of four times the value of the merchandise.

The 19th section of the Act of August 30th, 1842, provides, that if any person shall knowingly and wilfully, with intent to defraud the revenue of the United States, smuggle or clandestinely introduce into the United States any goods, wares or merchandise subject to duty, and which should have been invoiced, without paying or accounting for the duty, or shall make out, or pass or attempt to pass through the Custom-House, any false, forged or fraudulent invoice, every such person, &c., shall be deemed guilty of a misdemeanor, and, on conviction, shall be fined not exceeding \$5,000, or imprisoned for a term not exceeding two years, or both.

The question presented is, whether this section has the effect necessarily to repeal the aforesaid provisions of the Acts of 1821 and 1823. If it has, it must be by implication, on account of the repugnancy and inconsistency of the two provisions, as there is no repeal in express terms ; and, in order to ascertain this, it will be material to compare the two Acts, and ascertain with care their import and effect.

The offence, in the Acts of 1821 and 1823, consists in the neglect or refusal to deliver at the office of the Collector, or of his deputy, nearest the boundary line, or nearest the road or waters by which the goods are brought, the manifest prescribed in the Act, of merchandise subject to duty brought into the United States from an adjacent foreign territory ; or, the passing by and avoiding such office. The simple neglect or refusal to deliver the manifest, under the circumstances stated, or the passing by and avoiding the office, constitutes the offence, and subjects the party to the penalty. The

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intent which accompanies the neglect or refusal, or the passing by and avoiding the office, is not made an element of the offence, or the subject of inquiry on the trial. If the fact of neglect or refusal appears, the penalty follows.

The offence, in the Act of 1842, consists in knowingly and wilfully, and with an intent to defraud the revenue, smuggling or clandestinely introducing into the United States merchandise subject to duty, and which should have been invoiced, without paying or accounting for the duty; or, the making or passing, or attempting to pass, at the Custom-House, a false, forged or fraudulent invoice. The act must be smuggling or clandestinely bringing into the United States merchandise subject to duty; and it must be done with a wilful intent to defraud the revenue. These are essential elements to constitute the offence, and must be established on the trial, to warrant a conviction.

Now, it seems to me that this analysis and comparison of the two Acts shows that they provide for an entirely distinct and different class of offences, depending upon a totally different state of facts and circumstances, and are to be regarded as separate and distinct parts of the system of the Government to prevent evasion and fraud in collecting the revenue. Their only identity consists in their object and purpose, to wit, to guard the customs. But, in this there is no repugnancy; as penal acts for this purpose in the statute book are numerous and constantly enforced. The repeal of a statute by implication is not favored by the Courts, and is never allowed unless the repugnancy is plain and unavoidable, so that the two Acts are incapable of being reconciled. (*Wood v. The United States*, 16 *Peters*, 342.) Here, both statutes may well stand together, as the acts constituting the offence in the former are not covered by the latter. The former prescribes particular regulations to be observed on the frontiers by the importers of foreign merchandise, with a view to guard the revenue, annexing a penalty in case of a non-observance. The violation of these comes far short of making out the offence under the latter. Both are directed against

the importation of foreign merchandise without payment of the duty, but under a different state of facts and circumstances, and prescribing a punishment according to the aggravation of each case respectively. Hence, where the act is done knowingly and wilfully, and with an intent to defraud, fine and imprisonment are annexed.

It is not necessary to say that the latter act is cumulative; indeed, it cannot be properly so regarded, because it is not for the same offence. Neither is it necessary to say that the party could be punished under each statute for the same importation of merchandise. That is a very different question from the one presented, and which I have been considering. The same act, committed under different circumstances, may be the subject of different degrees of punishment, as an assault, and an assault with intent to kill; but, it by no means follows that the party is punishable by the infliction of each penalty.

But, independently of the above views, there is also another upon which I am of opinion that the judgment below must be reversed.

By the 19th section of the Act of 1842, the punishment is inflicted for smuggling goods subject to duty, *and which should have been invoiced*; and for making, or passing or attempting to pass at the Custom-House, *false, forged or fraudulent invoices*.

The Act of Congress of the 1st of March, 1823, (3 *U. S. Stat. at Large*, 729,) requires that an invoice shall be delivered to the Collector when an entry of goods is made at the Custom-House, giving to him, in certain cases, a limited discretion as to the time when it is to be produced; and it is against the smuggling of goods which, if regularly imported, should have been accompanied with this invoice, and against the fabrication of fraudulent invoices, that the 19th section of the Act of 1842 is directed.

Now, the Act of 1821 refers to a different class of importations. No formal entry by the importer need be made at the office, *nor need the goods be accompanied with an invoice*.

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All that is necessary is the delivery of the manifest prescribed by the Act, at the office of the Collector, or of his deputy, nearest the boundary line, or nearest the road or waters by which the goods have been brought, together with the verification of the same. Upon this being done, the duties are paid or secured. The Act dispenses with the invoice.

If, in view of the Act of March 1st, 1823, which requires that an invoice should accompany the entry of goods at the Custom-House, there could be any doubt that the construction I have put upon the Act of 1821 is correct, all doubt is removed by the Act of March 3d, 1823, which, though passed after the Act of March 1st, 1823, yet substantially re-enacts the 1st section of the Act of 1821, and changes the penalty, thereby re-affirming that Act, which dispenses with the invoice.

It is apparent that an essential element to constitute the offence under the 19th section of the Act of 1842 is wanting, in the importation of goods provided for in the Act of 1821. There is nothing in the latter Act requiring that they should be invoiced. The system is a distinct one, applicable to the frontiers adjacent to foreign territories.

I am constrained, therefore, to differ from the Court below, and to reverse the judgment there rendered.

Judgment reversed, and *venire de novo*.

ERASTUS WILBUR vs. MATHER BEECHER.

The invention covered by Montgomery and Harris' patent of the 12th of August, 1840, for an "improvement in the mill for breaking and grinding bark," is a multiplication of the grinding-chambers and apparatus in a mill of a given size, and which may still be driven by the same power as a mill of a single chamber.

It appearing that a mill constructed according to the specification of the patent, with three grinding-chambers, would grind, when not in very rapid operation, say at a speed of 50 or 60 revolutions in a minute, a cord of bark an hour through the day, being double the quantity ground by the old

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single-chambered mill: *Held*, that that was evidence enough of the utility of the invention.

On the point of the utility of an invention, the question is not, whether the machine invented is the best one known to the community, nor whether it does its work better or faster than any other machine in the same department of labor, but whether it is, to a certain degree, useful.

In this case, the thing discovered and described was the formation of grinding-chambers, by the combination of movable conical rings with stationary cylinders, these two parts being severally brought together and fastened by cross-bars; the particular description in the specification showed a mill with three grinding-chambers; but the claim was to the combination of stationary cylinders with one or more movable conical rings, thus allowing both cylinders and rings to be multiplied to any extent, or the mill to be limited to two cylinders and one ring: *Held*, that any further particular description in the specification was unnecessary, in order to enable a mechanic of ordinary skill to make a mill with more chambers than three.

A bark-mill that multiplies the grinding-chambers by a combination of movable conical rings with stationary cylinders is an infringement of Montgomery and Harris' patent.

The shape of the grinding-chambers and the form of the teeth in the mill are no part of the patented combination, and, therefore, although the defendant's mill, by a change in those points, grinds better and faster than the patented mill, yet, if it contains the combination of the movable conical nuts with the stationary cylinders, it is still an infringement.

The case of *Parkhurst v. Kinsman*, (1 *Blatchf. C. C. R.* 488,) cited and applied.

The plaintiff, in a patent suit for making and selling, is entitled to the actual damages he has sustained by the infringement, or, in other words, to the profits the defendant has made thereby; for the law presumes, that if the defendant had not put his machines into the market, the demand would have been for the plaintiffs, and he would have received the profits.

The difference between the actual cost of making a machine and its sale price is not all nominal profit; but the jury must take into account the interest on capital, the risk of bad debts and the expenses of selling, in arriving at the defendant's profits.

(Before NELSON, J., Northern District of New York, October 20th, 1850.)

THIS was an action on the case, tried before NELSON, J., for the infringement of Letters Patent granted to Richard Montgomery and Lewis W. Harris, of Sangerfield, Oneida County, New York, on the 12th of August, 1840, for an "improvement in the mill for breaking and grinding bark." The plaintiff was the assignee of the patent for the State of New York.

At the trial, the plaintiff gave in evidence the patent, with

the specifications and drawings thereto annexed, from which it appeared that the bark-mill described and claimed in the specification was composed of alternate stationary and movable rings, placed concentrically, the opposing surfaces of the rings being provided with teeth ; that the movable rings were connected together, and to a central shaft with which they revolved, by transverse arms or cross-bars ; and that the stationary rings were also connected to each other by transverse arms. The rings, as connected and combined, formed a community of grinding-chambers, consisting of two or any greater number, an increase in the number of chambers to any extent being effected by multiplying the number of rings, and connecting and combining them in the manner described in the specification. The plaintiff also gave evidence tending to show the novelty and utility of the invention, the sufficiency of the specification, and the manufacture and sale by the defendant, in the State of New York, of a large number of bark-mills alleged to be an infringement.

The bark-mills made and sold by the defendant were constructed, some with four, but most of them with six grinding-chambers, formed by alternate stationary and movable rings, arranged and combined in the manner described in the said specification ; but the teeth in the defendant's mills varied in some particulars from the teeth described in the specification, and the chambers and stationary rings in the defendant's mills differed somewhat in shape from those in the patented mill.

The defendant introduced evidence designed to show that the specification did not sufficiently describe the manner of constructing a bark-mill with any other number of grinding-chambers than three. So much of the specification as is material, and the principal points made and evidence given, are stated in the charge to the jury.

In charging the jury, NELSON, J., remarked as follows :

The improvement which has been patented to Montgomery and Harris has been described in the specification which

accompanies the patent, and it is necessary for us to look into that, in the first instance, with a view to ascertain, as nearly as possible, the thing which has been discovered, and the property in which is secured to the patentees. The law requires that the applicant for a patent shall set forth in his specification a description of his invention, sufficiently full and particular to enable any intelligent mechanic to make a machine from such description.

The patentees in this case begin by stating in their specification, in very general terms, the nature of the improvement which they have discovered. They say: "The nature of our invention consists in providing a mode of breaking and grinding bark and other substances of a like character, by means of hollow, stationary cylinders, and one or more revolving conical nuts, placed concentrically, in connection with teeth and pickers, the whole constructed, arranged and combined as hereinafter particularly described." They then go on in their specification and describe the material parts of the machinery of the mill. First, the outer cylinder or shell of the mill; next, another cylinder, which is also stationary, and is the second in the models which have been shown, there being teeth on the inside of the outer cylinder, and on the inside and outside of the inner cylinder; next, a movable conical nut or ring, with teeth on the outside and inside; and then another conical nut, which is solid, and has teeth on its outside, and through the centre of which a shaft passes, which is connected with the driving power. The patentees then give a description of the teeth which are used on these stationary cylinders, and on the movable conical rings. They also describe the cross-bars or pieces that hold firmly together the stationary cylinders, and the cross-bars that hold together firmly the movable conical grinders. All this, taken together, perfects the mill, and produces the combination which the patentees allege they have discovered, and which they design to describe in their specification.

They next set out their claim, which is the most material part of the specification, especially when taken in connection with the particular description previously given. The claim,

in the language of the patentees themselves, is as follows: "What we claim as our invention, and desire to secure by Letters Patent, is the combination of the conical nuts, one or more, with the cylinders, placed concentrically as herein mentioned and described, and constructed, arranged and connected in the manner herein described, and provided with teeth and pickers arranged as is also herein mentioned and set forth." The claim in substance is this—the combination of the conical nuts, one or more, with the cylinders, placed concentrically as described in the specification, and furnished with teeth and pickers on their surfaces.

Now, the first question is, What is the thing that has been invented by the patentees? Because, unless we ascertain intelligibly what the machine is which it is claimed has been discovered, we shall be altogether disqualified for determining whether or not it has been infringed or violated by the operation of the defendant's mill. The claim is exceedingly plain, and is very distinctly and clearly expressed. It is simply the combining together of the stationary cylinders and the movable conical rings, there being teeth on the sides of both, and that combination being sustained by the cross-bars to which the movable parts and the stationary parts are severally attached, so that, on applying the driving power to the shaft, the grinding is effected in the grinding-chambers formed by the surfaces of the nuts and cylinders.

It is proper to inquire what the purpose is of this combination, and what useful object was intended to be obtained by it. Obviously, it seems to me, to increase the grinding apparatus in a machine of a given size, and which may still be driven by the same power as before. This is the new and valuable idea which has occurred to the patentees, which they have reduced to practice, and which is, in their description, embodied in a working machine. This is manifest on looking at the old mill, and comparing it with the new mill of the patentees. There was but one grinding-chamber in the old mill, while one of the simplest forms of the mill discovered and reduced to practical operation by the patentees,

contains two grinding-chambers, which are formed by inserting a movable conical nut between an outer and an inner stationary cylinder. It was the multiplication of these chambers and of the grinding apparatus or machinery, that was discovered by the patentees, and which it is agreed was never before known or put in practice.

As to the utility of the invention, I do not understand that it is called seriously in question. An invention must not only be one that can be reduced to practice, but it must be one of some utility. It appears, from the testimony in this case, that the mill of the patentees, formed by the multiplication of the grinding-chambers, particularly the mill with the three chambers, described in the specification and shown in the drawings, will grind, when not in very rapid operation, say at a speed of fifty or sixty revolutions in a minute, a cord of bark an hour through the day; and the witness did not doubt, that with an increased velocity, it would grind more. It grinds, moreover, double the quantity ground by the old mill. This is evidence enough of the utility of the invention. The question is not, whether the machine invented is the best one known to the community, nor whether it does its work better or faster than any other machine in the same department of labor. But, if it be to a certain degree useful, and be original with the patentee, it belongs to him alone, whether it does less or more work.

It has been insisted, on the part of the defendant, and that view was taken by some of the experts whom he called, that the specification in question here is not sufficiently full and particular to enable a mechanic of ordinary skill to make a mill with grinding-chambers multiplied beyond the number particularly enumerated in the specification, which is limited to three. But several of the experts who have been examined on the part of the plaintiff say, that there is no difficulty in constructing a mill with any number of grinding-chambers, from the description in the specification. Some of the witnesses for the defendant, who were examined particularly in respect to this point of the case, obviously

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labored under a misapprehension as to the extent of the questions that were put to them. They failed to comprehend the principle on which these questions are put to experts, and they, therefore, failed to respond intelligibly. Mr. Pond, a witness for the defendant, of great intelligence, and of long practical experience in this branch of business, would not say that, after reading the specification, he could not make a mill with the grinding-chambers multiplied to any given number. But he undertook to give a legal construction to the specification for himself, and, assuming his construction to be sound, and predicated upon it the answer he gave, he said he could not make such a mill if he were to follow, throughout its structure, the particular and identical description in the specification; and this was the view taken by another witness. The point is thus made one of some importance.

What is the thing discovered and described? It is the formation of grinding-chambers, by the combination of movable conical rings with stationary cylinders, these two parts being severally brought together and fastened by cross-bars. The description in the specification shows a mill with three grinding-chambers. How will you add another chamber? The patentees evidently had in their minds the idea of multiplying the chambers, because they suggest the use of stationary cylinders and one or more movable conical rings, thus allowing both cylinders and rings to be multiplied to any extent, or the mill to be limited to two cylinders and one ring. Where was the necessity of their adding the description of another stationary cylinder just like the one described in the specification, and of another conical ring just like the one they have described, and directing the ring and cylinder to be put into the mill concentrically, so as to obtain two more grinding-chambers? There would be nothing new in such a description. The specification already directs how to make the cylinder and the ring, and how to combine them in order to produce grinding-chambers. A ring between two cylinders produces two chambers, and two more are

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made by the addition of another ring and another cylinder. This is a mere duplication of parts, and there is nothing new in the multiplication of the parts. By taking the description of what has already been put together to form grinding-chambers, and by putting the same together again, and adding it to the mill by the same connection of cross-bars, you have a multiplication of the grinding-chambers.

If I have been fortunate enough to communicate to you my ideas in respect to the thing really invented and put into practical operation by the patentees, you will be prepared to take up the next subject of inquiry, and that is, whether the defendant has been guilty of an infringement; or, in other words, whether he has appropriated to his own use and for his own benefit, this new machine constructed and put in operation by the patentees. As I have already stated, the object and effect of the invention are, an increase of the grinding apparatus by a multiplication of the grinding-chambers. Has the defendant appropriated to himself this idea? Has he increased the grinding apparatus in his mill, by using the combination of the movable conical rings with the stationary cylinders? Both parties must start with the old machine, the Gale mill, which was the only mill in operation at the time of the invention by the patentees. Montgomery and Harris being the first in point of time, made the improvement which I have been explaining; that is, they increased and multiplied the number of the grinding-chambers by a combination of rings and cylinders. They thus made an advance on the old machine. Instead of only one grinding-chamber in the mill, you have two, three, four or five, or any number you see fit to make, by a multiplication of the parts. Has the defendant appropriated this combination, in the mill which he has constructed? Has he formed grinding-chambers by combining movable conical rings with stationary cylinders? If he has, he has appropriated and adopted the combination invented, described, claimed and patented by Montgomery and Harris. The defendant has a mill of six grinding-chambers and twelve

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grinding surfaces. Has he obtained that by a multiplication of the chambers, according to the combination of the patentees? If he has, then he has been guilty of an infringement.

It is urged, on the part of the defendant, that the shape of the grinding-chambers in the defendant's mill is different from the shape of the chambers in the plaintiff's mill, and that, consequently, the combination in the defendant's mill of the running parts and the stationary parts which form the chambers, is different from the combination of those parts in the plaintiff's mill. It will be quite obvious, however, to any person of ordinary understanding, who will look at these various mills, and at the principle on which they are constructed, that this grinding-chamber, though made of various shapes, will still produce a useful result. A particular shape may and probably will enable one machine to operate more advantageously than another. A mill with grinding surfaces of one particular shape may grind faster and better than a mill with surfaces of another shape. But a mill that does not grind so fast or so well as another, because it has chambers of a different shape, will not, therefore, cease to be useful. This is demonstrated by the evidence in this case. The chamber in the plaintiff's mill has one receding side formed by the movable conical nut, and one upright side formed by the stationary cyllipder. The evidence shows that the mill thus constructed is a useful and valuable mill. In the defendant's mill, both the surfaces of the chamber are receding, as well that of the cylinder as that of the ring. Thus, a larger opening is made to let in the bark, and it is very likely that this is an improvement, and that its effect is to aid in feeding the mill and in increasing its grinding capacity. In every new invention, the particular machine, when first reduced to practice, is measurably in an imperfect state. But the idea of the inventor is complete. There is, however, in the execution and mechanical construction, which go to embody the original idea in a machine for practical use, a degree of imperfection which, from a want of experience, always attends

the first construction. In the two machines in question here, the shape of the grinding-chamber is different in this respect only, that in the plaintiff's one of its sides is upright and one recedes, while in the defendant's both of its sides recede. A person using the combination discovered and put into use by the patentees, may, by experience in its practical operation, see where it can be altered, and may call in a mechanic and have the alteration made, which may improve the machine. This is a necessary consequence of the practical use of the machine by a man of ordinary skill and judgment. But there is no novelty or invention in such alteration.

An illustration of this is to be found in a case recently tried before me in the city of New York, involving the title to a most useful machine called a burring machine, for the purpose of cleaning wool or cotton, and separating the dirt and foul stuff from the fibre. This had before been done by hand, at great expense. But a machine was invented whereby the whole operation was performed by covering a cylinder with a common card of leather, furnished with teeth formed with a hook on the outside and a slot below. As the cylinder revolved, the wool or cotton being brought close to it, was caught by the hooked teeth and drawn into the slot, in such manner that the fibre went to the bottom of the slot, while the dirt remained on the top of the tooth. There was then a beater, which rubbed along the surface of the cylinder and brought off the dirt, and the operation was complete. There was such demand for the machines that the business of constructing them became extensively profitable. In the suit of which I have spoken, the defendant had originally been in partnership with the inventor in constructing the machines, and, after the partnership expired, continued to construct them without any right or license. When prosecuted by the inventor, he set up, among other things, by way of defence, that he had changed the form of the hooked teeth, and had altered the shape of the slots between the teeth. This, he insisted, was a great improvement. He had taken the whole of the patentee's machine, and, slightly altering it,

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claimed the right to use it, and thus to absorb the whole of the invention.* But, if any such doctrine were to be incorporated into the patent law, and to be administered by Courts and juries, as that such an alteration would be a defence to a charge of infringement, no patent of any machine, however useful, would be worth the parchment on which it is written. But this is not the law. A difference merely in shape is a difference in degree only, and not in the thing itself. In this case, the grinding-chamber—the space through which the bark enters—is more open in one mill than in the other. But there is nothing new in this particular shape, because the shape of the grinding-chamber is no part of the combination patented.

The same observations are equally applicable to the shape of the teeth. Their shape, whether they be straight or slanting, is no part of the patented combination. Either form will work very well, though the one may be better and more perfect than the other. But the form of the teeth, whether straight or slanting, is not new. Teeth of both shapes are found in many grinding-mills, and neither party can claim either form as new.

The novelty of the patentee's machine consists, then, in the combination of the movable conical nuts with the stationary cylinders, by which means the patentees are enabled to multiply the grinding-chambers in a mill to any given number. The teeth were old. The mere form of the grinding surfaces was not new. But this multiplication of the grinding-chambers, in the manner described, appears to have been never before known. That is the novelty and all the novelty there is in the matter. As to the subsidiary parts, such as the peculiar shape of the chambers and the peculiar form of the teeth, they are incidental. But no one has a right, without the authority of the patentees, to use the combination of the two parts that go to form the grinding-chambers. If

* The case referred to is that of *Parkhurst v. Kinsman*, (1 Blatchf. C. C. R. 488.)

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you shall think that that combination is incorporated in the machine of the defendant, the plaintiff will be entitled to your verdict. But if you shall think otherwise, your verdict will be for the defendant.

If the defendant has been guilty of violating the plaintiff's rights, the rule on the question of damages is, that the plaintiff is entitled to all the actual profits which the defendant has made by the use of the principle of the plaintiff's combination. In other words, the plaintiff is entitled to all the damages which he has sustained by reason of the use which the defendant has made of the plaintiff's property. This is, in effect, the same thing, because the law presumes that if the defendant had not put his machines into the market, the demand would have been for the plaintiff's, and that he would have received the profits on the machines which have been made and sold by the defendant. Vindictive or exemplary damages are not allowed. The jury are confined to the actual damages, and the law has provided that the Court may increase those damages in proper cases.

There are some data in this case which you can take as guides to the amount of damages. It is stated by one witness, that from the year 1843 to this time, a period of some seven years, the defendant has cast six hundred and thirty-two mills; that the average cost of those mills to the defendant was \$20 apiece; and that they sold at retail for \$45 each, and at wholesale for \$37 and \$40 each. But the difference between \$20 and \$45 on each mill is not all of it nominal profit. The interest on capital, the risk of bad debts and the expenses of selling the mills, are all to be taken into account in arriving at the profits which the defendant has made. The right of the plaintiff accrued in August, 1845, and the suit was commenced in June, 1849. The jury should confine their inquiry on the subject of damages to that period, about four years, and to the profits which the defendant derived from sales of his mills within that period.

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The jury found a verdict for the plaintiff for \$7,200, which was reduced by the Court, by consent of the plaintiff, to \$6,000.

The defendant afterwards moved, on a case, for a new trial, on the ground of errors in the charge of the Court, and of the excessiveness of the damages. But the motion was denied.

Samuel Stevens, Samuel Blatchford and Levi D. Carpenter, for the plaintiff.

Joshua A. Spencer and William Baker, for the defendant.

JOHN GIBSON *vs.* WILLIAM W. COOK. IN EQUITY.

To enable an assignee of a patent to derive any benefit from a subsequent extension of the patent by Act of Congress, there must be an express provision in the assignment looking to such renewal.

Under § 11 of the Patent Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) the assignment of an exclusive right in the patent within a given territory must not only be in writing, but must be recorded within three months after its execution, to defeat the title of a subsequent purchaser without notice and for a valuable consideration.

Within the three months, an unrecorded prior assignment would prevail; but it must be an assignment in writing, that *may* be recorded within the time limited.

An interest in a grant of a future term of a patent not yet *in esse*, is not the subject of assignment at common law, or within the sense of § 11 of the Act of July 4th, 1836, and the right to such an interest, when stipulated for, rests only in contract.

As between the right of a person holding a contract for such an interest, and the right of a *bond-fide* purchaser, for a valuable consideration and without notice, of the same interest in the future term, after its grant, the latter must prevail.

The party setting up such a contract by way of equitable defence to the legal title to the same interest, must deny that the plaintiff is a *bond-fide* purchaser for a valuable consideration without notice, and must assume the burthen of impeaching the legal title.

(Before NELSON, J., Northern District of New York, November 21st, 1850.)

THIS was an application for a provisional injunction against the defendant for an alleged infringement of the Woodworth patent, in using six Woodworth machines, without license, since the 27th of December, 1849. The plaintiff was the assignee of the re-issued patent of July 8th, 1845, for the Congressional extension of seven years from the 27th of December, 1849, (see *Wilson v. Rousseau*, 4 How. 646,) for the county of Washington, New York, within which the alleged infringement took place. The patentee's rights to the territory in question were assigned by him to James G. Wilson, on the 9th of July, 1845, and by Wilson to the plaintiff, on the 12th of November, 1846.

In opposition to the motion, the defendant relied upon an assignment or license to him from the patentee, William W. Woodworth, administrator, &c., executed on the 4th of July, 1843, by which he was authorized to construct and use six Woodworth machines in the county of Washington. The question in the case involved the operation and effect of this license.

The license was given during the running of the seven years' extension of the patent, granted under the 18th section of the Patent Act of July 4th, 1836, and which prolonged its term from December 27th, 1842, to December 27th, 1849. (See *Wilson v. Rousseau*, 4 How. 646.) The license recited the issuing of the original patent, and its extension for seven years from the 27th of December, 1842, and then, in apt and proper words, granted to the defendant and his assigns the right to construct and use, *during the said extension*, six planing machines in the said county of Washington, but in no other place within the United States or their territories. It authorized him and his assigns to prosecute parties guilty of an infringement by constructing or using the Woodworth machine within the assigned territory; and mutual stipulations followed, by which Woodworth vested the defendant with an *exclusive* right to construct and use the six machines, *during the term aforesaid*, and the defendant bound himself not to exceed that number. The license wound up with the

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following provision: "It is understood that the said Cook has all the rights I have in the county of Washington, under said patent, to use six machines, and no more."

Besides the question arising on the face of the license, the defendant set up that there was a mistake in not inserting in the license a provision looking to a further extension of the patent by Act of Congress, the parties having actually agreed that the assignee should have the benefit of any such further extension. The facts in relation to this point sufficiently appear from the opinion of the Court.

Azor Taber and Rodman L. Joice, for the plaintiff.

Samuel Stevens, for the defendant.

NELSON, J. It is quite obvious, from a perusal of the provisions of the written instrument of the 4th of July, 1843, under which the defendant derived his right to use the machines in question, that the position taken in opposition to the motion for an injunction has no foundation in that instrument. That, in express words, limits the grant to the period of the extended term then running, which was all the right that belonged to Woodworth at the time within the given territory. Even the additional or contingent right of extension under the 18th section of the Act of 1836, no longer remained, as but one extension is provided for by that section. The possibility of a renewal of the patent by Act of Congress existed; but, for the purpose of enabling the assignee to derive any benefit in that event, an express provision should have been inserted in the grant or assignment, looking to such a renewal. (*Wilson v. Rousseau*, 4 How. 646, 685, 686.) Unless there be such a stipulation, showing that a renewal was contemplated, the Court is bound to construe the instrument, and each and all of its provisions, as relating to the existing right in respect to which the parties were contracting with one another. This is the natural presumption, arising from the usual and ordinary course of deal-

ing, and should govern in the construction of the contract, unless it is otherwise clearly expressed.

Assuming, however, that the written instrument imports no grant of a right to the use of the machines beyond the extended term, still the defendant insists that such was the actual agreement and understanding of the parties; that the omission to insert the stipulation arose out of a mistake or misapprehension of the purport of the instrument; that he is entitled to have it reformed and a clause to the effect claimed inserted, so that he may be protected in the enjoyment of the right during the term as renewed by Act of Congress; and that, being entitled to the relief in Equity, on a direct application for that purpose, it is competent for him to set up this ground by way of equitable defence to the motion for an injunction. (*Hunt v. Rousmaniere*, 8 Wheat. 174; *Joynes v. Statham*, 3 Atk. 388; *Garrard v. Grinling*, 2 Swanst. 244; *Clark v. Grant*, 14 Ves. 519; *Gillespie v. Moon*, 2 Johns. Ch. R. 585, 598; *Clowes v. Higginson*, 1 Ves. & B. 524; 1 *Story's Eq. Jur.*, § 161; *Newb. on Contr.*, 344.)

Upon this view of the law, the defendant has produced his own affidavit, and another by Mr. Boyd, who was present when the contract was made with Woodworth for the use of the six machines, and was consulted in respect to it, going to show that it was the understanding of the parties at the time, that the defendant's right to the use of the machines was to continue, notwithstanding a second extension of the patent should take place.

Whether this ground may or may not be set up by way of equitable defence to the relief sought by the plaintiff, is a question I do not intend to examine; for, in my view of the case, conceding the position to be well founded, it will not avail the defendant.

The 11th section of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) provides, that every patent shall be assignable in law, either as to the whole interest or any undivided part thereof, by an instrument in writing; and that the assignment, and also every grant and conveyance of the

exclusive right to make and use, &c., the thing patented, within any specified part of the territory of the United States, shall be recorded in the Patent Office within three months from its execution. The 4th section of the Act of February 21st, 1793, (1 *U. S. Stat. at Large*, 322,) contained substantially the same provision. The 4th section of the Act of April 10th, 1790, (1 *U. S. Stat. at Large*, 111,) strongly implies that the assignment must be in writing, as otherwise it is declared to be no defence to an action for an infringement; though there was no provision in that Act for recording the assignment.

Under the 11th section of the Act of 1836, the assignment or grant of an exclusive right in the patent within a given territory, must, therefore, not only be in writing, but must be recorded within the three months, to defeat the right of a subsequent purchaser without notice and for a valuable consideration. In order to guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the Patent Office. Within that period, he must protect himself in the best way he can, as an unrecorded prior assignment would prevail; but it must be an assignment in writing, that may be recorded within the time limited.

That the chief object of the section requiring the assignment to be recorded is the protection of *bona-fide* purchasers, is manifest, though not specially declared, as is usual in registry acts; as it cannot readily be perceived that any other benefit can be derived from the requirement. No reason can be given why the assignment should not be valid as between the parties, without being recorded. It is only when the rights of third persons are concerned, that the step becomes important, in guarding against frauds. (*Brooks v. Byam*, 2 *Story*, 525; *Pitts v. Whitman*, 2 *Story*, 609, 614; *Curtis on Pat.*, § 190.)

The instrument containing the grant in this case falls within a class required to be recorded, as the grant conveyed an exclusive right under the patent to construct and use, and to

grant to others to construct and use, the six machines, within a specified territory. It was a grant to this extent to the grantee *and his assigns*, clearly importing, therefore, not only an exclusive right to construct and use the machines himself, but to vend to others the right to construct and use them, as he might think most advisable for his interest.

Now, the assignment from Woodworth to Wilson, which was after the surrender of the patent and its re-issue on an amended specification, was made on the 9th of July, 1845. Wilson's assignment to the plaintiff was made on the 12th of November, 1846, and embraced the territory within which the defendant sets up a prior contract of assignment of the exclusive right to use his six machines. If this assignment to the defendant had been in writing, it would not have defeated the right of the plaintiff, unless recorded within the three months; and surely, not being in writing, and therefore not in a condition to be recorded, it cannot help the case out of the difficulty. The defendant's title is in the predicament of that of a grantee of land, where there has been an omission or misdescription of a portion of the premises intended to be conveyed. A subsequent *bona-fide* purchaser for a valuable consideration takes the title; and, although the party, as between himself and his grantor, might be entitled to have the deed reformed and the true description inserted, he cannot be thus entitled to the prejudice of the after acquired title.

But, it may be said that the clause omitted in the assignment, having relation to a grant of a future term of the patent, not yet *in esse*, was not an assignment or grant within the meaning of the 11th section of the Act of 1836, that section having relation to an interest in an existing patent; and that, therefore, the stipulation for this future contingent interest, if in writing, need not have been recorded in the Patent Office. The interest in respect to which the parties were contracting, not being in existence at the time, was doubtless not the subject of assignment or grant at common law, nor within the sense of this section of the Act. The right could

rest only in contract. Admitting this to be the correct view of the stipulation, still I do not see how it can help the defendant. For, if the Court should proceed and reform the contract, and cause the provision to be inserted in the assignment of the 4th of July, 1843, it would not affect the interest in the renewed patent in this territory, which had already passed by assignment to the plaintiff. As the right would rest only in contract, even after the instrument had been reformed, the interest of the assignee would still remain unaffected, until an actual assignment was enforced in Equity in pursuance of the agreement. In order to effect this, it would be necessary to make the plaintiff here a party, the legal title being in him, and the question would then be presented between the right of a person holding a contract for the interest in question, and that of a subsequent *bona-fide* purchaser for a valuable consideration. I need scarcely add that, in this posture of the case, the latter must prevail. (1 *Story's Eq. Jur.*, § 64 c, and cases there cited.) Besides, Courts of Equity will not interfere to correct a mistake in a written instrument, to the prejudice of a *bona-fide* purchaser, as he has at least an equal right to protection with the party laboring under the mistake. (1 *Fonbl. Eq.*, B. 1, ch. 1, § 7 and notes; *Sugd. on Vend.*, ch. 3, p. 143; *Warrick v. Warrick*, 3 *Atk.* 291; *Malden v. Menill*, 2 *Atk.* 8, 13; 1 *Story's Eq. Jur.*, §§ 108, 139, 165.)

The defendant, in order to have secured himself against the title of a *bona-fide* purchaser, should have procured a reformation of his contract, and an assignment of it, prior to the assignment to Wilson, under whom the plaintiff claims, and have recorded the same in the Patent Office within the three months. To reform the contract now, and award to him the benefit of the omitted clause, by directing an assignment, or, what would be equivalent, allowing him to avail himself of this matter by way of equitable defence, would not only contravene the effect of the recording Act, but operate as a direct fraud upon the plaintiff. This view alone seems conclusive against the ground of defence set up in answer to the motion.

The mere right to an assignment would be of no avail, whether in writing or otherwise, even though enforceable in Equity against the original party and his personal representatives. If it would, greater effect must be given to it as respects the title of a purchaser without notice, than to an actual unrecorded assignment of the interest—a proposition for which no one will contend.

I have assumed all along that the plaintiff is a *bona-fide* purchaser of the interest claimed in the patent. That fact has not been controverted by the defendant; and, as the question in the case is presented by way of equitable defence to the title shown in the bill, the denial was necessary to complete the ground of defence. Otherwise, the title stands as averred in the bill, the burthen lying upon the defendant to impeach it.

I am satisfied, therefore, that the ground set up in opposition to the motion for an injunction cannot avail the defendant, inasmuch as the equity shown is not superior to that of the plaintiff. And besides, if it were admitted, it would, in effect, override the rights of the parties as settled by the provision of the Act of 1836 requiring the recording of exclusive grants in a given territory, and of assignments of the whole or portions of the interest in the patent.

Injunction granted.

WILLIAM W. WOODWORTH AND JOHN GIBSON

vs.

WILLIAM W. COOK. IN EQUITY.

A license given by W., the patentee, to C., to use six patented planing machines, recited that C. desired a license to use the machines in a certain county "on the conditions hereinafter mentioned," and then granted to C. permission to use the six machines within the county, "and also, within said limits, to dispose of the plank or other things dressed and prepared on the said machines;" it further provided that W. should not permit any other

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person than C. to use the machines within the county, and that C. should not use more than six machines there, "nor use any such machines, nor sell and dispose of any plank or other thing dressed and prepared in such machines, anywhere else within the United States;" and it concluded thus: "It is understood that said C. has all the rights I (W.) have in said county, under said patent, to use six machines, and no more:" *Held*, that the sale of the products of the machines was restricted within the county, and that there was nothing in the prior clauses of the license necessarily repugnant to the last one.

But, where it appeared that the actual agreement between W. and C. at the time was, that C. was not to be restricted as to place in selling the dressed plank, and that the last clause in the license was especially inserted for that purpose, a Court of Equity would, probably, on a proper application, direct the contract to be reformed by the insertion of a clause to the effect claimed.

If so, it seems to be an established rule in Equity, that the matter entitling the party to an amendment of his contract may be set up by way of defence to a proceeding to enforce a specific performance of the contract, where the clause omitted through mistake or accident would, if found in the instrument, constitute a ground of defence.

But such a defence cannot be set up where the rights of a *bond-fide* purchaser have intervened, which would or might be seriously prejudiced by giving effect to the defence.

Under the license in this case, W., on a breach by C. of the condition as to the sale of the products of the machines, had a right to avoid the contract, and to be remitted to his original rights, and to prosecute C. for an infringement of the patent.

But C. also is remitted to his original position and rights; for the contract must be avoided altogether, if at all.

And C. may set up any right he had prior to the license, to use the machines; as, for instance, where the right granted by the license was for an extension of the patent under § 18 of the Patent Act of July 4th, 1836, he may set up a right, under the decision in *Wilson v. Rousseau*, (4 How. 646,) to use the machines as having been in use when the first term of the patent expired.

In a suit in Equity against C., to take advantage of a breach of said condition of the license, W. is properly joined as a plaintiff with G., although the latter owns the whole of the beneficial interest in the subject-matter; because W. was a party to the license, and, for aught that appears, is yet the owner of a portion of the interest in the patent, and, as such, interested in upholding it, and may be interested indirectly in the infringement itself.

(Before NELSON, J., Northern District of New York, November 21st, 1850.)

THE bill in this case was filed in June, 1847, and set forth the granting of the *Woodworth patent*, its extension for seven years from the 27th of December, 1842, and its re-issue on

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the 8th of July, 1845. (See *Wilson v. Rousseau*, 4 *How.* 646.) It also set forth that, on the 25th of November, 1845, the plaintiff Woodworth, the patentee of the re-issued patent, conveyed to the plaintiff Gibson the exclusive right to the patent during the extension, for the city and county of Albany, N. Y., except the right to use two machines in Watervliet in that county; that on the same day, James G. Wilson, who, on the 9th of July, 1845, had become the assignee of the right under Woodworth for the territory specified in the conveyance next mentioned, conveyed to the plaintiff Gibson all the right to the patent, during the extension, for the State of New York, excepting the exclusive right to run seven machines, in six specified places, (none of them, however, in the county of Washington, N. Y.,) in addition to the two machines in Watervliet, before excepted; that the defendant had had in operation for some time three Woodworth machines at Whitehall, Washington county, N. Y., and dressed large quantities of lumber with them, and sold it in Albany and Troy, and had had and still had depositories in those cities and elsewhere, for the sale of such dressed lumber; that the plaintiff Gibson had a large and expensive establishment at Albany for running and making the Woodworth machines and selling them and the lumber dressed by them, and his licensees had large establishments of the same kind at Troy and other places in the State of New York, the whole being of the value of not less than \$200,000; that the operations of these establishments had been materially injured by the defendant's acts, and that the defendant claimed the right to do as he had done, under a license from the plaintiff Woodworth, given on the 4th of July, 1843.

The license, which was set forth in the bill and was under seal, was executed by both Woodworth and the defendant, recited that the defendant desired a license to construct and use the Woodworth machines in the county of Washington, "on the conditions hereinafter mentioned," and then gave the defendant permission to construct and use six of the

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planing machines in the county of Washington, N. Y., and not elsewhere, during the extension, "and also, within said limits, to dispose of the plank or other things dressed and prepared in the said machines." The license then provided that Woodworth should not permit any other person than the defendant to construct or use the machine within the county of Washington, and further, that the defendant "shall not, nor will, during the term aforesaid, construct or use more than six machines as aforesaid within the limits above mentioned, nor construct or use any such machines, nor sell and dispose of any plank or other thing dressed and prepared in such machines, anywhere else within the United States and the territories thereof." The license concluded as follows: "It is understood that said Cook has all the rights I have, in the county of Washington, under said patent, to use six machines, and no more."

The bill claimed that the defendant, by vending the products of his machines out of the county of Washington, had violated the conditions and covenants of his license and forfeited all his rights under it. The bill further set forth that, on the 20th of August, 1846, the plaintiff Woodworth, by an instrument in writing, authorized and empowered the plaintiff Gibson, in the name of Woodworth or otherwise, to prosecute the defendant for the violation of the covenant and condition in the said license contained, and to recover from him such damages as he was liable to pay therefor, and to restrain him from further violating his covenant, and to receive to his own use all damages that might be recovered. The bill prayed for an account of profits, and an injunction against the further use of the machines, and that the license might be annulled.

The answer admitted the running of three Woodworth machines by the defendant at Whitehall, and the sale by him, out of the county of Washington, of the lumber dressed by them. It insisted that the plaintiff Gibson could not have been injured by the defendant's operations, unless the lumber dressed by the defendant would otherwise have gone

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to the machines of Gibson to be dressed ; that the defendant had a right to sell his dressed lumber wherever he thought proper ; that, in March, 1838, he and his brother acquired a right, through several mesne conveyances, by deed from William Woodworth, to use two of the Woodworth planing machines in Washington county, for the residue of the original fourteen years, and that they at the same time bought two of the machines and put them in use at Whitehall, and had used them there ever since ; that, at the time the license of the 4th of July, 1843, was executed, it was actually agreed between the plaintiff Woodworth and the defendant, that the latter should possess the right to vend the products of the six machines without any restriction as to place, and the parties intended that the license should so provide, and understood that it did, and the last clause in it was inserted to effect that object ; that the defendant had a right, at all events, to use the two machines so purchased by him and his brother, and to sell anywhere the lumber dressed by them ; that the restriction insisted on by the plaintiffs was in restraint of trade, and void ; that the patent did not grant to the patentee the exclusive right of selling the products of the machines, and he had no right to restrict their sale ; that this Court had no jurisdiction of the case ; that the bill did not show any joint interest of the plaintiffs in the relief prayed for ; and that they had a perfect remedy at law.

There was a replication to the answer, and the case was heard on pleadings and proofs. The material parts of the evidence are stated in the opinion of the Court.

Azor Taber and Rodman L. Joice, for the plaintiffs. I. The objections to the bill, as set forth in the answer, are untenable. 1. This Court has exclusive jurisdiction of the subject-matter of the bill. The objection taken is that, if the bill is founded on the forfeiture or the breach of any covenant, this Court has no jurisdiction. The answer is, that we are to consider the covenant as broken and set aside, and the bill as a bill for infringement, founded on the patent. Of a bill

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complaining of the unauthorized use of a patent right, and praying an account and injunction, a State Court has no jurisdiction, even by consent. (*Act of July 4th, 1836, § 17, 5 U. S. Stat. at Large, 124; Dudley v. Mayhew, 3 Comst. 9.*) 2. Woodworth, the patentee, is properly joined as plaintiff with Gibson, his assignee for the territory where the injury is alleged to have been done; the lumber dressed by the defendant's machines having, contrary to the license from Woodworth, been sold in Gibson's territory. (*Act of July 4th, 1836, § 14; Whittemore v. Cutter, 1 Gall. 429, 430; Woodworth v. Wilson, 4 How. 712, 716.*) 3. The plaintiffs have not an adequate remedy at law. They pray that the defendant's license be declared void, and for an account and an injunction; for all of which they have a manifest right to come into a Court of Equity.

II. The planing of lumber in Whitehall, for sale elsewhere, was contrary to the terms and true meaning of the license. The last sentence of the instrument does not contradict the prior explicit restriction as to disposing of the dressed lumber. Whatever was authorized to be done by the last sentence, was to be done "in the county of Washington." It expressly relates to *using* the machines, and was inserted for abundant caution, to show that Woodworth reserved no rights to himself in the county. To allow such a general expression to overrule an explicit condition not mentioned or referred to in it, would violate the fundamental rules of construction. (*Co. Litt., 147 a; Story on Contr., 2d ed. § 639.*)

III. The allegation in the answer, that the parties intended by the contract something different from what is expressed in it, is nugatory, and the oral evidence given in its support should be rejected. 1. Parol evidence is inadmissible to add to, defeat or vary the terms of a written instrument, especially where, as in the present case, an instrument in writing is required by law to give effect to the contract. (*Act of July 4th, 1836, § 11; 3 Stark. Ev., pt. 4, pp. 100-102; 1 Phill. Ev., C. & H. ed., 559; Rich v. Jackson, 4 Brown Ch. Cas. 514; Sherman v. Mayor, &c., of New York, 1 Comst. 316;*

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Norton v. Woodruff, 2 *Id.* 153.) 2. The construction of a written contract, or the presumption arising from it, can no more be varied by parol evidence, than can its terms. (*Creery v. Holley*, 14 *Wend.* 26, 30; *Hull v. Adams*, 1 *Hill*, 601.) 3. There is no pretence of any latent ambiguity in the instrument. If there be any ambiguity, it is patent, and cannot be explained by oral evidence. (*Story on Contr.*, 2d ed., § 677.) 4. If there was any mistake or fraud in the license, Cook should have filed his bill against Woodworth, to be relieved from his contract, or to reform it according to the intention of the parties. He cannot be permitted to claim under it as it is, and then, when sued for its violation, alter some of its provisions by parol evidence. 5. Especially can he not be permitted to do this against Gibson, an innocent third person, who, on the faith of the records of the Patent Office, has for years conducted his business under the patent, and has incurred the expense of this prosecution.

IV. The license was, by its terms, granted on certain conditions, one of which has been violated by Cook. The violation of this condition was a forfeiture of the license. (*Story on Contr.*, §§ 28, 29; *Com. Dig., Condition, B. and C.*)

Samuel Stevens, for the defendant. I. The defendant had a right to use, without restriction, the two machines bought by him in 1838; and the plaintiffs can, in any event, reach only the third machine.

II. The license does not restrict the defendant as to the place of selling the lumber dressed in the machines. And, even if it does, it is not a condition on which his title depends, but merely a covenant, for a breach of which the parties injured must obtain relief by damages. Courts will not create a condition by construction, when the consequence is to be a forfeiture; but will sometimes construe a condition to be a covenant, in order to avoid a forfeiture.

III. But, if the license does restrict the place of sale, the proofs show that there was a mistake in the contract, and that the agreement was, there should be no restriction.

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IV. The Court will, therefore, in a suit in Equity, give such a construction to the license as the parties intended it to receive ; especially will they do so where a different decision will work a forfeiture. (*Hunt v. Rousmaniere*, 8 *Wheat.* 174.)

V. The bill is defective for the reasons set forth in the answer.

NELSON, J. 1. The evidence is very strong in this case to show that, according to the actual agreement between the patentee and the defendant at the time of the assignment of the 4th of July, 1843, the latter was to possess the right not only to construct and use the six machines within the territory mentioned, but also to vend their products, without any restriction as to place. The deposition of Mr. Boyd is very particular and explicit on this point. It was the subject of discussion in the negotiation, and was deemed a very material part of the contract on the part of the defendant ; so much so, that he refused to become the purchaser if restricted in the exercise of this right, as provided for in one of the clauses in the assignment. To remove the objection and give the unrestricted right of sale, the last clause was interlined at the bottom of the instrument, as follows : " It is understood that said Cook has all the rights I have in the county of Washington, under the said patent, to use six machines, and no more."

Upon this evidence, assuming that the clause thus inserted has not the effect, when taken in connection with other parts of the contract, to give the unrestricted right of sale, according to any legal interpretation of the instrument, a Court of Equity would probably, on a proper application, direct the contract to be reformed, by the insertion of a clause to the effect claimed ; and, if so, it seems to be an established rule in Equity, that the matter thus entitling the party to an amendment of his contract may be set up by way of equitable defence against a proceeding involving the rights of the parties under the instrument, and which would not be maintainable

if the clause in question had formed a part of the contract. In other words, it may be set up by way of defence to a proceeding to enforce a specific performance of the contract, where the clause omitted through mistake or accident would, if found in the instrument, constitute a ground of defence. (*Com. Dig., Chancery*, 2 C. 16; *Joynes v. Statham*, 3 Atk. 388; *Pitcairn v. Ogbourne*, 2 Ves. Sr. 375; *Legal v. Miller*, *Id.* 299; *Mason v. Armitage*, 13 Ves. 25; *Flood v. Finlay*, 2 Ball & Beat. 15; *Gillespie v. Moon*, 2 Johns. Ch. R. 585; *Price v. Dyer*, 17 Ves. 357; 1 *Story's Eq. Jur.*, § 161.)

I am inclined to think, notwithstanding the insertion of the last clause in the agreement, that, taking the whole instrument together, and giving to each and all of its provisions a consistent interpretation, the sale of the products of the machines was restricted within the limits of the county within which their operation was confined; and that there is nothing in the restrictive clause necessarily repugnant to the one relied on by the defendant as qualifying it. It is not to be denied, however, that unless the view taken by the defendant as to the effect of the qualifying clause is the correct one, it is difficult to perceive its object or materiality, as that clause, if confined simply to the number of machines to be used, would be but a repetition of what had already been fully provided for. The defendant's view, therefore, though not sustainable upon any proper legal interpretation of the instrument, tends to confirm the evidence as to the mistake or misapprehension of the effects of it, claimed in the answer.

Upon the whole, I should be disposed to acquiesce in the ground and principle of the defence thus set up, were it not for the consideration that the rights of a *bon fide* purchaser have intervened, which would or might be seriously prejudiced by allowing the contract to be reformed at this late day, or by giving effect to the defence, which would be the same thing. Wilson and Gibson having purchased all the right of the patentee within the State of New York, subject to certain previous grants, and, among others, the one in

question, and paid for the same a valuable consideration, the enlargement of the defendant's contract beyond what appeared upon the face of it, to the prejudice of these subsequently acquired rights, would be unjust and inequitable, and constitutes ground that must prevent the interference of the Court. In the aspect of the case in which the relief is prayed for against the terms of a written instrument, these assignees are to be regarded as *bona-fide* purchasers, and as presenting at least an equal equity against the correction of the mistake, to their prejudice, with that presented by the defendant in favor of it. The authorities on this point were referred to in the case of *Gibson v. Cook*, (*ante*, p. 144.)

That the unrestricted sale of the products of the machines operated in the territory in question would not be prejudicial to the rights of these assignees, is a proposition I cannot assume or admit. It is manifest that a right to vend the products in the markets at the cities below on the Hudson River, would seriously affect the value of the machines in operation in those cities, and, of course, the price of the rights under the patent. If so, then the rights of the assignees, as *bona-fide* purchasers, intervene, and, upon the principles above stated, forbid the interference of the Court.

2. I am inclined to think that the assignment from Woodworth to Cook, according to the fair import of its terms, was made upon the express condition that he should observe strictly the limitation in regard to the sales of the products of the machines; and that, on a breach of the condition, the patentee had a right to avoid the contract and to be remitted to his original rights. This would seem to be not only the intention of the parties in inserting the condition, but also the legal effect and operation of the stipulation; and upon this view the bill has been framed.

It is to be observed, however, that the defendant is also remitted to his original position and rights under the Woodworth patent, as the contract must be avoided altogether, if at all. It cannot be obligatory upon the one party and not upon the other. The bill assumes, and properly, as its foundation,

that the contract has been rendered null and inoperative by the breach of the condition ; and that, since the breach, the defendant has been running the machines in violation of the patent. In this view of the case, he may well set up, as he has done in the answer, any right belonging to him, as it respects the use of the said machines, prior to the assignment in question.

It seems that two of these machines were constructed and used under a right acquired from the original patentee during the first term, and were in use at the expiration of that term. According, therefore, to the case of *Wilson v. Rousseau*, (4 *How.* 646,) the defendant had a right to continue in the use of them, notwithstanding the first extension. This ground affords a complete answer to the charge of infringement as it respects these two machines.

3. Woodworth, the patentee, is, we think, properly joined with Gibson as a plaintiff. He being a party to the assignment, it was, perhaps, necessary to make him a party to the suit, in order to take advantage of the breach of the condition, notwithstanding the whole of the beneficial interest is in Gibson. Besides, for aught that appears, he is yet the owner of a portion of the interest in the patent, and, as such, interested in upholding it ; and he may be interested indirectly in the infringement itself.

There must be a decree for the plaintiffs, and a reference to a Master to take proof of the loss of profits sustained on account of the infringement, upon the principles above stated.

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DOUGLASS PRENTISS

vs.

CHARLES W. BRENNAN. IN EQUITY.

Under § 11 of the Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 78,) construed in connection with Art. 3, sec. 2, of the Constitution of the United States, it is not sufficient to give jurisdiction of a suit to a Circuit Court, that one of the parties to it is an alien.

The controversy, in order to give jurisdiction, must be one in which a citizen of a State and an alien are parties.

Where the plaintiff was a native of New York, but had resided in Canada and been in business there for thirty years before bringing his suit, and resided there when he brought his suit, and had taken the oath of allegiance there to the Queen of Great Britain, and the defendant was a citizen of Canada and a subject of the Queen of Great Britain: *Held*, that this Court had no jurisdiction of the case.

Though the plaintiff might, for some purposes, be regarded as a citizen of the United States, he was not a citizen of the State of New York, which was essential to give jurisdiction.

(Before NELSON, J., Northern District of New York, February 7th, 1851.)

THE plaintiff filed his bill in this case against the defendant for the settlement of a partnership account, claiming a large balance due to him from the firm, charging that the defendant had wrongfully taken possession of the partnership books, papers and effects, and had absconded with them from Kingston, in the Province of Canada, where the partnership business had been carried on, into the State of New York, and praying for an account and an injunction, &c.

The bill described the plaintiff as of the city of Kingston, in the Province of Canada, and a citizen of the State of New York, and the defendant as a citizen of the Province of Canada, and a subject of the Queen of Great Britain. The defendant put in a plea to the jurisdiction of the Court, setting forth that the plaintiff was then, and had been for more than twenty years preceding, a resident of, and located and domiciled in Kingston, in the Province of Canada West, and

not in the State of New York, or in any one of the United States, and had become a naturalized citizen of the Province aforesaid, and had taken the oath of allegiance to the Sovereign of Great Britain. The plea was verified by the oath of the defendant.

Upon the facts set forth in the plea, supported by affidavits, a motion was now made by the defendant to vacate an order allowing a writ of *ne exeat*, made by NELSON, J., on the filing of the bill and on affidavits showing a case for the writ, and to discharge the writ issued by virtue of the order. The principal ground of the motion was, that this Court had no jurisdiction of the case, on account of the residence and character of the parties. The affidavits on the part of the plaintiff showed that he was a native of the State of New York, but that, some thirty years before, he removed to Kingston, in the Province of Canada, and had since that time been a resident of that place, engaged in mercantile business, and had taken the oath of allegiance there, in order that he might be enabled to purchase and hold real estate in said Province.

Albertus Perry, for the defendant.

Selah Mathews, for the plaintiff.

NELSON, J. The second section of the third article of the Constitution of the United States provides, that the judicial power of the United States shall extend, among other things, to controversies between a State, or the citizens thereof, and foreign States, citizens or subjects; and the 11th section of the Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 78,) in carrying into effect this provision, declares that the Circuit Courts shall have original cognizance, concurrent with the Courts of the several States, of all suits of a civil nature, at common law or in Equity, where the United States are plaintiffs or petitioners, or an alien is a party, &c.

This Act is defective in respect to the jurisdiction conferred

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upon the Circuit Courts in the case of aliens, as it would seem, from its language, that it might be sufficient to give jurisdiction to the Court, if one of the parties was an alien. Construing it, however, in connection with the provision of the Constitution, there can be no difficulty as to the meaning intended by Congress. The controversy, in order to give jurisdiction, must be between a State, or a citizen thereof, and a foreign State, or a citizen or subject thereof; that is, speaking with reference to individual parties, the suit must be one in which a citizen of a State and an alien are parties. (*Jackson v. Twentyman*, 2 *Peters*, 136.)

The objection to the jurisdiction in the present case is, that the plaintiff is not a citizen of any particular State, and that this is essential to bring the case within the provisions of the Constitution and of the Act of Congress made in pursuance thereof. If it had been shown that the plaintiff had returned to the State of New York, and was a resident therein at the time of filing the bill, he would then have become reintegrated an American citizen, and entitled to the privileges belonging to that character; and then, being a resident of the State, he would have been a citizen thereof. But his residence and domicil are in the Province of Canada, and not in this State; and hence, though for some purposes he may still be regarded as a citizen of the United States, he is not a citizen of the State of New York, which is essential to give jurisdiction. (*Hepburn v. Elzey*, 2 *Cranch*, 445; *Corporation of New Orleans v. Winter*, 1 *Wheat.* 91; *Gassies v. Ballou*, 6 *Peters*, 761; *Brown v. Keene*, 8 *Peters*, 112; *Picquet v. Swan*, 5 *Mason*, 35; *Case v. Clarke*, *Id.* 70; *Wilson v. The City Bank*, 3 *Sumn.* 422; *Cutlett v. Pacific Ins. Co.*, 1 *Paine C. C. R.* 594; *Lessee of Cooper v. Galbraith*, 3 *Wash. C. C. R.* 546.) The language of the Constitution is explicit, that the controversy must be between a State, or the citizens thereof, and foreign States, citizens or subjects; and the above cases will show that the interpretation is in conformity therewith.

A person may be a citizen of the United States, and not a

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citizen of any particular State. This is the condition of citizens residing in the District of Columbia, and in the Territories of the United States, or who have taken up a residence abroad, and others that might be mentioned. A fixed and permanent residence or domicile in a State is essential to the character of citizenship that will bring the case within the jurisdiction of the Federal Courts, as will appear from the cases already referred to.

As I am satisfied that this Court has no jurisdiction in the case, and that the bill must eventually be dismissed on that ground, the writ of *ne exeat* heretofore issued ought not to be continued. The rule entered granting the writ must therefore be vacated, and the defendant be discharged from custody.

EDWIN C. LITTLE AND OLIVER SCOVILL

vs.

ANTHONY GOULD AND OTHERS. IN EQUITY.

The provision of the 22d section of the 6th Article of the Constitution of the State of New York, adopted in 1846, that all "judicial decisions shall be free for publication by any person," is not repugnant to the Constitution and laws of the United States.

Nor is the 2d section of the Act of the Legislature of the State of New York, passed April 9th, 1850, (*Laws of 1850, chap. 245,*) which provides that "the copyright of any notes or references made by the State Reporter" to any of the Reports of the decisions of the Court of Appeals "shall be vested in the Secretary of State for the benefit of the People" of the State, inconsistent with the said provision of the Constitution of the State of New York.

The various Acts passed in relation to the publication of the Reports of the Court of Appeals of the State of New York, reviewed.

The word "notes" in the said Act of 1850, comprises the summary of the points decided by the Court which immediately follows the title of the suit in each case reported, and the foot-notes in the volume of Reports, and the statement of the arguments of counsel.

The abstracts of the pleadings and the statements of facts, which form the basis of the decisions reported, are neither "notes" nor "references."

The "notes and references" intended by the Act do not embrace such original

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notes and references as the Reporter may see fit, of his own accord, to super-add to what would otherwise be, in themselves, complete Reports of the cases reported by him.

As to what is covered by the word "references" in the Act, *quere*.

In pursuance of law, the State Reporter, the Secretary of State and the Comptroller of the State of New York, contracted with L. that he should, during the term of five years, publish the decisions of the Court of Appeals, and have the exclusive benefit of the copyright to be taken out in behalf of the State, of the notes and references and other matter furnished by the State Reporter connected with such decisions, which contract was therein declared to be an assignment and transfer to L. of the copyright of the matter so published. The contract was made after the passage of said Act of 1850. The Reporter was a salaried officer, appointed by the State authorities, under laws which declared that he should have no pecuniary interest in his Reports, but that they should be published by contract, and that it should not be lawful for the Reporter, or any other person within the State, "to secure or obtain any copyright for said Reports of judicial decisions," but that the same might be published by any person. After said contract was made, the Reporter prepared a volume of said Reports, and the necessary steps to obtain a copyright for it under the Acts of Congress were taken in the name of the Secretary of State of the State of New York, in trust for said State. This volume was, during the five years, printed and published by L. under his contract. Subsequently, and during the five years, G. reprinted and published the volume: *Held*, on a motion by L. for a provisional injunction, that he was entitled to such an injunction restraining G. from publishing or selling any copies of the Reports of cases argued and determined in said Court, already published or to be thereafter published by L. in pursuance of his contract, containing any of the head-notes or summary statements of points decided, or any foot-notes, copied or taken or colorably altered from any book so published by L.

Considerations stated, in regard to the granting of provisional injunctions.

(Before CONKLING, J., Northern District of New York, February 27th, 1851.)

THIS was a motion for a provisional injunction, founded upon a bill and affidavits. The plaintiffs claimed the exclusive right to print, publish and sell a book entitled "Reports of Cases argued and determined in the Court of Appeals of the State of New York, with Notes and References and an Index, by George F. Comstock, Counsellor at Law, Vol. III." They alleged that this right had been violated by the defendants, and prayed an injunction to restrain its further infringement.

The bill set forth that, in pursuance of an Act of the

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Legislature of the State of New York, passed May 12th, 1847, (*Laws of 1847, chap. 280, § 73.*) Mr. Comstock was duly appointed Reporter of the decisions of the Court of Appeals, under the official denomination of "State Reporter," and that he immediately entered upon the execution of his office; that, on the 1st day of September, 1850, he prepared the volume in question, the contents whereof were summarily described in the bill; that, by the laws of the State of New York, the State Reporter was constituted a public officer, and was entitled to a salary in full compensation for his services as such Reporter; that the original manuscript matter composed and written by him in virtue of his appointment, became the property of the People of the State of New York, and that they were the legal assigns of Mr. Comstock of all such original manuscript; that, by the laws of the State of New York, the Reports prepared by the State Reporter were required to be published under his supervision, by contract to be entered into by him, in conjunction with the Secretary of State and the Comptroller of the State of New York, with such person as should agree to publish and sell the Reports on the most advantageous terms to the public, and at a price not exceeding three dollars for a volume of five hundred pages, and to furnish to the Secretary of State sixty-four copies of each volume of the Reports, bound in leather; that, in pursuance of such law, on the 20th day of April, 1850, a contract was entered into by Mr. Comstock, State Reporter, Christopher Morgan, Secretary of State, and Washington Hunt, Comptroller, with the plaintiffs, whereby it was agreed that the plaintiffs should, during the next ensuing five years, publish the decisions of the Court of Appeals, and have the exclusive benefit of the copyright to be taken out in behalf of the State, "of the notes and references and other matter furnished by the Reporter connected with said decisions," which contract was therein declared to be "an assignment and transfer of the copyright of the matters so published" to the plaintiffs; and that the plaintiffs agreed to publish such decisions in the man-

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ner and on the terms required by law and specified in the contract, and to deliver the number of copies required by law, and ten additional copies to the Reporter, for exchanges, and that they would at all times keep the work on sale at a price not exceeding two dollars and fifty cents per copy. The plaintiffs further averred that, by an Act of the Legislature of the State of New York, passed April 9th, 1850, it was provided that the copyright of any notes and references made by the State Reporter to the Reports of the judicial decisions of the Court of Appeals should be vested in the Secretary of State, for the benefit of the People of the State; that, on the 20th day of November, 1850, a printed copy of the title of the book in question was deposited in the Office of the Clerk of the District Court of the United States, according to law; that the plaintiffs, by virtue of their contract with the State, were vested with the sole right to publish the original matter composed by Mr. Comstock and contained in the volume in question, and were entitled by law to be protected in the enjoyment of that right; that, on the 21st day of November, 1850, and in pursuance of their contract, the plaintiffs printed and published the work, and caused to be inserted and printed, on the proper page of each copy thereof, the words, "Entered, according to Act of Congress, in the year 1850, by Christopher Morgan, Secretary of State, in trust for the State of New York, in the Clerk's Office of the District Court of the United States for the Northern District of New York;" that, within three months from such publication, they delivered a copy thereof severally to the Clerk of the District Court, the Librarian of the Smithsonian Institution and the Librarian of the Congress Library; and that they had at all times kept, and still had on sale, a sufficient number of copies of the work for the use of the public, at the stipulated contract price; and that, with full knowledge of the facts set forth in the bill, and without the consent of the plaintiffs, the defendants had caused the work to be printed and published, and had sold many copies, and had on hand many copies thereof.

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Accompanying the bill was an affidavit made by one of the plaintiffs, verifying an original letter thereto annexed, bearing date October 16th, 1850, and addressed to the Governor and Secretary of State of the State of New York, by the defendants, in which they avowed that they had commenced the printing, and were about to publish an edition of the work in question, describing it by its full title. The letter concluded as follows: "This notice is given, to the end that you may resort to any legal measures for the purpose of restraining our action, which you may be advised to take; and, in case you omit so to do forthwith upon the receipt of this notice, we will give the same in evidence on any motion you may subsequently make for an injunction or other process against us."

No formal answer had been put into the bill, but an affidavit sworn to by William Gould, one of the defendants, was read in opposition to the motion, in which it was stated that, after the sending of their letter to the Governor and Secretary of State, they proceeded with their enterprise therein mentioned, and prosecuted the same in the city of Albany, where the plaintiffs and the State Officers also resided, without being notified by either of any objection to the further prosecution of their undertaking; that the defendants were abundantly able to pay many times the amount of any damages which could lawfully be awarded against them for the supposed injury complained of by the plaintiffs; that their books would furnish the ready means of ascertaining the number of copies of Comstock's Reports which they might sell; that the sale of their edition would be almost entirely defeated, and irreparable injury would be done to them, should an injunction be now allowed, while no damage not susceptible of ascertainment and compensation would accrue to the plaintiffs from the denial of an injunction; that they were advised by their counsel and believed they should be able to show that Mr. Comstock was not lawfully appointed State Reporter, and that the People of the State of New York did not become his assigns; that the plaintiffs were not the legal

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assigns of the copyright of the book in question ; that only a single number of the volume described in the bill had yet been published by the plaintiffs ; that Christopher Morgan, Secretary of State, was not the author or the legal assign of the author of the work ; that the defendants had acted in the premises in good faith, under the belief that they had the constitutional, legal and equitable right to do what they had done ; and that, as they were advised by their counsel and believed, they had a good and substantial defence on the merits to all the matters contained in the bill.

John C. Spencer, Nicholas Hill, Jr., and John K. Porter,
for the plaintiffs.

Azor Taber and Otis Allen, for the defendants.

CONKLING, J. To maintain the denial by the defendants of the plaintiffs' title, their counsel rely mainly upon a provision contained in the Constitution of the State of New York.

By the Constitution and laws of the United States, authors are invested with the exclusive right and liberty, for a limited period, of printing, re-printing, publishing and vending their books ; and this right is extended to their executors, administrators and assigns. The right is held to belong to the reporters of judicial decisions in common with other authors, to the extent of their authorship in the composition of their works. It does not comprise the written opinions of the judges, because of these the reporter is not the author, and it has been said by the Supreme Court of the United States that the judges of that Court cannot confer on the reporter of its decisions any copyright in the written opinions delivered by them.

Under this well-known state of the law of the land, as declared in the Constitution and Statutes of the United States, and by the authoritative interpretations they had received, the People of the State of New York saw fit, in 1846, by the 22d section of the 6th article of the Constitution adopted in

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that year, to ordain as follows: "The Legislature shall provide for the speedy publication of all statute laws, and of such judicial decisions as it may deem expedient. And all laws and judicial decisions shall be free for publication by any person." According to the interpretation given by the counsel for the defendants to the second member of this section, its direct and sole design was, so far as judicial decisions are concerned, to secure to all persons the right to do precisely what the Court is now called upon to restrain the defendants from doing—the right to re-print and sell, *ad libitum*, any volume of Reports published in pursuance of any law of the State enacted in obedience to the injunction contained in the first branch of this section. The counsel insist, therefore, that the Act of April 9th, 1850, mentioned in the bill of complaint, purporting, to a limited extent, to invest the Secretary of State, for the benefit of the People of the State, with the copyright of Reports to be prepared by the State Reporter, is unconstitutional and void.

One of the answers given to this objection is, that the expression "judicial decisions," occurring in the last member of this section of the Constitution, does not admit of being restricted to the sense thus ascribed to it; but that the provision embraces, by its very terms, "all" judicial decisions, whether required by law to be published or not, and would extend, therefore, to the Reports which have been, and are likely to continue to be, published, of the decisions of other Courts of the State of New York, as well as to the Reports now in controversy. And it is rightly argued that, if this is the true construction, and if it is true, also, that the absolute common right intended to be secured was that of re-printing Reports prepared and published by others, it would follow that this provision of the Constitution of the State of New York is repugnant to the Constitution and laws of the United States, and, therefore, void; for, it is undeniable that a State cannot in any form interfere in this respect with the rights of private persons. For this reason, unless this interpretation of the language of the State Constitution is unavoidable,

it ought to be rejected ; and, after carefully considering the ingenious argument of the counsel for the defendants, designed to show that the judicial decisions referred to in the last member of the section under consideration, are such only as shall be designated by the Legislature for publication in obedience to the first part of the section, I am of opinion that this proposition cannot be maintained. It is inconsistent with the phraseology actually used, and with the omission of words which, if such an interpretation had been intended, would naturally have been employed. The words "*all* judicial decisions" must be held to mean what they naturally import—not all *such* judicial decisions only as the Legislature should direct to be published, which is what they do not import. It follows, then, that if the license designed to be secured to all persons, extends to the re-printing of all Reports prepared and published by others, notwithstanding a copyright may be asserted therein by the author, this provision is obnoxious to the objection that it transcends the limits of State authority, and is, consequently, invalid. It is necessary, therefore, as already observed, to seek for it some other interpretation which, while consistent with the language of the provision, and with its spirit, so far as that can be discerned, shall be consistent also with the Constitution and laws of the United States ; and, in my judgment, there is no serious difficulty in finding such an interpretation, although it may be no easy task to discover the precise nature of the evil against which the provision was designed to guard.

On looking into the proceedings of the Convention, I observe that this section was proposed by a member, after the adoption, on the same day, of a resolution to arrest all further debate on the Article relating to the Judiciary, and, having been decided by the President to fall within the scope of this resolution, the vote upon it was taken immediately, without explanation or debate, and it was adopted by a majority of twenty-seven. Its language is mandatory, and it is addressed to the Legislature. It directs, (1.) That pro-

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vision shall be made by law for the speedy publication of *all* statute laws, and of *such* judicial decisions as the Legislature may deem expedient; and (2.) That all laws and judicial decisions shall be free for publication by any person. This last direction is obviously intended to promote and extend the design of the first. This design was expressed in the section as originally proposed and adopted, by the addition, to what now stands as the first sentence, of the words, "so as to render the same easy of acquisition by the People;" and then followed, separated only by a semi-colon, the words which now stand as the second sentence. The words just quoted were expunged in the process of final revision, doubtless because they were seen to be wholly unnecessary, the object being too apparent to require elucidation, and a period was substituted for the semi-colon. I have narrated the history of this section, not because it appears to me to shed much light upon the question under consideration, but because it is relied on by the counsel for the defendants to support the interpretation on which they insist. A deliberate review of their argument on this point has failed to convince me of its soundness. The just view of the subject appears to me to be this. The first part of the section having peremptorily enjoined the speedy publication of the more authoritative and important judicial decisions of which it most concerned the public to be speedily apprised, the rest was left to private enterprise; but, lest some impediment should be thrown in the way, (not by the claim on the part of the author to copyright, which was beyond the power of the Convention,) but by the Legislature or the Courts, or in some other way not easily divined, it was, by the second part of the section, ordained that no such restriction should be imposed, and it was made the duty of the Legislature, if necessary, to see that this should not be done. In other words, it was declared, not that when one person had performed the labor of preparing, and incurred the expense of printing from manuscript, a volume of Reports, any other person should be at liberty, in spite of the author or his assignee, to intercept

and appropriate, or destroy, the just rewards of the enterprise, by rapaciously seizing upon the book and re-printing it, but that the right to engage in such original enterprises should remain common to all. Assuming this, as I feel warranted in doing, to be the just interpretation of this constitutional provision, I dismiss it from further consideration.

But it is further objected by the counsel for the defendants, that, conceding the validity of the Act of April 9th, 1850, in virtue of which the copyright of the book in question is claimed by the plaintiffs, still the defendants are not chargeable with any infringement of this right, because, as they argue, the book does not contain anything which can properly be denominated "notes or references," to which alone a copyright in behalf of the People of the State of New York is asserted by the Act. The answer given to this objection by the learned counsel for the plaintiffs is, that the prohibition contained in this Act against the securing or taking by any person of a copyright for the Reports of cases decided by the Court of Appeals, with the exception therein mentioned, is in conflict with the provisions of the Constitution and laws of the United States securing, absolutely, to authors and their assignees, the exclusive right to the fruits of their intellectual labors. But to this it may be replied, that Mr. Comstock having consented to accept and hold his office, and to prepare the book in question for the press, under a law of the State expressly declaring that he should have no pecuniary interest in the work, and that no copyright should be taken therefor, except to a limited extent by the Secretary of State, for the benefit of the People of the State, must be considered as having surrendered his rights as author, and was incompetent to confer them on another; or, it may be said—which, however, would be little else than the assertion of the same principle in a different form—that the rights and disabilities of his office being prescribed by law, are to be regarded as conditions of the tenure by which it was held, which were binding upon him, and which a Court of justice ought not to aid him in violating. But it

is to be further observed, that the enjoyment of the right in question is by law made to depend, except in the case of an unpublished manuscript, upon the condition of taking certain steps demonstrative of the author's intention to insist upon his rights in this respect, and adapted to convey notice to all others of such intention, and that, if he omits this precaution, he is to be deemed to have abandoned his claim to protection. Now, in the present case, the author has not complied with this condition. It is said, indeed, that Mr. Morgan is the assignee of the rights of the author, and, as such, has taken the required measures for their security. But Mr. Morgan acted, throughout, in a fiduciary and representative character, as the agent of the People of the State of New York, and in execution of a trust imposed upon him by law. And it thence follows, I think, that he could not in that character acquire, and that he was therefore incompetent to convey to the plaintiffs, any rights cognizable in a judicial tribunal, except those of which, according to the terms of the laws under which he acted, he was to become the recipient. To this extent, however, it may be assumed, as I do not understand it to be denied, that he might lawfully act, and that his acts ought to be held valid and effectual by this Court, provided the laws under which he acted are, as I hold them to be, not inconsistent with the Constitution of the State of New York. It becomes necessary, therefore, in the next place, to ascertain the limits of the authority vested in the Secretary of State, in trust for the People, by the Act of April 9th, 1850; and, for this purpose, before proceeding to notice more particularly the provisions of this Act, I propose to advert to some antecedent enactments relating to the subject.

At the session of the Legislature next after the adoption of the Constitution, an Act was passed providing for the appointment, by the Governor and Lieutenant-Governor, of a Reporter of the decisions of the Court of Appeals, to be denominated "State Reporter," who should hold his office for three years, unless sooner removed by the concurrent vote of

both branches of the Legislature. This Act (*Act of May 12th, 1847, chap. 280, §§ 73, 74.*) contains the following enactment: "The Reporter shall have no pecuniary interest in such Reports, but they shall be published by the Secretary of State, under the supervision of the Reporter, by contract to be entered into, pursuant to the provisions of the Act, entitled 'An Act in relation to the public printing,' passed March 5, 1846. Such contract shall be made with the person who, in addition to furnishing the said Secretary sixty-four copies of each volume of said Reports, bound in leather, as soon as may be after the same is prepared, shall agree to publish and to sell them at the lowest price by the number and volume, according to the pages therein contained; such Reports shall be published in numbers every second month. And the Reporter shall prepare for each volume such digests and tables of contents as are usually prepared for similar Reports. If the Reporter shall neglect to discharge his duty faithfully, it shall be the duty of the said Court to report that fact to the Legislature, to the end that he may be removed from office. The Reporter shall not practise as an attorney, counsellor or solicitor in any Court." Of the copies to be delivered to the Secretary of State, the Act requires one copy to be by him delivered to the clerk of each county of the State. It was under this Act that Mr. Comstock, as alleged in the bill, was, on the 27th day of December, 1847, appointed State Reporter. By another Act, passed on the same day, the salary of this officer had been fixed at the sum of \$2,000.

By an amendatory Act passed April 11th, 1848, the mode of appointing the State Reporter was changed by the association of the Attorney-General with the Governor and Lieutenant-Governor for that purpose, and it was again enacted that the Reporter should "have no pecuniary interest" in the Reports to be prepared by him as such Reporter, but that the same should "be published under the supervision of the Reporter, by contract to be entered into by the Reporter, Secretary of State and Comptroller, with the person or persons who, in addition to furnishing the said Sec-

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retary of State with sixty-four copies of each volume, shall agree to publish and sell the said Reports on terms the most advantageous to the public, and at a rate not exceeding the price of three dollars for a volume of five hundred pages, regard being had to the proper execution of the work." The 3d section of this Act is as follows: "§ 3. It shall not be lawful for the Reporter, or any other person within this State, to secure or obtain any copyright for said Reports, notes or references, but the same may be published by any persons." It may not be amiss here also to recite the remaining provisions of this Act. They are contained in the 4th section, and are as follows: "As often as the Reporter shall have prepared for publication sufficient of the said Reports, with notes and references, to constitute two hundred and fifty pages of the usual size of law Reports, he shall cause the same to be published in pamphlet form, with such headings as will appear in the bound volumes, and shall furnish a copy thereof to each county clerk's office at the expense of the State, and keep the same on sale at contract prices for all persons who may want to purchase; such printing to be done by the person who shall contract to publish the Reports under this Act, at and in proportion to the prices stipulated in his contract." (*Act of April 11th, 1848, chap. 224.*)

The only remaining enactments which it is necessary to notice, are contained in an Act to amend that last cited, the third section of which is thereby declared to be amended so as to read as follows: "§ 3. It shall not be lawful for the Reporter, or any other person within this State, to secure or obtain any copyright for said Reports of the judicial decisions of the Court of Appeals, but the same may be published by any person." The Act further provides: "§ 2. The copyright of any notes or references made by the State Reporter to any of said Reports shall be vested in the Secretary of State, for the benefit of the People of this State." (*Act of April 9th, 1850, chap. 245.*)

Now, the question is whether, according to the proper construction of the words, "any notes or references made by the

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State Reporter to any of said Reports," contained in the last-mentioned Act, these words comprise any, and, if so, what portion or portions of the volume in controversy. The counsel for the defendants strenuously insist they are referable exclusively to such original notes or references as the State Reporter might see fit, of his own accord, to superadd to what would otherwise be in themselves complete Reports of the cases by him reported; and the example of the late Mr. Justice Cowen, while Reporter to the Supreme Court of the State of New York, to whom the profession were so much indebted for the learned essays with which his great industry and love of jurisprudence impelled him to accompany his Reports, is adduced as an example.

The words "notes or references," as we have seen, first occur in the Act of April 11th, 1848, chapter 224. By the 3d section of that Act, the State Reporter and all other persons are expressly forbidden "to secure or obtain any copyright for said Reports, notes or references;" and the 4th section directs the immediate publication of the Reports, from time to time, as often as "the said Reports, with notes and references," shall be sufficient to make two hundred and fifty pages. Now, it is to be observed, that the words in question, in the sense in which they are understood by the counsel for the defendants, import nothing that has ever been supposed to pertain to the business of reporting judicial decisions, and nothing, therefore, which a Reporter has ever done except at his own option merely. It is what few Reporters have in fact done to any considerable extent, and what others have altogether omitted. There is nothing in either of the Statutes relative to the subject, expressive of any design to exact this kind of labor of the Reporter, and nothing in any other part of them indicative of any expectation that he would engage in it. It was what the State Reporter might, perhaps, lawfully do, to a moderate extent, if he should see fit, but what he certainly was at liberty to omit at his pleasure, and what it could not therefore reasonably be assumed he was likely to undertake. It was what, if he should perform it, would

be the fruits of his extraordinary labor, and that to the pecuniary profits of which, therefore, he would in justice be exclusively entitled. Without stopping, then, to inquire whether the Legislature had the power, is it probable that it entertained the design to deprive him of the reward due to his enterprise and learning? And, having done this by the prohibition contained in the 3d section of the Act, is it probable that it would have been assumed, as it seems to have been done in the next succeeding section, that the Reporter would nevertheless gratuitously accompany his reports with such notes or references? I am of opinion that these questions must be answered in the negative; and, unless the words in question are to receive a different interpretation in the Act of April 9th, 1850, which, to the extent of its provisions, must govern the rights of the plaintiffs, so far as they depend on State legislation, it follows that the rights with which the Act invests the Secretary of State, are not restricted to the narrow limits insisted on by the counsel for the defendants. The two acts being *in pari materia*, the presumption is strong that the words "notes or references" were not designed to be used in different senses. But, in truth, the interpretation which they appear to me, as I have already stated, to require in the Act of 1848, is fortified, in its application to them, in the Act of 1850. This Act declares, that the copyright of any notes or references made, &c., shall be vested in the Secretary of State, for the benefit of the People. Now, bearing in mind the nature of the notes or references of which the words of the Act are supposed by the defendants' counsel to be descriptive, and the improbability that the Reporter would even take the trouble to make them at all, is it to be imagined that the Legislature thought it worth while, to say nothing of the injustice of doing so, solemnly to claim them as the property of the State? I think not; and it follows, therefore, that these words were intended to designate some portion or portions of the Reports, constituting an essential ingredient of their integral composition, and which the State Reporter, as such, was therefore bound to supply. The next

question, then, is, What part or parts of the Reports are to be considered as comprised by these words? And herein lies the chief difficulty of determining their true interpretation.

The word *note* has many significations. Among the fifteen definitions given of it by Webster, the greatest lexicographer of the English language that has yet appeared, the twelfth is this: "Annotation; commentary; as the *notes* in Scott's Bible; to write *notes* on Homer." This is the definition insisted on by the defendants' counsel, but which, for the reasons already assigned, I hold to be inadmissible. The third definition given by Dr. Webster is this: "A short remark; a passage or explanation in the margin of a book;" and his fourth definition is this: "A minute, memorandum or short writing, intended to assist the memory." These are all the definitions which it is pertinent to notice, and the two last mentioned furnish, in my opinion, the proper guide in determining the scope of the word *note* in the statute. That it comprises the summary of the points decided by the Court, which immediately follows the title of the suit in each case reported, and the foot-notes, in the volume in question, is indubitable. Does it embrace, also, the arguments of counsel? The process by which this portion of the report of a case is prepared, is well known. The arguments are unwritten, and addressed to the Court *ore tenus*, and a minute or memorandum, or short writing, intended to assist the memory of the Reporter, is made by him at the time, from which he constructs the arguments which ultimately appear as one of the constituent elements of his Report. I am of opinion, therefore, that they ought to be adjudged to fall within the scope of the expression, "any notes made by the Reporter." The only remaining portions of the matter contained in the book in question, (which I understand to be, in fact, the *first part* of Volume III. of Comstock's Reports, this being all that I have seen, and all that the defendants in their affidavit admit to have been published,) that are susceptible of being made the subject of copyright, even independently of the State law, are the abstracts of the pleadings and statements

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of facts, which form the basis of the decisions reported. These can, in no proper sense, be denominated *notes*, nor am I able to perceive that they fall under the denomination of "references." If the book contains anything embraced by this latter word, it is the table of contents, entitled "cases reported," which consists of the titles of the suits comprised in the book, with *references* to the several particular pages where the cases are to be severally found. This constitutes but a very inconsiderable portion of the work; and, as it would be inapplicable to a re-print, unless its pages corresponded exactly with those of the original, I presume it has not been appropriated by the defendants, though I have not seen their book.

It appearing, from this review of the course of State legislation, that a copyright in the work in dispute was reserved to the People of the State, and the authority to secure it for their benefit vested in Mr. Morgan, the next question for consideration is, whether, in virtue of the contract with the plaintiffs, set forth in their bill of complaint, they obtained such a title to the subject of the controversy as is requisite to enable them to maintain their suit.

In some of the English cases to which I am referred, it is said that, to entitle a plaintiff to an injunction, in a case of this nature, he must establish a valid legal title to the copyright. Undoubtedly, when he relies upon a legal title, he is bound to set it forth, and it must appear to be at least *prima facie* valid. But, it has also been held, that there are cases in which an equitable title is sufficient to entitle its possessor to protection in this form. In the present case, an agreement has been entered into between the plaintiffs and certain officers of the State, designated by law for that purpose, the author of the work in question and the Secretary of State being of the number, by which it is stipulated that, upon the terms therein mentioned, the plaintiffs shall have the exclusive right to the publication of the decisions of the Court of Appeals, and to the benefit of the copyright to be taken out in behalf of the State therefor, during the period of five

years. By an Act of the Legislature then recently passed, it was declared that the copyright of certain specified portions of the Reports of such decisions should be vested in the Secretary of State, for the benefit of the People of the State. With respect to the particular manner in which this right should be made advantageous to the People, the Act was not explicit. This was left, therefore, measurably, to the discretion of the Secretary. He and his associates were, however, expressly required by law to see that the Reports were speedily published and exposed to sale at a price not exceeding three dollars per volume. Perhaps they would have been authorized to contract for their publication and sale at that price, on condition that the publisher would pay a certain sum to the State for the privilege, provided a suitable person could have been found willing to become a party to such a contract. But they saw fit, and in strict accordance with the policy adopted by the Legislature, of providing a sufficient supply of the Reports at moderate prices, so to use the copyright as to make it conducive to that end, by offering to confer the emoluments arising therefrom, for a portion of the period during which it was to continue, on the publisher who would agree to furnish the required supply of the Reports at the lowest prices. The plaintiffs having, as it is to be presumed, offered the most favorable terms, the contract was made with them, they stipulating to publish and sell the Reports at the very low rate of two dollars and fifty cents for a volume of five hundred pages.

It is objected, that this contract was entered into before the book in controversy was prepared for the press. But, from the nature of the case, this could not have been otherwise without incurring delays subversive of the policy of the laws under which the agents of the State were acting. It seems clear, therefore, without pursuing the subject further, that these gentlemen, in entering into this contract, acted in strict accordance with the laws of the State, and that the plaintiffs are justly entitled to all the benefits arising from it which the State could confer. If it is not valid and effectual

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to the extent contended for by the plaintiffs, it is altogether nugatory, and the plaintiffs must seek redress, not from a judicial tribunal, for the violation of their copyright, but from the State, for the breach of its plighted faith. It is true they are not the assignees of the entire privilege reserved by the State, of asserting a copyright to the volumes of the Reports to be prepared by the State Reporter, as they shall be successively issued from the press, through all future time; but, to the beneficial interest in the copyright of the volumes to be published during the stipulated term of five years, it was designed to give them a perfect title. So far as this could be done by the supreme authority of the State, it has been done; and I am not aware of any grounds on which I should be warranted in deciding that it has not been done effectually. If it has not been, it must be because the subject is not in its nature susceptible of municipal regulation. But, in the compact between the State and the State Reporter, by which the latter relinquishes and the former assumes the copyright in the Reports, I can discern nothing inconsistent with the Constitution and laws of the United States. It may be regarded as an assignment by operation of law. Can it be successfully contended, that the exclusive right guaranteed by the laws of the Union has in this instance become extinct? If not, it must have vested in the State, and passed temporarily to the plaintiffs, who alone, at the present time, are competent to enforce it. Assuming this to be so, I think it follows that the plaintiffs have shown themselves to be in possession of a title to the work in question, of which this Court is bound to take cognizance. Indeed, there is no want of precedent in our own Courts on this point, if it were necessary to invoke it. Thus, in the case of *Folsom v. Marsh*, (2 Story, 100,) which was a bill in Equity to restrain the infringement of Dr. Sparks' copyright in the writings of Washington, the interest claimed by the plaintiffs was described in the bill to consist in their having "assumed a part of the risk and responsibility of publishing the said work;" and the suit was maintained, and a perpetual injunction awarded.

Under this view of the substantial merits of the controversy, it remains only to determine whether an injunction ought to be withheld for the reasons so earnestly addressed by the learned counsel for the defendants to the discretion of the Court. It certainly must be conceded that the case involves questions by no means entirely free from obscurity and doubt; and if, as the counsel seem to suppose, this ingredient of itself always constitutes a conclusive objection to the grant of a provisional injunction to restrain an alleged piracy of a copyright, the only duty which would remain to me, after making this concession, would be the simple denial of the motion. But it is for the express purpose of resolving doubts with respect to the rights and responsibilities of parties, that Courts are instituted; and, even on a motion of this nature, it is not every kind or degree of doubt that will absolve a Judge from the responsibility of deciding questions presented for his consideration, much less from the labor of investigation and reflection. It must, at least, be a serious doubt, which remains after the faithful application of his faculties to its solution. If it were otherwise, this form of redress would be illusory. Doubts affecting a plaintiff's title may arise either from uncertainty with respect to the facts, or with respect to the law on which the title depends. In the present case, I do not understand that there is any dispute concerning the facts—certainly none respecting which there is any probability, not to say possibility, that any conflicting evidence could be adduced. There is nothing, therefore, which it would be proper to submit to the decision of a jury. The questions on which the rights of the parties depend are questions of law, arising mainly out of certain provisions contained in the Constitution and statutes of the State of New York, and these questions the Court is bound, at some stage of the controversy, to decide. But it is objected that they are new, never having been settled by acquiescence, or *by the adjudication of any Court*. An injunction in a case of this kind, it is said, has never been granted in England without a trial at law; and it is broadly

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intimated that to do it in this case would be *iniquitous*. It would, it is argued, be to prejudge the case, to decide it, and to award execution before trial. These are grave objections, and, if well founded, certainly ought to be held to be decisive. But it is because these questions have never before been judicially determined, that they are now before this Court for decision; and, with respect to the practice of English Courts of Chancery, of sending pure questions of law to be settled in a suit at law, the adoption of this practice by the Circuit Courts of the United States would, for obvious reasons, be an absurdity. As to the assertion that, to allow an injunction now, would be to decide the cause without a trial, it is proper to remind the counsel that the case has already been elaborately argued; and it is easy to see that its legal features are not likely to be essentially changed by the substitution of a formal answer for the affidavit of one of the defendants. The parties, therefore, have already had a trial of the only kind they ever can have while the question is not, as it would be on a final hearing, whether the defendants should be perpetually enjoined, but whether this shall be done temporarily, leaving them at liberty, if they see fit, to re-argue the case on a final hearing.

If any additional reasons were wanting why I should not hold myself at liberty fastidiously to decline the responsibility of giving effect to the conclusions at which I have, however doubtingly, arrived, by granting an injunction, such reasons might easily be found in the demerits of the defendants. There can be no injustice in assuming that they have acted with full knowledge of all the facts detailed in the bill of complaint. Their extraordinary letter, already mentioned, shows this. They are chargeable, therefore, not only with a wilful and apparently very discreditable encroachment upon the rights of the plaintiffs, but with openly arraying themselves against the supreme authority of the State. There may possibly be circumstances, growing out of a spirit of rivalry between the parties, affording some palliation for conduct apparently so unjust and audacious; but of this I

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know nothing, and it may at least be safely assumed that they can furnish no shadow of justification to the defendants.

I am of opinion, therefore, that the plaintiffs are entitled to an injunction, restraining the defendants, their agents, servants and workmen, until the further order of the Court, from further printing, publishing, selling, or otherwise disposing of any copy or copies of the Reports of cases argued and determined in the Court of Appeals of the State of New York, already published or to be hereafter published by the plaintiffs in pursuance of their contract with the State, set forth in their bill, containing any of the head-notes or summary statements of points decided, or any arguments of counsel, or any foot-notes, copied, taken or colorably altered from any book so published by the plaintiffs.

OBADIAH H. PLATT *vs.* CHAUNCEY JEROME.

J., for the accommodation of M., accepted a draft drawn by M., payable to his own order. In a suit against J. on the draft, brought by P., to whom M. transferred it before due, J. set up that his acceptance was obtained by fraud: *Held*, that a receipt signed by M., expressing a consideration for the transfer of the acceptance to P., was not competent evidence against J., to prove the payment of value by P. for the acceptance.

Before the draft was passed to P., it was put by M. into the hands of one B., to negotiate. B. inquired of J. as to the draft, who said it was a business draft and would be paid at maturity. Afterwards, and before taking the draft, P. applied to B. to know what J. had said about the draft, and was told, and then took the draft: *Held*, that P. could not be in any more favorable position, as regarded the inquiries he made of B., than if he had made them of J. himself, in which case he would have been bound to disclose to J. any knowledge he had that J. had been defrauded in giving the acceptance.

Held further, that if P., when he applied to B., knew that J. had been defrauded in giving the acceptance, such knowledge would affect his title to the draft.

(Before NELSON, J., Southern District of New York, April, 1851.)

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THIS was an action by endorsee against acceptor, on the following draft :

"\$1,678 73. Poughkeepsie, N. Y., March 1st, 1844.

Five months after date, pay to my order, at the Union Bank in the city of New York, sixteen hundred and seventy-eight 73-100 dollars, for value received, and place to the account of

Your obed't servant,

Mr. Chauncey Jerome,

Franklin Merrill.

New Haven, Ct.

(Endorsed,)

Franklin Merrill.

Pay N. G. Ogden, Esq., Cashier,

O. H. Platt."

The draft was accepted by Jerome. At the trial, before NELSON, J., in May, 1849, it appeared that the draft in question and several others were accepted by Jerome under an arrangement with Merrill, which was set forth in a receipt given by Merrill to Jerome at the time, as follows: "Received, New York, March 1st, 1844, of Chauncey Jerome, the following notes, which I receive as advances to raise money on for my own business, to purchase wool before the clip, if deemed proper, and funds or wool I agree to put in his hands before the following notes and acceptances fall due, and agree to see the said Jerome harmless from all trouble for so doing, and have given the said Jerome a writing from H. Martin & Co., that this matter is guaranteed by them, that the wool or money shall be in his hands in season to raise or take up the notes and acceptances. I also agree to take the same up myself. Franklin Merrill." To this receipt was annexed a list of notes and acceptances amounting to \$17,800, among which was the one in suit, and under the list was written: "The above notes and acceptances I receive as advancement on wool, and agree to save Mr. Jerome harmless, and am to take up the paper myself. Franklin Merrill." The draft in suit was transferred to the plaintiff on the 4th of April, 1844. He on that day deposited it in

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the Phoenix Bank, New York, for collection, where it remained till maturity, when it was protested for non-payment, and returned to the plaintiff.

The defendant insisted that the acceptance was without consideration, and for a particular purpose, namely, to purchase wool, under the agreement above set forth. He also introduced evidence to show that the acceptance was procured from him by fraud on the part of Merrill. The evidence went to show, among other things, that the firm of H. Martin & Co., mentioned in the above agreement, was insolvent and irresponsible at the time; that a guaranty, signed "Henry Martin & Co.," which was given to Jerome, was signed by one of that firm without the assent or authority of his partners; and that that fact was known to Merrill at the time. The guaranty was as follows: "Mr. Chauncey Jerome, Sir: Any arrangement which you and Mr. Franklin Merrill may enter into in regard to your making advances to Merrill we will hold ourselves responsible for, that the advances shall be met as may be agreed upon between you and him. New York, March 4th, 1844. Henry Martin & Co."

The plaintiff, then, for the purpose of rebutting the defence, offered in evidence a receipt given by Merrill to him, as follows: "Received of O. H. Platt his receipt in full for an account of Four Hundred Dollars, due Reynolds, Platt & White for professional services; also a deed of one hundred and sixty-eight acres of land in Jackson, Mississippi, from said Platt, at a valuation of six hundred and twenty-eight dollars twenty-one cents, and six hundred dollars in cash, for which I have placed in his hands and sold to him a draft upon Chauncey Jerome, New Haven, for sixteen hundred and seventy-eight dollars and seventy-three cents, at five months, dated March 1st, 1844, and accepted by him, payable to my order, and endorsed by me, which draft is fair business paper. Dated April 4th, 1844. Franklin Merrill." The defendant objected to the admission of the receipt in evidence, but it was admitted, and the defendant excepted. The plaintiff also showed, that in March and April, 1844, he was an attorney

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and counsellor at law, in the State of New York, and that, when the above receipt was given, he had an account against Merrill for professional services rendered to Merrill in New York in January, 1844. Merrill died in the winter of 1844.

The plaintiff further insisted that he took the paper on the faith and strength of representations made by the defendant in relation to it. For this purpose, he introduced as a witness one Burr, who testified that he was a broker; that, between the 15th and 20th of March, 1844, he had in his hands for negotiation the draft in question, with a number of other drafts and notes against Jerome, amounting in all to \$9,500, all of which he had received from Merrill; that he at that time went to Jerome with the draft, and presented it to him, and he said it was a business transaction, and all right, and that they were all genuine business notes; that he told Jerome he wanted to know if it was all regular, that he might negotiate it; and he replied that it was, that it was a regular business transaction, that the draft was a business draft and was all right, and would be paid at maturity, Jerome having taken the draft into his hands and examined it before he answered; that the witness returned all the drafts to Merrill, having failed to negotiate them; and that, on or before the 1st of April following, the plaintiff called on the witness, and inquired of him in relation to his said conversation with Jerome about the draft, and the witness stated to him the substance of said conversation.

The defendant then introduced evidence to show, that the plaintiff, when he made the inquiry he did of Burr, and when he took the draft, knew that a fraud had been committed by Merrill on Jerome, in procuring the acceptance. Henry Martin, who signed the guaranty, testified that, a short time after he signed it, he became uneasy about it, from what he heard of Merrill, and said so to Merrill; that Merrill then took him to the plaintiff's office, and Merrill and the plaintiff went into a room by themselves, and were there together for some time; that, when they came out, the plaintiff said the

guaranty was not binding on the firm, and that that was ten or fifteen days after the witness signed the guaranty.

The Court charged the jury that, as to the fraud alleged by the defendant, it appeared that he was to be indemnified by the firm of H. Martin & Co., but that that house was not responsible, and the indemnity given was void and did not bind the firm; that there was ground, therefore, for saying, not only that the acceptance was without consideration, but that there was fraud; that, in this aspect of the case, the burden would be thrown upon the plaintiff, to show that the paper came to him *bonâ fide* and for a consideration; that the plaintiff had set up, as one ground in answer to the fraud, that he paid a consideration for the draft, and in that respect complied fully with the rule of law; that, in this view, he had given in evidence the receipt from Merrill to him; that it appeared, that on the day of the date of the receipt the draft was in the plaintiff's possession, and was deposited by him on that day in the bank for collection; that putting together those facts, with the fact that the plaintiff had an account for professional services, as mentioned in the receipt, the Court, though entertaining doubts on the point, was inclined to think the receipt admissible evidence, and entitled to such weight as the jury saw fit to give it; that, as to the proof of consideration given by the plaintiff, the account and land and cash, if they actually existed and were received by Merrill, constituted a valuable consideration, within the meaning of the rule of law requiring proof of consideration where paper has been procured by fraud; that the plaintiff further insisted, that he took the paper on the faith of representations made by Jerome, and was, therefore, not bound to prove a consideration for it, although it was originally obtained from Jerome by fraud; that this point depended on the testimony of Burr; that it was undoubtedly true, that notwithstanding the draft was originally procured by fraud, and under circumstances which would exonerate the acceptor from payment of it, unless it were in the hands of a *bonâ fide* purchaser, yet if, at the time, the party taking it inquired

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of Jerome as to its character, with a view to take it, it became Jerome to put himself on his rights; that if he was then satisfied there was fraud, he should have taken that ground; and that, if he had not discovered the fraud, still if he chose to represent the paper as good paper, he would be bound by the paper, the same as if no fraud existed in its concoction, because the party who inquired was about to take it, and his representations were sufficient to induce him to take it; that, in such case, the person taking it would be entitled to recover, although he did not show affirmatively that he paid full value for it; that if the plaintiff was privy to the original fraud in procuring the draft, he could not recover, but that he would not be affected by any knowledge he might have acquired of Merrill's fraud before he purchased the draft and before he made the inquiries of Burr.

The jury, after being out some time and being unable to agree, came into Court and requested further instructions. They inquired whether it was important for the plaintiff to make any other proof of the payment of a consideration than the receipt of Merrill, and if the Court considered that good evidence to prove it. The Court replied, that the receipt was evidence of the payment of the consideration. The jury further inquired whether, if they believed that the plaintiff did not pay a full consideration for the draft, they were at liberty to find such an amount as they might believe he did pay. The Court replied, that if the plaintiff had a right to recover at all, he had a right to recover the full amount. The jury then further inquired whether, in case they believed the receipt was true, still if they believed that the plaintiff knew when he took the draft that it had been dishonestly obtained, they should then find for the plaintiff or for the defendant. The Court replied that, independently of the evidence of Burr, such knowledge on the part of the plaintiff would be fatal to his recovery; but that it would not be, if the jury believed the evidence of Burr that Jerome made the representations alleged, and that the plaintiff took the draft on the faith of them.

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The defendant excepted to the several points of the charge. The jury found for the plaintiff, for the amount of the draft, with interest. The defendant now moved for a new trial, on a case.

Seth P. Staples and George C. Goddard, for the defendant.

John E. Burrill, Jr., for the plaintiff.

NELSON, J. 1. I am of opinion that an error was committed in admitting the receipt of Merrill, of the 4th of April, 1844, as evidence of the payment of value for the acceptance in question by the plaintiff at the time of the transfer to him. It would have been evidence against Merrill, but was not as against a third person, in a case where the fact became material. The question here was, whether or not the plaintiff had actually advanced money or property, or had cancelled an indebtedness from Merrill to him, as a consideration for the transfer of the acceptance, with a view to show that he was a *bona fide* holder for value. The fact, when material, must be made out, like any other fact in a cause, by competent evidence. Now, the receipt given by Merrill is of no higher evidence than his admission or statement not under oath, which would clearly have been inadmissible, as it respected any one but himself. I entertain no doubt, on reflection, that I erred in the ruling at the trial on this branch of the case.

2. I think an error was committed, also, in the ruling that knowledge, on the part of the plaintiff, of the fraud committed by Merrill in procuring the acceptance from the defendant, would not affect his title to the same, if such knowledge was acquired before he made the inquiries of Burr and received from him the information given by the defendant as to the character of the acceptance. This was carrying the protection of the holder, under the circumstances stated, too far—further than policy or justice requires, even in respect to commercial paper. The plaintiff cannot claim to be

in a more favorable position, as it respects the inquiries made by Burr, than if he had himself applied to the defendant for the purpose of ascertaining the character of the acceptance ; and then, if he had been aware that a fraud had been committed upon the defendant in the procurement of the paper by Merrill, he would have been bound, in good faith and fair dealing, to disclose the fact, so that the defendant might, when he answered his inquiries, be fully possessed of all the circumstances attending the acceptance of the paper.

If the plaintiff knew that a fraud had been committed in procuring the acceptance, he might well have supposed that, when the defendant confirmed it, on the application of Burr, he was not aware of the fact. And, indeed, from the testimony of Martin, the plaintiff had reason to believe that when Burr applied to the defendant for the information, the latter had no knowledge of the fraud committed upon him. The plaintiff became advised of the fraud about the middle of March, for he gave the advice to Martin, professionally, that the guaranty delivered to the defendant, to indemnify him and keep him harmless against the acceptance, was good for nothing. Burr did not make his inquiries, according to the evidence, till a period somewhat later. At all events, the plaintiff had no reason to suppose that the defendant, when he confirmed the paper to Burr, knew what he, the plaintiff, did, namely, that the guaranty was worthless.

For the reasons above given, and upon a careful consideration of the case, I am entirely satisfied that it was not properly submitted to the jury ; and, from their inquiries, and the response of the Court, it is obvious that the errors led to the verdict that was given. There must, therefore, be a new trial, with costs to abide the event.

ALFRED HALL vs. JOHN WILES.

Where a patent contains several claims, and the invention covered by one of them is not new, the patentee may, under the 7th and 9th sections of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 193, 194,) maintain an action for the infringement of the patent, so far as regards the valid claims, although he did not, before the commencement of the action, make or record a disclaimer of so much of the thing patented as he claimed without right; but he will not be entitled to costs.

Under the 9th section of the Act, the question whether there has been unreasonable negligence or delay on the part of the patentee in entering such disclaimer, is a question which goes to his right of action.

A disclaimer is necessary only where the thing claimed without right is a material and substantial part of the thing patented.

Where the thing claimed without right is a part of a machine, if it is not an essential part, and was not introduced into the patent through the wilful default of the patentee, or with intent to defraud or mislead the public, the want of a disclaimer in regard to it affords no ground for invalidating the patent.

Where one part of a combination is new, the combination is a new one, though the other parts of the combination may be old.

A formal change, such as a change of proportions, a mere change of form, or a different shape, is not, within the meaning of the patent law, a change sufficient to support a patent; but the improvement upon the old contrivance must embody some originality, and something substantial in the change, producing a more useful effect and operation.

In determining the question of patentability, the jury have a right to take into consideration, in connection with the change, the result which has been produced; because the result, if greatly more beneficial than it was with the old contrivance, reflects back, and tends to characterize in some degree the importance of the change.

In this case it was *Held*, that the thing patented, namely, a carriage in a brick-press, was not a combination of materials, within the doctrine of the patent law, and that the principle, that unless the defendant had taken the whole of the combination he was not liable, did not apply.

The rule of law as to damages, when an infringement is made out, is, to give to the plaintiff the actual loss he has sustained, and nothing more. Exemplary or vindictive damages cannot be given.

In this case it was *Held*, that the plaintiff was entitled, if his case was made out, to the profits on all the machines sold by the defendant.

(Before NELSON, J., Southern District of New York, April 17th, 1851.)

Hall v. Wiles.

THIS was an action on the case, tried before NELSON, J., for the infringement of Letters Patent granted to the plaintiff on the 3d of September, 1842, for an "improvement in the construction of the brick-press." * The points raised on the trial are stated in the charge of the Court.

* The specification was as follows: "Be it known, that I, Alfred Hall, of Cleveland, in the county of Cuyahoga, and State of Ohio, have invented a new and useful improvement in the machine for moulding bricks, and I do hereby declare, that the following is a full, clear and exact description thereof, reference being had to the accompanying drawing, making a part of this specification, in which Fig. 1 is an isometrical projection, Fig. 2 is a longitudinal vertical section.

"The nature of my invention consists in constructing a moulding machine, to be attached to a common tempering tub, with revolving knives, of the usual construction, from which the mortar is conducted directly into the moulds, into which it is forced by the press. To this machine, an apparatus is affixed for removing the moulds, and, when obstructed by stones, &c., to relieve them therefrom. The frame of the machine consists of four upright posts, (*A*,) framed into two sills, (*a*) and cap-pieces, (*a* 1,) which are connected by cross-ties, (*a* 2,) forming a stout frame of proper proportions for containing the machinery. To each of the caps (*a* 1) are attached metallic plates, (*B*,) on the inside near the centre of the frame. From the lower part of these plates flanges project, which embrace the caps and serve to steady them: these plates have shoulders at (*b*,) turning inward, from which to the top they are vertical. They are wide enough to form the sides of the hopper, and contain the pressing apparatus hereafter described. A grating, (*B* 1,) which forms the bottom of the hopper, is attached to the plates (*B*) at the shoulder, (*b*,) just high enough to clear the moulds. The bars of this grating correspond with the partitions in the moulds, and must be varied for every different kind of brick; they are chamfered off on their upper edges, and serve to direct the clay into the mould; the back piece of this grating rises at (*b* 1,) (see Fig. 2,) to the press platen, to prevent the escape of the mortar; there is also a similar projection (*b* 2) at the front of the grate, having on its upper edge an apron, (*b* 3,) which rests in the spout of the tempering machine, (shown in dotted lines,) and directs the mortar into the machine. The platen (*C*) is the segment of a cylinder, its lower surface being fitted to the grate and projection, (*b* 1;) it does not extend quite out to the plates, (*B*,) but has a projecting flange (*c*) at each end, around the periphery, and down the under side, made of metal, which shuts out the mortar from the end of the cylinder segment; on each end of this platen an iron cross-brace is let in, (lettered *c* 2;) its inner end has a hole through it on which the platen turns on its shaft or fulcrum, (*c* 3;) from these braces, near the periphery of the platen, studs (*c* 4) project, which extend out through the plates, (*B*,) slots (*b* 4) being cut in them for the studs to play in; these slots are covered when the platen is thrown back, by brass segment slides, (*c* 5,) which are pushed forward from the platen by means of springs, (*c* 6,) which bear against studs projecting from the side of the slides let into its ends; when the platen is forced down, these segments strike the grate and are stopped, the spring yielding for that purpose. The platen thus constructed turns on its shaft, (*c* 3,) which has its bearings in the plates (*B*) by means of a segment rack (*c* 7) outside the plates on each side, with which it is connected by the shaft and studs above named; the teeth on these racks mesh into pinions (*d*) on a shaft, (*d* 1,) which has its bearings in the plates over the platen; on one end of the shaft (*d* 1)

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In charging the jury, NELSON, J., remarked as follows:

The patentee's description of his invention sets it forth with great particularity and clearness, and models have been

there is a large hand-wheel, (*D*), by which the platen is put in motion; between the caps (*a* 1) of the frame above mentioned, a carriage (*E*) is placed; it is formed of two side frames, of a T shape, firmly braced, the horizontal part extending out about the length of the caps, and the vertical nearly down to the bottom of the frame; these T frames are connected by a brace (not shown in the drawing) running from one to the other. Just under the grating, three horizontal rollers (*e*) are placed, having their journals turn in bearings on the upper side of the T frames of the carriage; to these frames, on each side of the roller, slots (*e* 1) are affixed in the upper side; on these the moulds slide; this carriage is sustained in the frame at the rear end, on a cross-piece (*a* 3) which is suspended to the end of the cap (*a* 1) that projects over the post (*A*) by a rod (*a* 4) at each end, which can be drawn up by a screw below the cross-piece; the carriage is steadied by a pivot (*e* 2) projecting from each side, near the end that turns in the posts of the frame, and at the other end by studs, (*e* 3;) these are necessary, as the carriage is made smaller than the space between the sides of the frame, so as to give a free passage to any dirt that may collect on the machine, which would tend to clog its operation, (see section 1.) At the front end of the carriage are jointed stout connecting-rods, (*e* 4,) which extend down to a revolving shaft (*e* 5) which turns in bearings, (*e* 6,) attached to the front posts of the frame, and which are also connected to the cap by rods (*e* 7) running from the cap to the bearings, (*e* 6;) on the upper side of this shaft are short projections, to which the connecting-rods are coupled, and by which this end of the carriage is supported; on the end of the shaft (*e* 5) a lever (*e* 8) is put, which extends up and rests against a pin in the frame near the lever. It will readily be seen, that by bringing the lever forward, the end of the carriage resting on the shaft will be lowered down; on each side of the carriage an iron rail (*e* 9) is affixed, extending from the rear end to the rollers; this rail rises a little above the side-pieces, which are cut out on their upper edge, away from it, except at the points of attachment, so as to allow any dirt that may get upon the rail to fall through without clogging the machine; a wheel (*f*) runs on each side of these rails, which are connected by an axle or movable carriage, (*F*), formed of a square straight piece of wood; a piston (*f* 1) is attached to the back of this carriage, which curves down and runs forward horizontally under the centre of the machine, just below the cross-piece connecting the sides of the carriage, against which, or a friction roller which may be attached thereto, it bears when in motion; on the under side of this piston a rack is formed, which meshes into a segment rack (*f* 2) on a shaft, which has its bearings in the lower end of the vertical pieces of the carriage above named; to the end of the shaft (*f* 3) a lever (*f* 4) is affixed; which rises up beside the shaft, (*d* 1,) so as to be convenient to work by the operator; the moulds, (*G*), which are like those now in use in other machines, are put into the machine opposite that on which the wheel (*D*) is; they are prevented from being pushed too far through by a spring, (*g*), which guides them in entering the machine; they are forced under the grating by the movable carriage, (*F*), acted on by the lever, (*f* 4;) when this machine is attached to a "tempering machine," it receives the mortar directly from it into the grating, and into the moulds underneath it; the hand-wheel is then turned, which brings down the platen and forces the mortar into the moulds; the lever (*f* 4) is then brought forward, and the empty mould which is placed forward in the grating between the full mould and the movable carriage, and forced under the

produced which render it perfectly intelligible. After describing the various parts of this machine, the patentee closes, as is usual, with a specification of the particular things which he claims to have invented.

The first is, the segment slides, acted on by springs, in combination with the platen and hopper, constructed and arranged as described in the specification. The object of this contrivance is, to close the slot in the end of the press which was before open, and through which the shaft of the press moves, in order to prevent the mortar from being pressed out of the aperture. The patentee next claims the combination of the carriage E, suspended at its rear end in the frame, with the connecting-rods and shaft for freeing the machine from obstructions. He claims, also, the construction of the carriage E so as to free itself from dirt—meaning all the parts used by him, in the construction of this carriage, to effect the purpose intended—that is, to free it from dirt, which seems to have been a difficult thing in these machines; and he claims, also, the carriage E, thus arranged, in combination with the movable carriage F, constructed in the

grating, the full mould being driven out on the opposite side, the weight of the mortar in the tempering machine, at the same time, raises the platen by its pressure upon it till the segment (c 7) strike against the springs, (b 5,) which prevent the platen from receding too far. If, when the full mould is being forced out, a stone or other obstruction stops its motion, the lever (f 4) is drawn forward, and the carriage on which the mould rests is lowered till the difficulty is overcome, when it is again raised to its place; over the platen, and between it and the shaft, (d 1,) a brace (h) runs across from one side platen to the other, on the under side of which a scraper (h 2) is affixed, that fits close to the circular side of the platen, and serves to free it from the mortar that adheres to it when run down; just over the scraper a board (h 1) is placed, the lower edge of which rests on the scraper, its upper edge projecting up towards the "tempering machine," at an angle of about 45°; this forms the upper part of the hopper, and confines the mortar while the press acts.

"What I claim as my invention, and desire to secure by letters patent, are the segment slides (c 5) acted on by springs, in combination with the platen and hopper, constructed and arranged as herein set forth.

"I further claim the combination of the carriage (E) suspended at its rear end with the connecting-rods (e 4) and shaft, (e 5,) for freeing the machine from obstructions, substantially as before specified. Lastly, I claim the construction of the carriage (E) so as to free itself from dirt, that is to say, the pivots and studs for steadying the carriage, the slatted top and railway, set off from the carriage, &c., and, in combination therewith, the movable carriage (F) constructed and operated as herein described."

mode pointed out in the specification. These are the things he claims, each of which he supposes to be an improvement on all prior machines in use.

As to the first claim, the defendant insists that, whether original or not, the contrivance is destitute of utility, and could not be carried into practical effect, and was abandoned by the patentee immediately. The defendant's counsel assume the fact to be proved, and then insist that, as this claim is invalid, either from want of originality or utility, the whole patent becomes void. This is a question of law for the Court to decide. It is argued by the defendant that, in order to have saved the patent, the patentee should have disclaimed this part of his patent, under the 7th and 9th sections of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 193, 194,) and that, as he has failed to make this disclaimer and to record it, this suit cannot be maintained, and the whole patent is void. Though there is some evidence going to show that this contrivance may be new, and may not have been used before, yet, perhaps, the weight of it is that it is useless or could not be operated. I have examined the provisions of the statute, and am of opinion that this suit may be maintained under the two sections referred to, notwithstanding a disclaimer of the first claim has not been made or recorded; but the plaintiff will not be entitled to costs. The provision in the 9th section, that no costs shall be recovered unless a disclaimer of all that part of the thing patented which is claimed without right, is entered before the commencement of the suit, certainly shows that the action may be maintained for other parts of what is patented. If the disclaimer was entered in the Patent Office before the suit was instituted, the plaintiff recovers costs in the usual way, independently of any question of disclaimer. But if, in the progress of the trial, it turns out that a disclaimer ought to have been made as to part of what is claimed, the plaintiff may recover, but will not be entitled to costs.

Another question arises under the 9th section—whether there has been unreasonable negligence or delay in entering a

disclaimer. That is a question which goes to the right of action. If the delay shows great negligence, the jury may say that the patent is void. The provision in question applies only in the case where the part claimed by the patentee, of which he is not the inventor, is a material and substantial part of the thing patented. A disclaimer is necessary, therefore, only where the thing claimed without right is a material and substantial part of the machine invented. The question as to the disclaimer in this case is, therefore, of no importance in the determination of the rights of the parties, unless the slides and springs claimed in the first claim are described as a material and essential part of the machine, or unless they were introduced into the description through the wilful default of the plaintiff, or with intent to defraud or mislead the public. If you find that these slides and springs are not essential to the machine, and were not introduced into the patent through such wilful default or intent to defraud or mislead the public, the want of a disclaimer in regard to them affords no ground for invalidating the patent.

As to the second claim. If the carriage E, which is one part of the combination as arranged by the patentee, is a new and useful improvement, the combination of that with the connecting-rods and shaft, for letting it down and freeing it from obstructions, will be maintained, though the latter may be old. Because, one part of the combination being new, the uniting that with an old contrivance makes the combination necessarily a new one.

I pass now to the third claim, and to the real point in controversy. The arrangement of the carriages E and F is a distinct and independent claim—a material and substantial one—and one without which the substratum of the invention would fail. This brings the case very much to the point, whether the carriage E, constructed as it is described in the specification, is of itself a new improvement, in view of the carriages which had been in use prior to the invention of the plaintiff. It is necessary that it should be new, in order to uphold the third claim; and that, if maintained, will uphold

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the second. The question is one of fact. A great deal of evidence has been given on both sides, all bearing on the point; and, except that there are some legal principles bearing on the question of fact, and as to which the Court may aid you, it is a question which must be determined by the good sense and sound judgment of the jury. Of course, the question is not, whether the plaintiff's was the first bed or carriage that had ever been used; because, it is admitted that carriages and beds had before been used. But the question is, whether the plaintiff's carriage, as constructed by him, is a substantial improvement, for the purpose for which it is used, on all previous carriages. A formal change, such as a change in proportions, a mere change of form, or a different shape, is not a change within the meaning of the law. An improvement upon an old contrivance, in order to be of sufficient importance to be the subject of a patent, must embody some originality, and something substantial in the change, producing a more useful effect and operation. And, in determining this question, the jury have a right to take into consideration, in connection with the change, the result which has been produced. Because, the result, if greatly more beneficial than it was with the old contrivance, reflects back, and tends to characterize, in some degree, the importance of the change.

I do not agree with the counsel for the defendant, that the carriage E, as constructed by the patentee, is to be regarded as embracing a combination of materials, within the doctrine of the patent law, and that, unless the defendant has taken the whole of the combination, he is not liable. My opinion is, that that principle does not apply.

If the carriage E, as constructed by the plaintiff, is not a substantial improvement upon all previous constructions, he is not entitled to recover. But, if you arrive at the conclusion that that carriage is a substantial improvement upon all previous constructions, then the question is, whether the carriage used by the defendant is identical with that of the

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plaintiff. If it is, it is an infringement, and the plaintiff is entitled to recover.

The rule of law as to damages, when an infringement is made out, is, to give to the plaintiff the actual loss which he has sustained, and nothing more. Exemplary or vindictive damages cannot be given. If the damages are insufficient, there is a provision of law authorizing the Court to treble them. The plaintiff is entitled, if his case is made out, to the profits on all the machines sold by the defendant.

The jury found a verdict for the plaintiff for \$1,000 damages.*

Francis B. Cutting, for the plaintiff.

Seth P. Staples and *Ambrose L. Jordan*, for the defendant.

THE UNITED STATES

vs.

THOMAS C. BUTLER AND OTHERS. IN EQUITY.

Where, on the filing of a bill to remove an incumbrance on land, so that it may be sold under the plaintiff's judgment, a receiver is appointed of the rents and profits of the land, they are, in equity, subject to the lien and claim of the judgment, the same as the land itself.

Where the parties to such a suit settle it, the plaintiff getting rid of the incumbrance by paying to its holder a certain sum, and the land being thus left subject only to his judgment, the result is, in legal effect, the same, as it respects the lien of the judgment, as if a decree were to be made in the suit that, on payment of the sum, the prior incumbrance should be discharged.

On the payment of such sum by the plaintiff, under a decree, the land and the rents and profits would be applicable to the plaintiff's judgment; and, the incumbrance being disposed of by settlement, the land and the rents and profits that have accrued become subject to the judgment.

* A motion for a new trial in this case was subsequently made before Judges NELSON and BETTS, on the ground of alleged errors in the charge, but it was denied.

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Nor does the fact that the land is then sold under the judgment, and satisfaction entered of the judgment, that being done in pursuance of an agreement with the defendant in the judgment, affect the right of the plaintiff to those rents and profits. They are, in equity, immediately applicable to the judgment when the right under the incumbrance is disposed of; and the agreement to enter the satisfaction after selling the land and applying the proceeds, will be construed, upon a fair interpretation, to intend that the rents and profits which have accrued and are in the hands of the receiver shall also be applied on the judgment.

(Before NELSON, J., Southern District of New York, May 17th, 1851.)

THIS was a demurrer to a supplemental bill. The facts were these: In December, 1816, the plaintiffs recovered a judgment against the defendant Thomas C. Butler, in the District Court of the United States for the Southern District of New York, for a large amount. The judgment was recovered on duty bonds, on which Butler and also one Minturn and one J. Sturgis were sureties for others. On the 12th of August, 1816, Butler and wife executed to J. Sturgis a mortgage, covering certain houses and lots in the city of New York, to secure the payment of \$27,000, without interest, in one year thereafter. The mortgage was given to indemnify J. Sturgis against liability on the said bonds.

On the 31st of March, 1823, there was upwards of \$30,000 due on the judgment against Butler, and on that day the original bill in this cause was filed, to remove the said mortgage as an incumbrance upon the lots, so that they could be sold under the said judgment. J. Sturgis had paid nothing, as surety, to the Government. Butler put in an answer to the original bill, admitting that the mortgage was given to J. Sturgis for the purpose of raising money to pay the bonds or the judgments recovered upon them; that he had so advised the Attorney of the United States; and that he had received no consideration from J. Sturgis for the same. J. Sturgis also answered the original bill, alleging, among other things, that Butler was indebted to him at the time of giving the mortgage; that it was not given solely to indemnify him as surety to the plaintiffs on the bonds; that he had assigned the mortgage to secure the sum of \$15,000 due and owing to

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the firm of Sturgis & Burrows, in Savannah, Georgia; and that Butler had admitted to him that funds had been put into his hands by Minturn & Champlin, the principal debtors in the bonds, to satisfy them, and had stated that he would be kept harmless.

On the 11th of February, 1825, a supplemental bill was filed, making Burrows, the surviving partner of Sturgis & Burrows, a defendant, and praying a discovery as to the assignment of the mortgage, and that it might be delivered up and cancelled. Burrows answered, setting up a large indebtedness of J. Sturgis to him and his partner, and alleging that the assignment of the mortgage to them was made in part satisfaction of the same.

Replications were filed to the original and supplemental bills, and proofs were taken in the case, and it was brought to a hearing, and, on the 20th of June, 1826, an order was made referring the case to a Master, to take and state an account between the defendants Butler and J. Sturgis. On the 7th of June, 1827, a further order was entered, appointing Thomas C. Bolton, the Master, a receiver of the rents and issues of the premises covered by the mortgage. Before the Master completed the reference, and on the 25th of July, 1830, an order was entered discharging him as Master and receiver, and appointing in his place Murray Hoffman, who was authorized to receive the balance of money in the hands of Bolton, and deposit it in the New York Life Insurance and Trust Company. Hoffman continued as such receiver down to the sale, hereafter mentioned, of the mortgaged premises.

By an Act of Congress, passed March 24th, 1834, (6 *U. S. Stat. at Large*, 555,) the Secretary of the Treasury was authorized to compromise the bonds and judgments, with the parties liable on them, and particularly with Minturn, surviving partner of Minturn & Champlin, the principal debtors. An arrangement was accordingly made, by which Burrows, the surviving partner of Sturgis & Burrows, in consideration of \$6,000, assigned the mortgage to the plaintiffs; and it

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was further agreed, on the 12th of June, 1834, between the Secretary and Minturn, by way of compromising and settling all the claims of the United States upon the late firm of Minturn & Champlin and their sureties, that Minturn should procure to be assigned to the United States the mortgage given by Butler to J. Sturgis, in order to clear the premises from embarrassment, so that they could be made available towards the payment of the judgment against Butler, and, in consideration of the assignment having been made, the plaintiffs stipulated to release all the judgments, (there having been separate judgments against the principal debtors and each of the sureties,) and to discharge them of record, as soon as the mortgaged premises should be sold under the mortgage, or otherwise disposed of. The premises were sold under the judgment against Butler, on the 10th of March, 1838, and purchased by John Rathbone for \$25,500, which was much less than the amount then due on the judgment, and the mortgage was assigned to him as a muniment of title. Satisfaction of the several judgments was entered of record on the 4th of August, 1840.

The supplemental bill which was now filed set forth the above facts, and alleged that Hoffman, the receiver, had in his hands \$9,000; that a large sum of money, far exceeding the sum in the hands of the receiver, remained due on the judgment against Butler, over and beyond the amount brought by the sale of the mortgaged premises; and that the defendants Laird M. H. Butler and Jonas Butler claimed the funds in the receiver's hands, under an assignment of some interest in the lots from T. C. Butler, but the bill charged that it was made, if at all, during the pendency of the suits against T. C. Butler and the others, and of which these defendants were chargeable with notice. The bill also set forth various judgments recovered by the plaintiffs against T. C. Butler for debts due from him individually, and which remained unpaid, and were a lien on the lots covered by the mortgage, or on T. C. Butler's equity of redemption in them. The bill prayed that the sum in the receiver's hands might

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be directed to be paid over to the plaintiffs on the balance remaining upon the first-mentioned judgment against T. C. Butler, or upon those last named.

To this supplemental bill T. C. Butler and L. M. H. Butler demurred.

Edward Sandford, for the defendants.

Benjamin F. Butler, for the plaintiffs.

NELSON, J. The answer of Thomas C. Butler to the original bill admits that the mortgage was given to Sturgis for the benefit of the plaintiffs, that is, for the purpose of raising money to pay the judgments recovered on the Custom-House bonds, and was, therefore, properly no real incumbrance on the premises, as respected the judgment against Butler. So far as his interest was concerned, therefore, they might have been sold at once under the judgment, and the proceeds applied in payment. The sale, however, was embarrassed by the interest in the mortgage set up by Sturgis, the mortgagee, and by Sturgis & Burrows, the assignees under him. But as, on the filing of the bill to remove this incumbrance, a receiver had been appointed, for the purpose of securing the rents and profits pending the litigation, that they might be applied towards the satisfaction of the judgment, if necessary, they are, in equity, to be deemed subject to the lien and claim by virtue of the judgment, the same as the premises themselves.

The rents and profits thus accruing would have been applied to the judgment, together with the proceeds of the sale, if the proceedings in Equity had gone to a final decree in favor of the plaintiffs. Certainly, there would have been no ground for any other disposition, as it respected Butler or those coming in under him, as he had admitted that the premises were subject to the lien of the judgment, from the time it was docketed, free from the mortgage. The litigation with him, as it respected the mortgage, and the right of ap-

plying the premises to the satisfaction of the judgment, ended on the coming in of his answer. It continued only in respect to the claim of Sturgis and his assignees. If they had succeeded in establishing the mortgage, and if the premises had, on being sold, turned out to be insufficient to satisfy that security, perhaps they would, it being the first lien, have been entitled, in equity, to have the rents and profits accruing and in the hands of the receiver applied to its payment. That was a question, however, between the plaintiffs and those parties.

Has, then, the settlement made with Minturn and the assignees of the mortgage in any way affected the right of the plaintiffs to this fund? I do not see how this can be. The parties, instead of carrying on the litigation to a final determination, preferred to settle it; and the plaintiffs, by paying the sum of \$6,000, got rid of the mortgage incumbrance, and the premises were thus left subject only to the lien of their judgment. In legal effect, the result is the same, as it respects the lien of the judgment, as if a decree had been made, on the coming in of the Master's report, that, on payment of such sum, the prior incumbrance should be discharged. On the payment of that sum, the premises and the rents and profits that had accrued and were in the hands of the receiver, would have been applicable to the judgment of the plaintiffs against Butler. The mortgage having been got rid of by the settlement, everything was accomplished that would have been by a decree to the effect above stated. The land and the rents and profits that had accrued became subject to the judgment; and this is what, as is apparent, was intended by the parties, in their arrangement.

Neither does the entry of satisfaction of the judgment after the sale in any way affect the right of the plaintiffs to the rents and profits. They were in Court, awaiting the result of the litigation, to be applied to the judgment; and, in equity, were immediately applicable, when the right under the mortgage was disposed of. Besides, the whole scope of the settlement clearly shows, that it was intended by all

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parties concerned, that the premises covered by the mortgage, and the rents and profits that had accrued and of right belonged to the judgment creditors, should be applied to the plaintiffs' demand. Butler had nothing to say in the matter, as he had admitted this right in his answer.

I am satisfied, therefore, that there is sufficient equity in the bill to entitle the plaintiffs to this fund, and that the demurrer should be overruled.

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v8.

EDWARD F. DOUGLASS, JAMES CLEMENTS AND THOMAS BENSON.

Where, on a joint indictment against three for murder, one of them is tried separately, it is not competent for him to give in evidence a conversation between the other two, when they were alone, inculcating themselves and exculpating him from all participation in the crime.

The cases of *Powell v. Harper*, (5 Carr. & P. 590,) and of *Doe v. Hadden*, (3 Doug. 310,) commented on and explained.

What is direct evidence, and what circumstantial evidence.

In a case of circumstantial evidence, the jury, in order to convict, must find the circumstances to be satisfactorily proved as facts, and must also find that those facts clearly and unequivocally imply the guilt of the accused, and cannot be reasonably reconciled with any hypothesis of his innocence.

Where a person is present, actually or constructively, at a murder, aiding and abetting it, that is sufficient, both at common law and under the statutes of the United States, to warrant his conviction under an indictment charging him with the murder, though containing no count charging him with only being present at the murder, aiding and abetting it.

The Acts of Congress of April 30th, 1790, (1 U. S. Stat. at Large, 114, § 10,) and of March 8d, 1825, (4 Id. 115, § 4,) do not make the aiding and abetting an act of murder by personal presence and assistance, a separate and distinct offence.

A qualified peremptory challenge in a criminal case, that is, a right to set aside a juror without challenging him for principal cause or to the favor, and to have him finally excluded from the jury unless the panel is exhausted by the challenges of the prisoner, exists in favor of the Government in the Courts of the United States. *Per NELSON, J.*

This is the settled doctrine of the common law, and was recognized by the

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Supreme Court of the United States in *The United States v. Marchant*, (12 Wheat. 480. *Per* NELSON, J.

The Act of July 20th, 1840, (5 U. S. Stat. at Large, 394,) applies only to the mode of selecting the jury, that is, by ballot, lot or otherwise, as prescribed by the State laws, and does not affect the questions involved in the right of challenging the jurors called, whether peremptorily or for cause. Those questions stand upon the common law, except where regulated by Act of Congress. *Per* NELSON, J.

The Act of July 20th, 1840, (5 U. S. Stat. at Large, 394,) manifests a purpose to conform the regulations in regard to the designation and empanelling of jurors in the Courts of the United States, so far as may be practicable, to the existing laws of the particular States. *Per* BETTS, J.

It is a well-settled principle, in the jurisprudence of the United States, that rules of State practice acted upon by the Courts of the United States in a State, as obligatory upon them, have the efficacy of rules adopted by express order of those Courts. *Per* BETTS, J.

The right to a qualified peremptory challenge in a criminal case did not belong to the Crown, at common law. It rested wholly upon a construction of the statute of 33 Edw. I. *Per* BETTS, J.

The case of *The United States v. Marchant*, (12 Wheat. 480,) did not involve any question as to the right of the Government with regard to challenges of jurors. *Per* BETTS, J.

The laws of the State of New York do not allow to the prosecution, in a criminal case, such qualified peremptory challenge, and the practice of the Courts of the United States has always been, to conform in all respects, in trials by jury, as nearly as practicable, to the laws of the State in which they sit. *Per* BETTS, J.

The Attorney for the United States is bound to assign and substantiate his challenge when it is made, and before other jurors can be drawn. *Per* BETTS, J.

(Before NELSON and BETTS, JJ., Southern District of New York, June 2d, 1851.)

THIS was a joint indictment against three persons for murder upon the high seas. The prisoners were tried at New York, before Mr. Justice NELSON and Judge BETTS, in May, 1851, and found guilty. Douglass was tried separately. Clements and Benson were tried together. Before sentence, a motion for a new trial was made before both Judges, upon their minutes of the trial and the charge of the presiding Judge to the jury. The indictment, in every count, charged the murder of the deceased by each of the prisoners. There was no count charging either of the prisoners with only being present at the murder, aiding and abetting it. The points urged as grounds for a new trial

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were these: 1st, That the Court erred in allowing the District Attorney to exercise a qualified peremptory challenge, by excluding individual jurors from the jury until the panel should be exhausted, without making any challenge to such jurors for principal cause or to the favor; 2d, That Douglass ought to have been allowed to prove a conversation between Benson and Clements when they were alone, inculcating themselves and exculpating Douglass from all participation in the crime; 3d, That the Court erred in not charging the jury that the evidence was purely circumstantial; 4th, That the Court erred in not charging the jury that the evidence must exclude, to a moral certainty, every hypothesis but that of guilt, before a conviction could be had, and that the Court misdirected the jury, in instructing them that they could convict the prisoners if the circumstantial evidence was found to be more consistent with their guilt than with their innocence; 5th, That the Court erred in charging the jury that mere presence, actual or constructive, at the murder, aiding and abetting it, was sufficient to warrant a conviction under the indictment. The facts of the case, so far as they are necessary to be stated, sufficiently appear in the opinions of the Judges.

Lorenzo B. Shepard and George F. Betts, for the prisoners.

Ogden Hoffman and William M. Evarts, for the United States.

NELSON, J. The motion for a new trial made in this case is denied. But it is proper to say, that the Judges do not altogether agree in respect to the point made as to the right of the Government to a qualified peremptory challenge—that is, the right to set aside a juror without cause, and to have him finally excluded from the jury unless the panel is exhausted by the challenges of the prisoner. If the jury-list is exhausted before the panel is completed, it is admitted that the juror thus set aside must be called and must serve,

unless he is challenged by the Government for cause. This qualified right of challenge without cause is the settled doctrine of the common law, and has been recognized by the Supreme Court of the United States in the case of *The United States v. Marchant*, (12 *Wheat.* 480,) and has been practised upon in some of the Circuits. The doubt that is suggested in regard to it arises under the Act of July 20th, 1840, (5 *U. S. Stat. at Large*, 394,) which provides for the designation of jurors to serve in the Federal Courts, by ballot, lot or otherwise, according to the mode of selecting them in the States where such Courts are held; and, for this purpose, those Courts are empowered to make rules and regulations for conforming the designation and empanelling of jurors to the laws and usages of the States as they may exist at the time. A rule to this effect has been adopted in this District. My brother Betts thinks that the Act of 1840 adopts, together with the mode of selecting and empanelling the jury, the law of the State regulating the right of challenge, which would exclude the qualified right of peremptory challenge that belongs to the Government at common law. Such is the law of the State. But my own opinion is, that the Act of 1840 applies only to the mode and manner of drawing or selecting the jury, that is, by ballot, lot or otherwise, as prescribed by the State laws, and does not affect the questions involved in the right of challenging the jurors called, whether peremptorily or for cause; and that those questions stand upon the common law, except where regulated by Act of Congress.

In the present case, the panel was completed before the jury-list was exhausted, and before the privilege of peremptory challenge belonging to the prisoners was exhausted. The question, therefore, in this particular case, is one of no substantial importance in the fair and proper administration of justice. Great liberality was extended by the Court to both sides in forming the panel, with a view to the selection of an impartial and intelligent jury, and such was eminently the character of the one obtained.

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BERRS, J. The Judges differ in opinion upon the first point urged as a ground for a new trial, and concur in regard to all the others.

Upon the second point, we think there was no foundation in law for admitting the evidence offered. The general principle laid down by text-writers is explicitly against it, (*Best on Ev.* 96, 50 *Law Library, new series*, 79,) and so is the reason of the thing. Mere assertions by one person, affecting the guilt or innocence of another, show no such privity with the latter as to become evidence for or against him. The case of *Powell v. Harper*, (5 *Carr & P.* 590,) is too loose a statement to be entitled to reliance, if it intends to declare any such doctrine; and, in so far as it admits the naked declaration of a person not on trial, that he stole certain property, to be evidence against another that he received it knowing it to be stolen, it is against the well-established rules of law. Some feature in the case is undoubtedly dropped in the report of it. The case of *Doe v. Hadden*, (3 *Doug.* 310,) cited for the prisoners, turned on a different point. The declarations offered in evidence were offered to vitiate an act done by the party making them and show it corrupt and void, that act being introduced as the ground of right by the lessor of the plaintiff.

The third point made rests upon a misconception of the character of the evidence. It was not wholly circumstantial. A very large and most important part of it was direct and positive. The murder of the deceased, the report of a musket, the cry of murder by the deceased, the presence of the prisoners on deck at the time, armed with muskets and other deadly weapons, and the violent interference of two of them to prevent the officers of the vessel from going to the rescue of the dying man, are facts directly proved. Such, also, was the fact of the muskets coming clandestinely to the possession of the prisoners. The only fact important to their conviction of the murder, which depended upon presumptive proof, was, whether the three concurred in the felonious acts out of which the death of the deceased arose.

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The fourth point is not supported by the terms of the charge. It was delivered in writing, and is, accordingly, easily compared with the doctrine contended for by the prisoners' counsel. We think that the clear and unmistakable import of it is, that the jury, in order to convict, must find the circumstances to be satisfactorily proved as facts, and must also find that those facts clearly and unequivocally imply the guilt of the prisoners, and cannot be reasonably reconciled with any hypothesis of their innocence. This is the plain bearing of the instructions, and if, in particular sentences, expressions of a wider and looser bearing occur, yet, in others, the language is explicit and pointed to that effect, and the whole charge is reconcilable only upon the idea that the jury must find that the circumstances remove all reasonable doubt of the guilt of the prisoners.

We think that the fifth point cannot be maintained. At common law, every person present at a murder, willingly aiding or abetting its perpetration, is guilty of murder, and may be indicted and convicted as principal in the first degree. The Acts of Congress of April 30th, 1790, (1 *U. S. Stat. at Large*, 114, § 10,) and of March 3d, 1825, (4 *Id.* 115, § 4,) in which aiders and abettors are named, do not make the aiding and abetting an act of murder by personal presence and assistance, a separate and distinct offence. The more probable interpretation of those terms is, that they apply to accessories before the fact. There is certainly no fair ground to infer that they were employed in the statutes to distinguish such aiders and abettors from the principal murderer. (*Whart. Crim. Law*, 224.) We therefore think the indictment is good in charging the prisoners with the murder by doing acts aiding and abetting its perpetration in their presence. (*The United States v. Magill*, 1 *Wash. C. C. R.* 463; *The United States v. Ross*, 1 *Gall.* 624.)

As the first point involves an inquiry into the practice of the Court, of much weight and some difficulty, it is proper to set forth more at large the considerations which influence the minds of the Judges in the opinions they adopt

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in respect to it. The presiding Judge holds that, as the matter is not expressly regulated by Act of Congress, the Courts of the United States must resort to the common law to ascertain what the rule is in regard to the right of the Government to challenge jurors in capital cases. He construes the Act of July 20th, 1840, (5 *U. S. Stat. at Large*, 394,) as extending no further than the Judiciary Act of 1789, and regards its provisions as limited to the mode and manner of obtaining the general panel of jurors to serve in Court, and as not governing the method of empanelling them in a specific case on trial. He also holds, that the common law practice of permitting the Crown to have jurors set aside without challenging them, till the whole panel is exhausted by the challenges of the prisoner or the acceptance of jurors called, must be regarded as the rule in the Courts of the United States. I maintain a different view. We concur in the opinion that, under the terms of the Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 88, § 29,) the State law was made the rule of the Courts of the United States only in respect to the mode of designating the jurors, and that, in other respects, the common law was followed. (*The United States v. The Insurgents*, 2 *Dallas*, 335.) But I think that the Act of May 13th, 1800, (2 *U. S. Stat. at Large*, 82,) and the Act of July 20th, 1840, (5 *U. S. Stat. at Large*, 394,) are more extensive enactments, and manifest a plain purpose to conform the regulations in regard to jurors in the Courts of the United States, so far as may be practicable, to the existing laws of the particular States.

The 29th section of the Judiciary Act of 1789 required the jurors to be designated by lot or otherwise, according to the mode of forming juries in the States respectively, to which language the Act of May 13th, 1800, added the words, "therein now practised;" thus making the State practice of that day the rule governing the Courts of the United States in designating jurors. The Act of July 20th, 1840, annexes to the addition made by the Act of 1800, the words, "and hereafter to be practised therein," and more distinctly indi-

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cates the intention of Congress to bring the whole system substantially within the regulations of the State laws, by declaring first, that the jurors shall have the like qualifications and be entitled to the like exemptions as State jurors "now have and are entitled to, and shall hereafter, from time to time, have and be entitled to;" and secondly, by adding, "and, for this purpose, the" "Courts" of the United States "shall have power to make all necessary rules and regulations for conforming the designation and empanelling of juries, in substance, to the laws and usages now in force" in the States. Though it is not claimed for this language that it, in express terms, conforms the entire regulations, both in obtaining jurors and in empanelling juries, to the laws and usages of the States, yet it is most significant to show, that the State laws and usages were looked to as the leading and main authority in both respects. And, moreover, it denotes the competency of the Courts of the United States to regulate the subject by adopting express rules to that end. It is a well-settled principle, in the jurisprudence of the United States, that rules of State practice acted upon by the Courts of the United States in a State as obligatory upon them, have the efficacy of rules adopted by express order of those Courts. (*Fullerton v. Bank of the United States*, 1 *Peters*, 604.) Accordingly, the uninterrupted usages of the Courts of the United States in this District, for over fifty years, to conduct criminal trials, especially in the organization of juries, conformably to the State laws, is high evidence of an explicit adoption of that practice.

Independently, however, of these considerations, I think that the right claimed by the Attorney for the United States in this case was not maintainable upon any doctrine of the common law. There is no evidence that the Crown ever possessed or claimed that right, except under the provisions of the Act of 33 Edw. I. The prerogative right on the part of the King, prior to this Act, was to challenge jurors peremptorily, without restriction of numbers, which in effect gave the Crown the power of selecting juries in capital cases. (*Co.*

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Litt., 156 b; *Hawk. P. C.*, b. 2, ch. 43, sec. 2; *Bac. Ab., Juries*, E. 10; *Com. Dig., Challenge*, G. 1; *Joy on Confessions*, 143, 24 *Law Library, new series*, 84; *Chitty's Cr. L.*, 434; 2 *Hale's P. C.*, 271.) This was the evil which Parliament intended to remedy by the Act of 33 Edw. I. (*Co. Litt.*, 156 b.) Bacon gives the Act at large, (*Ab., Juries*, E. 10,) and these motives for its passage are assigned by Baron Gilbert. He also adds, that it is the established practice of the Courts, in the construction of the Act, that the King need not show any cause of his challenge till the whole panel be gone through. That this is a practice of the English Courts, resting not on the common law, but wholly upon the construction of the statute, is still more definitely settled by the decisions of the King's Bench in *Rex v. Parry*, (7 *Carr. & P.* 836,) and in *Regina v. Frost*, (9 *Id.* 129, 136,) made upon the provisions of the Act of 6 Geo. IV., re-enacting in substance the Act of 33. Edw. I.

Mr. Justice Story, in *The United States v. Marchant*, (12 *Wheat.* 480,) would also seem, on a fair construction of his language, to place the right of the Crown to this mode of challenge, upon the uniform practice which has prevailed in the English Courts since the statute of 33 Edw. I.; but the reasoning of the learned Judge, collateral to the point under consideration by the Court, even if it amounts to a recognition of the English practice as a doctrine of the common law, cannot avail as a judgment of the Court on the subject. The point raised upon the certificate of division of opinion, and determined by the Supreme Court, related solely to the right of two or more persons, jointly charged, in the same indictment, with a capital offence, to be tried severally, separate and apart—an inquiry apparently in no way involving the prerogative or authority of the Government in respect to its challenges of jurors on such trial. And, even if the very accomplished jurist who drew up the opinion of the Court had explicitly pronounced the privilege now claimed on the part of the United States to be a common law right, the declaration could not, in a different case, carry the authority of

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a judicial decision, though it would command all the consideration which the suggestions of a Judge so acute, laborious and exact, upon questions of common law, always merit and receive.

The point in question was directly raised in the Pennsylvania Circuit, before Judges Baldwin and Hopkinson, in 1830, in the case of *The United States v. Wilson*, (1 *Baldw.* 78, 82.) The District Attorney challenged a juror peremptorily. His right to do so was denied by the counsel for the prisoner. The Court observed, that they had known no case where the right now claimed had been allowed to the prosecution; that they would not be the first to do it in a capital case, unless it was clearly established; but that, on examining the opinion of the Supreme Court, in the case of *The United States v. Marchant*, 12 *Wheat.* 480,) they did not feel themselves at liberty to refuse the qualified right of challenge claimed by the United States.

It was upon reading these cases on the trial of the indictment against the prisoners, that this Court permitted the exercise of a like challenge, and the presiding Judge considers the law on the subject settled by these cases. I dissent from that opinion, and think that the Court committed an error on the trial in allowing the challenges of the District Attorney.

The cases in Pennsylvania, which were referred to on the argument, throw no additional light on the subject. Those cases do not appear to harmonize in principle with each other, on the question of the right of challenge, while, in one particular, they strongly corroborate the view I have taken against the existence in the States of any common law right to such challenge. In *Commonwealth v. Lisher*, (17 *Serg. & Rawle*, 155,) the Court deny that such a right of challenge exists in Pennsylvania. In the subsequent case of *Commonwealth v. Joliffe*, (7 *Watts*, 585,) that decision is treated as having been incautiously made, and it is held that the statute in force in Pennsylvania is substantially the same as that of 33 Edw. I., and that there is no reason why it should not receive the same construction. Whichever decision is adopted as the

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correct exposition of the law, the doctrine that this mode of challenge is not a common law right, is not affected by it, any further than as the general reasoning of the Court in the last case conflicts with the principle involved in the doctrine. And I most confidently insist, that no act of a State Legislature and no decision of a State Court can be shown, manifesting an intention to set up, in the United States, a privilege to the prosecution in capital cases, in respect to the organization of the jury, greater than is enjoyed by the accused; and further, that it was the palpable purpose of the Acts of Edw. I. and Geo. IV., to bring the right of the Crown within a narrower restriction, and only to give the King and the prisoner coequal rights of challenge for cause.

Under the English practice, and that proposed to be sanctioned in the United States, a way is open for most unreasonable advantages in favor of the Government against the prisoner. Suppose the panel to consist of eighty jurors, (the number returned in the present cases,) and that it should so chance that one-half of the whole number are men free of impeachment by challenge for principal cause or favor, yet so circumstanced as to have naturally strong prepossessions in support of the prosecution—for instance, that they are shipowners, shipmasters and others, so connected with maritime business as to feel honestly but deeply convinced that every act of a sailor at sea, tending to put in peril the lives of the officers, or the vessel or cargo, should be regarded with the greatest distrust of his motives, and as justly requiring, at the hands of the seaman, most satisfactory evidence of his innocence, and that circumstances which, in other relations, would be regarded as slight or insignificant, should carry a weighty import when brought to bear against a sailor. The other half of the panel may be drawn from the ordinary employments of life, and be in no way, by their business, associations or prepossessions, unfavorably impressed respecting the character and integrity of seamen as a class. On empanelling the jury, the District Attorney may set aside every one of the forty who would deal dispassionately with

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the case, and drive the prisoner to exercise his peremptory challenges and those for cause upon the forty who stand naturally in a relation of distrust, if not of hostility, towards him. This, to the extent supposed, is put as an extreme case. But it marks distinctly the principle, and shows that the Government may be enabled to force upon the panel men who, unless constrained by overpowering evidence for the defence, would be ready to refuse the prisoner the benefit of an acquittal under almost any circumstances, and might even be inclined, upon testimony faintly criminating him, to render against him a verdict of conviction.

The whole theory of criminal jurisprudence looks to placing the advantage, if one accompanies the case, on the side of the accused; and I think that, after the efforts almost universally put forth in the United States to strengthen and extend such privilege, particularly to a person on trial for his life, we are taking a long step backwards, in setting up the practices of the English assizes, originating in an age of colder sympathy for human life than pervades our era and the jurisprudence of the United States. Accordingly, I regard it as far more consonant with the spirit of our institutions and the rules of criminal law sanctioned by them, for this Court to adhere to the humane and guarded practice adopted in this State, than to recur to one drawn from an English statute, (by means of a construction wearing more the appearance of maintaining a royal prerogative against the will of the Legislature, than of securing to a prisoner the pittance of favor accorded by it,) which dates back to about the year 1300, to the reign of a monarch who, in advance of the sentiment of his age, made most meritorious efforts to reform the condition of the law in his realm, both civil and criminal.

The legislation of the State of New York shows conclusively how the rule is accepted here, and may, with great force, be claimed as declaratory of the true import of the English statutory law on the subject. At all events, it fixes definitively the law governing the State Courts in this respect. As early as 1786 it was enacted that, in all cases where the

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Attorney-General of this State, in behalf of this State, or he who shall in any case prosecute for the people of this State, shall challenge any juror as not indifferent, or for any other cause, he who shall make any such challenge shall immediately assign and show the cause of such challenge, and the truth thereof shall be inquired of and tried in the same manner as the challenges of other parties are or ought by law to be inquired of and tried. (1 *Jones & Varick's Laws*, 311, § 22; 1 *Greenleaf's Laws*, 269, § 22.) This statute was included in the revision of 1801, (1 *Kent & Radc. L.*, 385, § 25,) and in that of 1813, (1 *R. L.*, 334, § 25,) and was preserved in the Revised Statutes, (1 *R. S.*, 734, § 11.) If the English statute of 33 Edw. I. was ever in force in this colony or State, it was specifically repealed by the Acts of 1786 and 1788, (1 *Jones & Varick's Laws*, 312, § 27; 2 *Id.* 282, § 37;) and then the common law, as modified by the laws and usages of the State, and not as altered by acts of Parliament, would govern the method of conducting criminal trials and selecting jurors. (1 *Kent's Comm.*, 472, 473, and notes.)

The practice of the Courts of the United States has always been to conform in all respects, in trials by jury, as nearly as practicable, to the laws of the State in which they sit. (*Conk. Tr.*, 1st ed., 298.) On the trial of Col. Burr, Ch. J. Marshall said: "The United States have precisely the same rights as the prisoner has, and make the same challenges for a good cause." (1 *Burr's Trial*, 425.) The counsel for the Government argued for the right of the Government to challenge jurors for cause. Mr. Martin, for Col. Burr, insisted that the United States had no right to disqualify jurors for the prisoner. Ch. J. Marshall replied: "Certainly, the counsel for the United States may challenge for cause." (*Id.* 424.) And, under those rulings of the Court, the counsel proceeded immediately to try the cause of challenge. These proceedings manifest most clearly that the challenges were received and disposed of by the Circuit Court pursuant to the laws of the State or the practice of the State Courts, and

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that no reference was had to the English practice under the statute of 33 Edw. I.

To the like effect were the proceedings in *Jones v. Van Zandt*, (2 *McLean*, 611.) The action was in the name of an individual, but was treated, under a statute of Ohio, as a criminal prosecution, and the question was made as to the right of the Government to challenge jurors, and the right was upheld and exercised in conformity with the State law.

Upon the foregoing considerations, I am of opinion that the Attorney for the United States had no right to a peremptory challenge, and was bound to assign and substantiate his challenge when it was made, and before other jurors could be drawn.

New trial denied.

SAMUEL GRANT vs. HUGH MAXWELL.

The proviso to the 61st section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 673,) which declares "that it shall be lawful for the President of the United States to cause to be established fit and proper regulations for estimating the duties on goods, wares and merchandise imported into the United States, in respect to which the original cost shall be exhibited in a depreciated currency issued and circulated under authority of any foreign Government," is not repealed by the Act of May 22d, 1846, (9 *U. S. Stat. at Large*, 14,) which prescribes the rates at which certain foreign coins shall be estimated in computations at the Custom-House.

Notwithstanding the Act of May 22d, 1846, an importer of foreign goods is entitled, under the proviso to the 61st section of the Act of 1799 and the Treasury Instructions issued for carrying the same into effect, to enter his goods on paying duties only upon their cash value in the country of their purchase; and is entitled, in order to fix that value, to have the paper or nominal value at which they were purchased and invoiced, reduced to its specie value in such country at the time of the purchase, and to enter the goods on that valuation.

Where goods were purchased in Austria, in 1850, and imported into New York, and the invoice and entry set forth the purchase-price in paper florins, and they were paid for in paper currency, and it appeared that the paper florin was depreciated in Austria, at the date of the purchase of the goods, below the

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value of the silver florin, although it was the legal currency in Austria, and was a legal tender at its nominal value: *Held* that, although the Act of May 22d, 1846, directed the florin of the Austrian Empire to be estimated at forty-eight and one-half cents, yet, under the proviso to the 61st section of the Act of 1799, and the Treasury Instructions in regard to invoices made out in a foreign depreciated currency, the goods were chargeable with duty only on their value in silver florins, after allowing for the depreciation.

(Before NELSON and BETTS, JJ., Southern District of New York, June 2d, 1851.)

THIS was an action against the Collector of the port of New York, to recover back an excess of duties paid on goods purchased in Austria on two different days in May, 1850, and shipped from Trieste to New York. The invoice and entry set forth the purchase-price of the goods in paper florins, and they were paid for in paper currency. It appeared upon the trial, by oral testimony, and also by the official certificate of the United States Consul at Trieste, that the paper florin was depreciated in Austria, at the two several dates of the purchase of the goods, $18\frac{1}{4}$ and $19\frac{1}{4}$ *per cent.* below the value of the silver florin. It was further proved, that the legal currency in Austria at those dates was paper money, estimated in florins, and made by law a legal tender at its nominal value. The plaintiff claimed, that the duty on the goods should be paid upon their value in silver florins. A verdict was taken for the plaintiff, subject to the opinion of the Court on a case to be made.

John S. McCulloh, for the plaintiff.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. By the Act of Congress of the 22d of May, 1846, (9 *U. S. Stat. at Large*, 14,) it is enacted that, in all computations at the Custom-House, the foreign coins and money of account therein specified, shall be estimated at certain specified rates, and, among others, "the florin of the Austrian Empire and of the city of Augsburg, at forty-eight and one-half cents." The Act also declares, that all laws inconsistent with

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it are thereby repealed. For the defendant it is urged, that he was bound, by the terms of the Act, in charging duties on the goods in question, to rate the florin of the invoice at forty-eight and a half cents, without regard to its specie value or depreciation. The plaintiff, on the other hand, claims that the goods are subject to duty only upon their cash value abroad, and that he is entitled, in order to fix that value, to have the paper or nominal value at which they were purchased and invoiced, reduced to its specie value in Austria, and to enter the goods on that valuation.

The purpose of the Government, in all its laws imposing *ad valorem* duties on foreign merchandise imported into this country, has been to take the true value of the goods in the country which produced them or in which they were obtained, ascertained by the actual purchase-price or by their market value, as the basis upon which such duties are to be computed. This is manifested in the various revenue laws introducing from time to time new provisions to enable the collectors to fix the foreign value correctly and to render duties uniform. The oaths exacted to invoices and on entries, and the enlarged powers conferred on appraisers, together with the early regulation by law of the value of foreign currencies, with the methods of determining their depreciation, are all designed to accomplish that end. The enactments for this purpose are found in the Acts of July 4th, 1789, August 10th, 1790, March 2d, 1799, March 3d, 1801, March 1st, 1823, May 19th, 1828, July 14th, 1832, August 30th, 1842, and July 30th, 1846. (1 *U. S. Stat. at Large*, 24, 180, 627; 2 *Id.* 121; 3 *Id.* 729; 4 *Id.* 270, 583; 5 *Id.* 548; 9 *Id.* 42.) The invoice value of merchandise must be expressed in money, and the invoice and entry must particularly specify in what money the goods are bought and valued. (*Act of March 2d, 1799*, 1 *U. S. Stat. at Large*, 655, § 36.) And they must be invoiced in the currency of the country whence they are imported, without respect to the intrinsic value of the money or the standard of the United States fixed for its value. (*Act of March 3d, 1801*,

2 *Id.* 121, § 2.) Still, the actual wholesale cash value is to be ascertained and made the dutiable basis, notwithstanding any affidavit or invoice statement or valuation. (*Act of August 30th, 1842, 5 Id.* 563, § 16.)

The earlier and later enactments concur in enforcing the one prominent object, that of having at the Custom-House the actual value in cash of the merchandise imported, at the place of its exportation. To make that purpose effectual, in addition to the regulations respecting invoices, entries and appraisals, Congress, by the 61st section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 673,) fixed the rates at which all foreign coins and currencies should be estimated in the United States, giving to various known denominations of foreign money a specific value, and requiring all other denominations to be estimated in value, as nearly as might be, to such fixed rates or the intrinsic value thereof, compared with money of the United States. The following proviso was added to the section: "That it shall be lawful for the President of the United States to cause to be established fit and proper regulations for estimating the duties on goods, wares and merchandise imported into the United States, in respect to which the original cost shall be exhibited in a depreciated currency issued and circulated under authority of any foreign Government."

The main question submitted to the Court for its decision in this case is, whether the Act of 1846 covers the whole subject, so that the cost price of the goods must be estimated at forty-eight and a half cents to the florin stated in the invoice or whether the proviso to the 61st section of the Act of March 2d, 1799, operates in the case, and entitles the plaintiff to enter his goods on paying duties upon the specie or intrinsic value of the Austrian florin or currency.

The Act of March 2d, 1799, is regarded as the fundamental law in relation to imposts and duties, and each of its enactments is viewed as independent, forming a rule upon the particular subject which is not changed by subsequent legislation varying other provisions of the Act. The like doc-

trine applies to the succession of statutes which have followed the parent Act. Accordingly, the law of imposts and duties is enforced as a system composed of distinct enactments, passed at various periods of time, and each provision is executed as part of the system, notwithstanding the change or repeal of other provisions in the same statute in relation to the denomination of imports or the rates of duties or the methods of computing them. This is sometimes effected by virtue of a saving clause appended to the new Act, (*Act of July 14th, 1832, 4 U. S. Stat. at Large, 583, § 1;*) and sometimes by declaring all provisions of any former law inconsistent with the Act last passed to be repealed, (*Act of August 30th, 1842, 5 Id. 566, § 26, and Act of July 30th, 1846, 9 Id. 44, § 11;*) and, again, by the decisions of the Courts on the effect of subsequent enactments. Anterior to the passage of the Act of May 22d, 1846, the Treasury Department had treated the proviso to the 61st section of the Act of March 2d, 1799, as continuing in force, and duties were levied in conformity to its provisions. (*Treasury Instructions to Collectors, May 14th, 1831; Id. October 16th, 1832; Id. April 4th, 1840; Id. August 20th, 1845.*) The latest Instructions from the Secretary of the Treasury, dated October 12th, 1849, direct that bonds taken for the production of consular certificates of the value of depreciated currencies must be strictly enforced; which imports the continuing operation of the proviso, in the judgment and practice of the Executive Department, because the consular certificates come into existence and have validity solely under the powers given by that proviso. The 61st section of the Act of March 2d, 1799, fixed the value of certain foreign coins or currencies. So, subsequently, did the 1st section of the Act of March 3d, 1801, (*2 U. S. Stat. at Large, 121;*) and similar provisions were re-enacted in the Act of June 28th, 1834, (*4 Id. 700,*) in the Act of March 3d, 1843, (*5 Id. 625,*) and in the Act of May 22d, 1846, (*9 Id. 14,*) the last two Acts being framed in like terms, and declaring that all laws inconsistent therewith are thereby repealed.

It is plain, upon this summary statement of the course of legislation and practice on the subject, that the proviso to the 61st section of the Act of March 2d, 1799, is to be regarded as repealed only in the contingency that it stands opposed to subsequent Acts of Congress, and especially to the Act of May 22, 1846. The reason for its preservation and enforcement, as a means to secure importers against the payment of *ad valorem* duties on amounts beyond the fair value of the merchandise imported, is the same at the present time as when it was enacted. What, then, does the proviso require? Clearly, not a disregard of the valuation of foreign currency designated by statute; but only a method of determining whether that assumed value remains unchanged, and whether the actual value corresponds with the nominal rate. The invoice must be expressed in the currency of the country from which the goods are exported or in which they are produced. The nominal currency will necessarily very often give the cost or market value very wide of the true value. In the case before the Court, it is proved beyond question that the goods imported are rated nearly twenty *per cent.* above their actual value in Austria, and beyond their real cost to the importer. This disaccordance is forced on him by the imperative direction of the revenue laws. He must invoice the goods at the cost or value expressed in the currency of Austria, although they are obtained at one-fifth less than that amount in specie, and, without the aid of the proviso, he will be precluded from showing the actual cost or value.

It seems to us that the proviso does not in any way contradict the statute of 1846. It supplies the Custom-House with a means of levying duties on invoices in conformity with the general provisions and scope of the revenue laws, and helps to carry out the intention of Congress, by keeping the fluctuations of nominal values to the standard of specie values, in transactions in foreign currencies. Congress does not make the foreign currencies named in the statute receivable in the United States at the values affixed to them. Had

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that been so, the merchant might be considered as protected by the opportunity of paying duties in the currency of his invoices. The proviso looks to a remedy for the injury that might, without its aid, be sustained by importers under a statutory regulation of foreign coins and currencies, bringing them in accord with United States currency, and yet leaving their nominal rates to act as a measure of value of merchandise in the country where it is purchased.

We think that there is no incompatibility or inconsistency between the Acts subsequent to the Act of 1799 upon this subject and the proviso, and that accordingly, neither by the terms of the Act of 1846 or of those antecedent to it, nor by legal implication, is the proviso to the 61st section of the Act of 1799 repealed or its legal operation suspended. The business of the country was conducted on that understanding of the law antecedently to 1846, and collectors and the Treasury Department unitedly admitted importations and charged duties in conformity with regulations adopted by authority of the proviso. The proviso was repugnant to the enacting clause of the 61st section of the Act of 1799, precisely as it is to a like designation of the value of foreign currencies by the Act of 1846. That section, in nearly identical language, declared the value of various denominations of foreign moneys; but the proviso, referring to the depreciation of foreign currencies in which the original cost of goods was exhibited, would necessarily include those specified in the enacting clause, equally with those not named. There was no less necessity for the interposition of the President in relief of the merchant, when his invoices were made up in a currency which had depreciated after its valuation had been once determined by Congress, than where no rate of valuation had been established by law. The proviso is accordingly framed to apply to all importations, when the invoice is exhibited in a depreciated currency issued and circulated under the authority of a foreign Government, and necessarily embraces equally those currencies whose value has been once fixed by Congress, and those which have

never been recognized by our laws. The Treasury Circular of August 20th, 1845, regards the proviso as in the alternative. Its directions relate to invoices made out in a foreign depreciated currency, *or* in a currency the value of which is not fixed by the laws of the United States.

This is, we think, the correct reading and exposition of the proviso to the 61st section of the Act of 1799. Congress has since, from time to time, ascertained the existing value of various foreign coins and currencies, and declared them by statute. This relieved the Treasury Department from keeping on foot a train of investigations, at every importation, respecting the value of the currency in which the invoice was exhibited. The statute value was adopted as the real one, for the time being. But it was manifest that such valuations must be liable to change, from the adulteration of coins or the emission of paper or base currencies abroad; and it was consonant with the general course of legislation in relation to the revenue, that a means should be supplied the Executive Department to maintain uniformity in imposts and duties, without delaying the business of the country or enforcing hardships or inequalities upon importers until special legislation could be interposed to remove the difficulty. The proviso supplied such means; and, as its operation was so appropriate, as well as effectual and just, we must conclude it to have been the purpose of Congress to retain it in force, when they have not in express terms rescinded it or passed any enactment necessarily repugnant to it. On the contrary, it seems to us that, as the proviso is essentially prospective, and contemplates a state of things which may come into existence at a future period, the Act of May 22d, 1846, instead of being construed as repealing it, ought to be understood as upholding and sanctioning the powers conferred by it on the President.

Judgment must, therefore, be entered for the plaintiff, on the verdict.

Ex parte Humphrey.

Ex parte WILLIAM S. HUMPHREY.

The 30th section of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 88,) gives authority to this Court to compel witnesses to attend before a Commissioner for examination *de bene esse*, in the same manner as to compel them to appear and testify in Court. And, upon due proof of service of a subpoena upon a witness, requiring his attendance before a Commissioner, and the certificate of the Commissioner that the witness did not attend before him, it is proper that an attachment should issue against the witness.

But that statute does not apply to a witness who is casually absent from home, although he is found at a place more than one hundred miles from the place of trial of the cause, unless he is about going to sea, or is aged, infirm, &c.

Where an attachment is issued against such a witness, the question of the authority of the Commissioner and of the regularity of the proceedings before him, is properly brought before the Court by affidavit.

(Before BETTS, J., Southern District of New York, June 9th, 1851.)

WILLIAM S. HUMPHREY was brought before this Court upon a writ of attachment issued against him, for his refusal to obey a subpoena from this Court, requiring him to appear and testify before a United States Commissioner in the city of New York, under the 30th section of the Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 88,) as a witness *de bene esse* in a suit pending in the Circuit Court for the District of Massachusetts. The witness had been duly subpoenaed and had failed to attend. But it also appeared, by his own affidavit, that he resided in Massachusetts, about fifty miles from Boston, and was temporarily in New York on business, and proposed returning to his family and place of residence within a few days.

Seth P. Staples objected, that the witness could not be compelled to appear before the Commissioner to give his deposition; but that the proper course was to take his testimony on commission.

George Gifford, contra.

BETTS, J. The 30th section of the Judiciary Act of 1789 gives authority to this Court to compel witnesses to attend before a Commissioner for examination *de bene esse*, in the same manner as to compel them to appear and testify in Court. And, upon due proof of service of a subpoena upon a witness, requiring his attendance before a Commissioner, and the certificate of the Commissioner that the witness did not attend before him, it is proper that an attachment should issue against the witness. But that statute does not apply to a witness who is casually absent from home, although he is found at a place more than one hundred miles from the place of trial of the cause, unless he is about going to sea, or is aged, infirm, &c. In the present case, the contempt of Court imputed to the witness in disobeying the subpoena is purged. He could not rightfully be subjected to an examination *de bene esse* under the statute. The question of the authority of the Commissioner and of the regularity of the proceedings before him, is properly brought before the Court by affidavit, and the witness must be discharged from the attachment.

JOHN A. PITTS *vs.* JOSEPH HALL.

The presumption of law is, that a patentee was the inventor of that which he patented, and the burden is thrown on the defendant to disprove the fact.

A person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embodied in his improvement.

But, in order to invalidate a patent on the ground that the patentee did not conceive such idea, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement completely and perfectly.

An inventor may *forfeit* his right to an invention by using it publicly, or by vending it to others to use, at any time prior to the period of two years before his application for a patent.

Such use must be a use by the patentee himself, publicly, in the ordinary way of a public use of a machine, and not a use for experiment or trial, with a view to test its operation or ascertain its defects.

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A forfeiture of an invention is not favored in law ; and, where a *use* is relied on as having worked a forfeiture, the evidence should be quite clear that the use was not by way of experiment, or for the purpose of perfecting the machine.

An inventor may *abandon* his invention, or dedicate it to the public, at any time before procuring his patent.

But the mere use or sale of the invention by the patentee within two years before his application for a patent, will not alone or of itself work an abandonment. There must be, in addition, some declaration or act going to establish an intention on his part to give to the public the benefit of his invention.

Declarations of a determination not to take out a patent, but to let the public have the invention, will estop the party making such declarations, and any one holding under him, from afterwards asserting his right against one who acts on the faith of them.

But declarations of an intention to dedicate an invention to the public, will not be regarded as equivalent to an actual dedication. Besides words, there must be acts, in order to fasten on a patentee the intention which, in judgment of law, will work an abandonment of his invention.

Such an abandonment operates in the nature of a forfeiture of a right, which the law does not favor, and must be made out beyond all reasonable doubt.

In patent cases, the plaintiff is entitled to the actual damages he has sustained in consequence of the infringement of his patent, as contradistinguished from exemplary, vindictive and punitive damages.

One mode of arriving at the damages is, to ascertain the profits which the plaintiff derives from the machines he makes and sells and which have been made and sold by the defendant.

Another mode is, to ascertain the profits which the party infringing has derived from the machines ; but this measure of damages is not controlling, and the plaintiff is entitled to the profits he would have made if not interfered with.

The plaintiff is entitled to interest on the actual damages, from the commencement of the suit.

(Before NELSON and CONKLING, JJ., Northern District of New York, June 19th, 1851.)

THIS was an action on the case, tried before Mr. Justice NELSON and Judge CONKLING, for the infringement of Letters Patent granted to Daniel Carey, of Clarkson, N. Y., June 27th, 1846, for an "improvement in the horse-power." The plaintiff was assignee of the patent, for the State of New York. The infringement alleged was the making and selling horse-powers containing the patented improvement. There was no dispute as to the identity of the defendant's machines with that patented. The grounds on which the defence was

rested, and the material points in the evidence, will sufficiently appear from the charge of the Court.

In charging the jury, NELSON, J., remarked :

As to the particulars of the improvement invented by Carey, we do not think it material to call your attention to them critically, because they are not in controversy. In very general terms we may say, that the invention is a new arrangement of the gearing of the horse-power, by duplicating it, and in this way distributing the power applied to the line or driving shaft, and diminishing the strain on any one part of it. It is admitted by the defendant that this arrangement of the gearing and distribution of the strain, in the operation of the machine, is new and useful, and the proper subject of a patent. The novelty of the improvement, therefore, which is a very important matter in most patent cases, need not embarrass your deliberations, in examining the questions growing out of this case.

This brings us to the first question arising upon the evidence, and that is, whether or not Carey, the patentee, was the first and original discoverer of the improvement. This is the most material question in the case, and the one that has been the most severely litigated. It is undoubtedly vital to the right claimed by the plaintiff, and, of course, it is one to which you will be obliged to turn your attention with some particularity. A good deal of evidence has been given by each of the parties, bearing on this question, both by deposition and by the examination of witnesses in Court. Carey having obtained his patent from the Government in June, 1846, the presumption of law is with him. He is, in the first instance, to be deemed the inventor, and the burden is thrown on the defendant to disprove the fact. This he has assumed, and he insists that the witnesses Daniel Fowler and Russell Bowers, one or both of them, were the first inventors of this peculiar arrangement, and that they made to Carey the first suggestions of the improvement, and of the particular combination embodied in the description of the

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patent. It is claimed, on the part of the defendant, that these witnesses prove that they made the first suggestions of this new arrangement to Carey as early as September, 1839, at a public house in Chili, Monroe County, where they were at the time, and where they met Carey. You recollect the drawings testified to by them as accompanying the explanations they made to him, and which they claim to have been the result of previous consultations between them about this improvement, with a view to perfect it. There is also the testimony of Leonard Hall, on this branch of the case. He states that, in the spring of 1846, he was present at this same public house, in Chili, in company with Carey and Bowers, and the subject of an improvement on the old horse-power came up, and Bowers mentioned to Carey and the witness his contemplated improvement on the machine, and took out some chalk and made a drawing on the floor and explained it.

In connection with the testimony of the two witnesses Bowers and Fowler, it is proper to call your attention to a circumstance which should be taken into the account when endeavoring to ascertain the credit and weight to which their testimony is entitled. It is, that Bowers purchased of Carey two machines containing the patented improvement, one in 1844 and one in 1845. And it appears that at this time, or at some previous time, when speaking of this improvement of Carey's, he recommended it highly, as being by far the best arrangement of the horse-power in public use, and stated, also, that he intended to have one or two of the machines before he went West. And, while thus speaking of the improvement and recommending it for its advantages, he did not pretend that he was the inventor or had suggested the arrangement to Carey. This circumstance is relied on to weaken the effect of his testimony. It is for the jury to say what effect it should have. He purchased two or three machines, and took them with him when he went West.

Another fact should be noticed in relation to the testimony of Fowler, the other witness. He wrote a letter, on the application of the plaintiff, giving an account of the part he had

taken in getting up this improvement, and undertook to give a detail of the interview between him and Carey upon this subject. That letter was signed by Fowler, on the application of the plaintiff. The witness did not read it himself, but heard it read before he put his signature to it. It is insisted by the plaintiff, that the account he gave in this letter of the part he took in the improvement, and of the suggestions he made to Carey in getting it up, fell far short of the account he has given in his deposition, and that, for this reason, his testimony going to detract from the merit of Carey should be regarded with considerable allowance. It is for you to say to what credit the witness is entitled.

This is the substance of the proof put forth on the part of defendant, to rebut the presumption of law arising from the patent, in favor of the claim of Carey, and to show that he was not the original inventor, but, on the contrary, that he got up the improvement on the suggestion of Fowler and Bowers.

In answer to this view, it is claimed, on the part of the plaintiff, that Carey made the improvement himself, in the summer and fall of 1842 and the spring of 1843; that he was engaged for some time in the discovery and in making drawings and experiments with a view to perfect it; that the result was due to his ingenuity and labor bestowed on the subject; and that he actually constructed a machine in the spring of 1843, completed it in June of that year, and put it in operation in the course of the fall. It is insisted, therefore, for the plaintiff, that he has shown that Carey was the inventor of the arrangement which has turned out to be so highly useful and profitable. The witnesses relied on to maintain this view of the case are Shelton, the brother-in-law of Carey, and who witnessed the experiments and trials made by him, and has related the conversations had with Carey at the time; Howe, who lived in his family from 1842 to 1847, and has detailed his knowledge of these experiments and trials; and Peck and Thompson, who built the first machine in the spring of 1843.

Without going into the evidence with any more particularity, we shall leave this question with you. It is a simple question of fact, and its determination will depend upon the exercise of good sense and judgment and an attentive and critical examination of all the testimony in the case.

Now, there is no doubt that a person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius, and not of another's. Thus, in this case, the arrangement patented must be the product of the mind and genius of Carey, and not of Bowers' or Fowler's. This is obvious to the most common apprehension. At the same time, it is equally true that, in order to invalidate a patent on the ground that the patentee did not conceive the idea embodied in the improvement, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement. In other words, the suggestions must have been sufficient to enable Carey, in this case, to construct a complete and perfect machine. If they simply aided him in arriving at the useful result, but fell short of suggesting an arrangement that would constitute a complete machine, and if, after all the suggestions, there was something left for him to devise and work out by his own skill or ingenuity, in order to complete the arrangement, then he is, in contemplation of law, to be regarded as the first and original discoverer. On the other hand, the converse of the proposition is equally true. If the suggestions or communications of another go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another.

These are all the observations I shall trouble you with on the first branch of the case. It is an important question, and, in one aspect of the case, puts an end to the controversy. It is for you to say, after weighing carefully the whole evidence,

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who is entitled to the merit of this improvement—who invented and perfected it. I do not mean, who constructed the first machine, but who conceived and gave practical form and effect to the ingenious arrangement which constitutes the improvement engrafted on the old machine.

The next question in order, in the examination of the case, assuming that you may come to the conclusion that Carey was the inventor, is, whether or not he has forfeited his right to the invention, or has abandoned it to the public use. By the 7th section of the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 354,) it is provided, that “every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale or prior use has been for more than two years prior to such application for a patent.” The right to an invention may be forfeited or abandoned in two ways: first, by using or vending the improvement more than two years prior to the application for a patent; and secondly, by a dedication or abandonment of it to the public use. There may be an abandonment by the inventor at any time, even within the two years before the application for his patent.

In the first place, the patentee may forfeit his right to the invention if he constructs it and vends it to others to use, or if he uses it publicly himself in the ordinary way of a public use of a machine, at any time prior to the period of two years before he makes his application for a patent. That is, he is not allowed to derive any benefit from the sale or the use of his machine, without forfeiting his right, except within two

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years prior to the time he makes his application. In this case, the application by Carey was made on the 28th of April, 1846. The two years would extend back to the 28th of April, 1844, and the sale or use of the machine, in order to work a forfeiture of his right, must have taken place anterior to the latter period. It is not pretended that there was any sale of this improvement previous to that time; and but one machine had been previously constructed. But it appears that this machine was used by Carey in 1843, in the business of threshing. This, unexplained, would operate as a forfeiture of the right. It is claimed, however, that the machine was used in the fall of 1843 by way of experiment and trial, with a view to ascertain whether it would meet the expectations of the discoverer, and to enable him to ascertain any defects in its operation or construction, so that he could remedy them before the application for the patent. It is also claimed that there were defects, and that material alterations were made in the spring of 1844, in the construction of the second machine; that the two bevelled wheels driven by the bull pinions were too large, so large that they were obliged to be extended over the frame, which threw the gearing, and the arms to which the horses were attached, so high as to put the machine out of gear, by canting the machinery; and that, to relieve this defect, the two bevelled wheels were reduced in the spring of 1844, and dropped down within the frame, so as to lower the gearing and arms. It is insisted, therefore, that the use in the fall of 1843 was by way of trial, and that the experiments resulted in a change in the construction of the machine. No doubt the view presented, if you think it sustained by the evidence, explains satisfactorily this previous use, and prevents its working a forfeiture of the right of the patentee.

On the other hand, if the machine was complete when it was constructed in June, 1843, and if the patentee put it into public use, or put it in operation himself publicly, deriving profit from it, and having no view of further improvements or of ascertaining its defects, then, this use having occurred anterior to the two years, the effect would be to work a for-

feiture. It is proper to say, however, that this ground of forfeiture is not favored in law, but is regarded as being somewhat harsh in its operation on individual rights. The evidence, therefore, should be quite clear, that the use was not by way of experiment, or for the purpose of perfecting the machine, in order to justify the conclusion that the patentee had forfeited his right to the improvement.

Then, as to the point of abandonment. This is a difficult question, although somewhat connected with the one to which we have been directing your attention. An abandonment or dedication may occur within the two years, and at any time down to the procurement of the patent. The mere use or sale, however, of the machine, within the two years, will not alone or of itself work an abandonment. There must be something more, because the 7th section of the Act of 1839 permits the sale or use by the patentee at any time within two years before his application, without its operating to invalidate his right. The use or sale must be accompanied by some declarations or acts going to establish an intention on the part of the patentee to give to the public the benefit of his improvement. The question here is, whether there has been shown any such act or declaration of Carey's prior to April, 1846. If the evidence leads you to this conclusion, then there has been an abandonment which operates as a dedication of the invention to the public, and bars the claim of any one under the patent.

It is insisted, on the part of the defendant, that the patentee should be bound by his declarations; and evidence has been given that, on several occasions, he expressed a determination not to take out a patent, but to let the public have the invention. Undoubtedly, a person acting on those declarations, who has constructed a machine and put it in operation, would not be liable to the patentee, or to any one holding under him, for an infringement, because Carey, having led the defendant, by his declarations, to believe that he had a right to construct and put in operation the machine, without exposing himself to responsibility, would be estopped

from afterwards denying the license thus given. But that is a different principle, and is founded on a different consideration, from the one that gives to these declarations of Carey's the effect of a dedication of the improvement to the benefit of the public. We think he is entitled to the *locus penitentiae*, and that there must be something more than mere words, to fasten on him the intention which, in judgment of law, would work an abandonment of his invention. There must be acts. The invention is the property of Carey, as much as the stock on his farm, or the furniture in his house, and the mere expression of an intention not to take measures for the purpose of securing to himself the exclusive enjoyment of this property, or the mere declaration of an intention to dedicate it to the public, cannot be regarded as equivalent to an actual dedication. This abandonment or dedication, too, operates in the nature of a forfeiture of a right, which the law does not favor, and which should be made out beyond all reasonable doubt.

The only remaining question is as to the damages. This assumes, in the first place, that you will find that Carey was the first and original inventor; and, in the next place, that he has not forfeited or abandoned his right to the public. The general rule is, that the plaintiff, when he has established a right to recover, is entitled to all the actual damages which he has sustained in consequence of the infringement of his patent, as contra-distinguished from exemplary, vindictive and punitive damages. These are not to be taken into consideration in patent cases.

One mode of arriving at the actual damages is, to ascertain the profits which the plaintiff derives from the machines which he manufactures and sells, and which have been made and sold by the defendant. This mode is founded on the presumption of law, that if the defendant had not been wrongfully concerned in the manufacture of the machines, those persons who procured them from him would have applied to the patentee or assignee for them.

Another mode, and the one resorted to partially in this

case is, to ascertain the profits which the party infringing has derived from the use of the invention or the construction of the machines ; because, whatever profits he has derived have arisen from the wrongful use of the invention, and belong to the real owner of the machine. This measure of damages, however, is not controlling, and ought not to be ; because, a party concerned in infringing a patent stands in a different position from the patentee, not having been previously subjected to the expense and labor to which the latter is frequently exposed in the process of invention and experiment. Hence, the person who enters upon the business without previous expense, may very well afford to sell machines at less profit than the patentee. The latter must have his profit, not only for the expense of putting in operation the improvement, but by way of indemnity for the previous time, labor and money which he has been obliged to bestow on the invention. He must, therefore, charge a higher price, to cover these greater expenses. Thus, profits which the party infringing might be satisfied with, and which would afford him compensation, would not afford indemnity to the patentee. If, therefore, on looking into the profits made by the defendant, the jury shall be of opinion that they do not correspond with the fair profits which the plaintiff, if left alone, would have realized, they are not bound by the measure of the profits of the defendant, but have a right to look to the profits which the plaintiff or the patentee would have made under the circumstances, if not interfered with. It is admitted that the defendant made forty-two machines within the time for which the plaintiff is entitled to recover, if at all, and your inquiry will be as to the profits which the plaintiff would have derived from those machines if they had not been manufactured by the defendant. You will thus approximate to the actual damages which the plaintiff has sustained, and you will add interest from the commencement of the suit.

The jury found a verdict for the plaintiff, for \$2,345.

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Samuel Stevens and William F. Cogswell, for the plaintiff.

Harvey Humphrey, Charles M. Keller and Samuel Blatchford, for the defendant.

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vs.

WILLIAM H. SEYMOUR AND DAYTON S. MORGAN.

In an action for the infringement of a patent, it being objected, that the arrangement of machinery claimed in the patent was so simple and obvious as not to be the subject of a patent: *Held*, that novelty and utility in an improvement are the only conditions requisite to the granting of a patent.

On a question of the novelty of an improvement in a reaping machine, the inquiry for the jury is, whether the alleged prior invention is identical with the plaintiff's, or whether his involves a new operation and produces a new effect on the standing or tangled grain, in the use of the machine.

On the point of infringement, the inquiry is, whether the defendant's machine involves, in its construction, some new idea not to be found in the plaintiff's, or whether the plan of the former is in substance the same as that of the latter, the differences introduced in the former being merely differences in things not material or important.

If the defendant has taken the same general plan and applied it for the same purpose, though he may have varied the mode of construction, he will only have introduced mechanical equivalents, and it will still be, substantially, and in the eye of the patent law, the same thing.

In *McCormick's* patent of October 23d, 1847, for *improvements in reaping machines*, the claim of "the arrangement of the *seat* of the raker over the end of the finger-piece, which projects beyond the range of fingers, and just back of the driving-wheel, *as described*, in combination with and placed at the end of the reel," is not a claim for the seat *as a seat*, or for its particular mode and form of construction, but is a claim to the arrangement and combination of machinery described, by which the benefit of a seat or position for the raker on the machine is obtained.

Since the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 353,) a patentee may make and vend or use his invention within two entire years before the time when he applies for a patent, without forfeiting or necessarily abandoning his right to a patent; but, if he either sells a machine, or uses one, or puts one into public use, at any time more than two years before his application, it works a forfeiture of his right.

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The Act virtually extends the patentee's privilege to sixteen years instead of fourteen.

The mere fact that an inventor makes and sells an invention, or puts it into public use, at any time within two years before he applies for a patent, is not, of itself, an abandonment, of the invention to the public.

Something more must be done within the two years—there must be some acts of the inventor, indicating an intention on his part to devote his improvement to the public in general—in order to authorize a jury to come to the conclusion that he has so abandoned it.

Those who rely upon the ground that a party has forfeited a legal right secured to him in due form of law, for the purpose of defeating his enjoyment of that right, must make out the point clearly and satisfactorily, beyond any reasonable doubt or hesitation; because, the law does not favor an abandonment, and throws upon the party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question.

The general rule as to damages in patent suits is, that the plaintiff is entitled to the actual damages he has sustained by reason of the infringement; and those damages may be determined by ascertaining the profits which, in judgment of law, he would have made, provided the defendant had not interfered with his rights—upon the principle that, if the defendant had not so interfered, all persons who bought his machine would necessarily have purchased the patentee's.

There is no distinction, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine, and the damages, in the latter case, are not to be limited in proportion to the value of the improvement.

The inventor of an improvement on an old machine, who has a right to use the old machine, is entitled, under a patent for his improvement, to the benefit of the operation of the machine under all circumstances, with the improvement engrafted upon it, to the same degree in which the original patentee was entitled to the old machine.

In order to ascertain the nett profits on the making and selling of machines, the jury must take into account, as making up the cost and to be deducted from the sale price, the cost of materials and labor, the interest on capital used, the expense of putting the machines into market, such as agencies and transportation and insurance; and, where the article is sold on credit, a deduction must be made for bad debts.

When the actual damages are ascertained, the plaintiff is entitled to interest on them from the commencement of his suit.

The jury may also allow to the plaintiff the damages which he has sustained beyond those arising from the actual interference of the defendant in making and putting into market machines which infringe the patent—such as damages from publications by the defendant, disparaging the plaintiff's improvement, while engaged in violating the patent.

(Before NELSON, J., Northern District of New York, June, 1851.)

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THIS was an action on the case, tried before Mr. Justice NELSON, for the infringement of two several Letters Patent granted to the plaintiff, one on the 31st of January, 1845, and the other on the 23d of October, 1847, for improvements in reaping machines. The points raised on the trial sufficiently appear from the charge of the Court to the jury.

In charging the jury, NELSON, J., remarked as follows :

The first patent in this case, which is in question between the parties, was granted to the plaintiff on the 31st of January, 1845, in general terms, for "a new and useful improvement in the reaping machine." The only improvements claimed in this patent, which it is insisted have been infringed by the defendants, are two.

The first is the arrangement and combination of the bow and dividing iron, for separating the wheat and straw, in the process of reaping or cutting, in the manner described. In speaking of this improvement, the patentee says, that he has a piece of scantling some three feet long and three inches square, made fast to a projection of the platform by screw-bolts ; to the point of this piece of scantling is made fast, by a screw-bolt, a bow of tough wood, the other end of which is made fast at the back part of the platform, and is so bent as to be about two and a half feet high at the left reel-post, and about nine inches out from it, with a regular curve. Then there is a description of the dividing-iron, which is an iron rod of a peculiar shape, made fast to the point of the scantling before described, by the same screw-bolt that holds the end of the bow. From this bolt the iron rises towards the reel at an angle of thirty degrees, until it reaches it, that is, until it extends to the reel ; then it is bent, so as to pass under the reel, as far back as the blade or cutter, and to fit the curve of the reel. Then there is a contrivance described to adjust this iron to the reel as it is elevated or depressed, which is not material in this case. "By means of the bow," says the specification, "to bear off the standing wheat, and the iron to throw the wheat to be cut within the power of the

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reel," so that the wheat may be caught and brought to the cutter and upon the platform, "the required separation is made complete." The invention, as claimed in the patent, is substantially this—the arrangement and combination of the bow and the dividing-iron, for separating the wheat, in the manner described.

On the part of the defendants it is insisted, first, that this arrangement and combination is so simple and obvious, that the claim, even admitting it to have been new and not before in use, is not the subject of a patent; secondly, that if it may be the subject of a patent, yet there was nothing new in it, but, on the contrary, it had before been known and in public use; and thirdly, that admitting both its patentability and novelty, still the contrivance used by the defendants for separating the wheat, in the process of cutting and reaping, is substantially different from the contrivance of the plaintiff.

As to the first point—whether the claim in question constitutes the subject-matter of a patent—the 6th section of the Patent Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 119,) provides, in substance, that any person, having discovered or invented any new or useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter, not known or used by others before his discovery or invention, and not, at the time of his application for a patent, in public use or on sale with his consent, may make application to the Commissioner and is entitled to a patent. This is the authority conferred on the Patent-Office for the granting of patents to inventors, and the Act defines with great particularity and clearness what constitutes a patentable subject, at the same time declaring what persons are entitled to a patent. Such being the definition of a patentable subject, declared by the Act of Congress itself, you see from it that the improvement upon a machine, which is the kind of invention in question here, must be new, not known or in use before, and must be useful, that is, the person claiming the patent must have found out, created and constructed an im-

provement which had not before been found out, created or constructed by any other person, and it must be beneficial to the public, or to those persons who may see fit to use it. Novelty and utility in the improvement seem to be all that the statute requires as a condition to the granting of a patent. If these are made out to the satisfaction of a jury, then the subject is patentable, and the inventor is entitled to the protection and benefit of the statute. Otherwise, he is not. This is, perhaps, the only general definition that can be given of the subject of a patent, and it is the only one that the law has given for our guide. The two questions, then, on this branch of the case, are, Was this contrivance, as constructed by the patentee, new and not before known?—and, if so, is it useful? Both these questions being answered in the affirmative, the case comes directly within the definition of the statute.

As to the first question—whether this contrivance for dividing the grain in the process of cutting it was new, or whether it had been before known and in public use. This is very much a question of fact, depending upon the evidence produced in the course of the trial, in connection with the illustrations afforded by the models and drawings and the original machines.

It is claimed by the defendants, that this divider of the plaintiff is to be found in Hussey's machine, patented as early as 1833. A small model of that has been produced; and, although Hussey, in his deposition, gives the entire form and structure of his divider, yet it requires some particular examination to ascertain its precise character. It will be found, however, to be simple and very readily comprehended, and the jury are in full possession of all the facts that are material and important for the purpose of determining whether or not the divider of Hussey affords reasonable evidence that there is nothing new in the contrivance of the plaintiff. Hussey, in his deposition, gives a brief description of his separator. He says that he projects the outer point, to separate the standing wheat, to any given length, and that he also

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uses an upright board, on a line with the outside of the frame of the machine, to prevent the wheat from rolling or falling off or from the cutters.

Then, there is the machine of Mr. Moore, of which you have a model, and which you will consider in connection with his evidence. He states that he constructs his separator with two horizontal lines, being a part of the frame of the machine, converging to a point, and projecting some two feet beyond the fingers; and that, on the machine he built in 1836, he raised a third on the centre line, corresponding, in that respect, with the board used by Hussey in 1833.

You will examine these separators of Hussey and Moore, in connection with the evidence, and look at the particular operation of each in the process of cutting, and ascertain, to your own satisfaction, whether those contrivances are identical with the plaintiff's, or whether he has made one different from either, involving a new operation, and producing a new effect on the standing or tangled grain, in the use of the machine.

The next objection taken by the defendants is that, assuming the divider of the plaintiff to be new and useful and patentable, and that he is entitled to the enjoyment of it free from any interference, still he is not entitled to recover, because the defendants have not used his separator, but have used a different contrivance. This presents another question for you to determine, on an examination of the two separators.

In order to take the separator of the defendants out of the charge of infringement, it is necessary that they should satisfy you that it is substantially and materially different from the plaintiff's; in other words, that it involves some new idea in its construction not to be found in the plaintiff's. If it is found there, of course it is an appropriation of his invention. If not, then it is an independent improvement and no violation of the plaintiff's right.

It is proper to observe, in respect to this particular question, that whether the separator of the defendants be or be

not an interference with that of the patentee, will depend upon this—whether the plan which the defendants have employed, in constructing their separator and in dividing the grain, is or is not in substance the same as the plaintiff's, and whether or not the differences that have been introduced by the defendants in their form of construction, and in accomplishing the design which all these separators seek to accomplish, are merely differences in things not material or important; in other words, whether their plan is, in substance and effect, a colorable evasion of the plaintiff's contrivance, or whether it is new and substantially a different thing. If the defendants have taken the same general plan and applied it for the same purpose, although they may have varied the mode of construction, it will still be, substantially and in the eye of the patent law, the same thing. Otherwise, it will not.

Subject to these observations, tending to advise you, as far as is practicable, on so nice and somewhat metaphysical a subject, as to the rules of law and general principles that should govern on a question of this kind, I shall leave it to you to determine, on the evidence and on an inspection of the models, whether the separator of the defendants is substantially different, in its operation and effect, from that of the plaintiff, or whether it is, in construction and operation, to all substantial and real purposes, the same. If it is, then, if you are with the plaintiff on the two previous questions, you will find for him on this branch of the case. Otherwise, you will not.

The second claim, which also arises under the patent of 1845, is for setting the lower end of the reel-post behind the blade or cutter, curving it and leaning it forward at the top, for the purpose of relieving the cutting, which was before embarrassed by the upright post in front of the cutter, by which means, also, the top of the post can be braced to the tongue.

The description in the patent is substantially this—that the reel-post on the left side of the machine, instead of being

placed before the blade, standing perpendicularly and braced as before, is set, say nine inches, behind the blade, and so leaned forward as to bring the middle of it, or point at which the end of the reel is supported, to its former perpendicular position, the top of the post being thereby so put forward as to admit of its being braced directly to the tongue; by which arrangement the patentee is enabled to brace the post firmly, and, the lower end of the post being behind the blade and crooked out, and the end of the dividing-iron being also bent inward, all tendency of straws to hang upon the post and interfere with the cutting is removed.

The object of this change was to get rid of the post in front of the cutter, which prevented the separation of the straw, and also prevented the grain that was cut from falling on the platform, the tendency being to become entangled around the post. This was the purpose, as declared by the patentee, of the arrangement by which the post is carried behind the cutter, and yet the place of sustaining the end of the reel is preserved.

It is insisted by the defendants that this arrangement is not the subject of a patent, but is a very common device, involving no skill or ingenuity beyond that of the clever mechanic; that it would have suggested itself to any one using the machine; and that it embodies no inventive mind. It is also insisted, by the defendants, that their arrangement for supporting the end of the reel is not substantially the same with the plaintiff's, but is a new arrangement, not suggested by the plaintiff's improvement of setting the post back of the cutter and bending it outward and leaning it forward, and that it does not embrace the principle or idea found in the contrivance of the patentee.

I have already called your attention to the definition of a patentable improvement, as given by the Act of Congress itself. It must possess novelty and utility. It will be for you, bearing in mind that definition, to examine whether or

not the plaintiff's arrangement in regard to the reel-post is a patentable improvement.

You will also examine the models of the respective machines, and recur to the testimony of the experts, and determine whether the change made by the defendants in the mode of supporting the end of the reel, and of getting rid of the upright post in front of the cutter, is a new contrivance, not only in form but in substance, and is not a change suggested naturally from the contrivance of the plaintiff. If it is new, then it is no infringement. But, if it embodies the same idea and its arrangement carries out the same idea—for, this is the true view of the question involved—then undoubtedly it is an infringement.

The general principle which I before stated in respect to the dividing apparatus is equally applicable to the second claim. If the defendants have taken the same plan and applied it to the same purpose, it is in substance the same thing, although they may have varied the mode of construction. It is then only what is called a mechanical equivalent, another way of doing the same thing, by means of mechanical skill, which, however meritorious and creditable to the mechanic, is not an invention.

This brings me to the third and last claim, and probably the most important one in this controversy. It arises under the patent of October 23d, 1847. It is for an arrangement of the seat of the raker over the end of the finger-piece which projects beyond the range of fingers, and just back of the driving-wheel, in combination with and placed at the end of the reel, whereby the raker can sit with his back towards the team, and thus have free access to the cut grain laid on the platform and back of the reel, and rake it from thence on to the ground by a natural sweep of his body, and lay it in a range at right angles with the swath, thereby avoiding unevenness and scattering in the discharge of the wheat, and accomplishing the same with a great saving of labor. This improvement is particularly described by the patentee, and it is undoubtedly important that the jury should look into the

description which the plaintiff has given of this improvement, and ascertain particularly what he claims he has invented, in order to be able to determine whether the improvement had or had not been before discovered or brought into public use, and, if new, whether it has or has not been infringed by the defendants.

The driving-wheel, says the specification, is placed further back than before, and back of the gearing which operates the cutter—the gearing which operates the crank being placed forward of the driving-wheel—thus balancing the frame of the machine with the raker on it, and making room for him to sit or stand on the frame, back of the driving-wheel, with his back to the horses. The patentee then places the reel further forward towards the horses than before, and makes it shorter—it having before projected out over the fingers. He thus makes room for the raker to use his rake freely. The effect of advancing the reel forward is to open to the action of the rake the platform on which the grain falls, and, by shortening the reel, room is afforded for the operations of the raker himself. In consequence of the reel being shorter than before, a wheel-board is introduced, one end of which is fastened to the inside hound, and it is so curved as to force the grain upon the edge of the swath inward, so as to be caught by the reel in its revolutions. The wheel-board also prevents the grain from getting under the frame and being entangled in the gearing of the machine. It is important that you should bear in mind this description given by the patentee of his improvement, and carry it with you when you are comparing his arrangement with previous improvements, with a view of determining whether it is the same thing with them or substantially different.

It has been made a point, in the course of the trial, that the seat of the raker is the improvement and the novelty claimed by the patentee; that not only the seat on the frame, but the mode and form of its construction is also part and parcel of the invention; that, in this respect, there is a difference between sitting and raking, and standing and raking; and that

the one does not necessarily involve the other. I have looked particularly into this branch of the case, because I have felt that it was the most important question involved, and that the claim in respect to it was the most meritorious one on the part of the plaintiff—more meritorious than either of the other contrivances—if he be entitled to any merit for his improvements.

Now, in order to ascertain, with reasonable certainty, what the patentee really believed he had invented, and for what he sought and obtained a patent, we must look into the description of the thing which he himself has given to the public, because there we must find his title, and there the public must look, after his term expires, to obtain the benefit of the use of his machine. From the description I have already given you, you see that the seat is not the thing which he claims in his description to have invented. The seat was the object and result he was seeking to attain, by the improvement which he supposed he had brought out. What he invented was, the arrangement and combination of machinery which he has described, by which he obtained his seat. That, and not the seat itself, constituted the essence and merit, if any, of the invention. What, then, was necessary, in order to obtain the benefit of this position for the raker? The difficulty before was, that the axle or shaft of the reel was perpendicular over the cutter, and the reel was thrown back very much over the platform. It was also extended on a line with the cutter, close up to the gearing, so that the end of the reel, extending to the side of the machine, interfered with a person placed behind the horses for the purpose of raking, and the reel, being too far back, interfered with the rake in its use. Thus, it appears that a seat was put on for the harvest of 1845, and some two hundred machines were made at Cincinnati for that harvest. That seat was put on without any change in the structure of the machine, except to fasten on the seat, extending from the front to the back. Those seats were put upon all the machines that were made for the harvest of 1845, but all agree that they went out of use generally, so

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great was the interference with the rake and raker, and it was that difficulty and obstruction that led to the subsequent modification of the machine. The reel was advanced in front of the cutters and shortened, and the driving-wheel was put back and the gearing forward, so as to balance the machine with the weight of the raker on the end of the finger-piece.

It has also been supposed, that there was something in the idea that the patentee in his claim says: "I also claim, as my invention, the arrangement of the *seat* of the raker over the end of the finger-piece which projects beyond the range of fingers, and just back of the driving-wheel, *as described*, in combination with and placed at the end of the reel." He here claims the seat "*as described*;" but, on recurring to the description, we find the patentee saying that the driving-wheel is placed further back, and other changes are introduced, thus making room for the raker *to sit or stand* on the frame. It is this seat, as thus described, by which the raker may sit or stand on the frame and rake the wheat from the platform with convenience, that is claimed in the specification.

It is insisted, on the part of the defendants, that there is nothing new in this, because there is, in the machine of Hussey, a seat, or, what is equivalent, a position for the raker, in which he may stand and rake off the grain. The seat, that is, the position on the platform, is, in one sense, undoubtedly common to both. But, Hussey's machine has no reel to interfere with the raking, and the grain, instead of being raked from the platform, is pushed from the back part of it. The question is, whether the arrangement of the seat—the combination by which the patentee obtains and can use the seat or position—is similar to or substantially like the contrivance in Hussey's machine. That is the point. The mere fact that a seat was used in previous reapers, does not embrace the idea contained in this patent. That view could only be material under the assumed construction given by the counsel for the defendants to the patent, that it is for a seat. If that

were the thing invented and claimed by the patentee, then the seat of Hussey would be an answer to the claim.

There is also another point to which it is proper to call your attention in this connection, and which has been the subject of discussion by the counsel, and that is, that Hussey, in the construction of his machine in Ohio, at a very early day, used a reel in connection with his cutter and a raker. It is insisted, that this use of the reel, in connection with a raker, in Hussey's machine, before the discovery of the plaintiff, destroys his claim to originality. In answer to this, it is claimed, on the part of the plaintiff, that the contrivance of Hussey into which the reel was introduced, was substantially different from the plaintiff's contrivance. It seems that Hussey's reel, like the reel of the plaintiff when his first seat was put on in 1845, interfered with the raker, so as to prevent his raking the grain the whole length of the platform. Hence, Hussey had an endless apron, by which the grain, when cut, was deposited at the feet of the raker, so that he could shove it off with his rake. Such was Hussey's contrivance for avoiding the difficulty that existed in the interference of the reel with the operations of the raker, by bringing the grain to the raker upon an apron, so that he should not be obliged to extend his rake in front of the reel. The next ground urged by the counsel for the plaintiff, in answer to this evidence to destroy the novelty of his patent, is, that Hussey abandoned and gave up that arrangement of his, as an unsuccessful experiment, and that, therefore, the idea which may have been and probably was in his mind, when he attempted to get up this contrivance for the benefit of the raker, was never completed or carried into practical effect, and that other contrivances were resorted to by him, in place of the reel, which he threw away and has not used since. It is not important, however, to take up your time with this last suggestion, because it is clear that the arrangement of Hussey, when he used the reel in connection with his endless apron, did not touch or reach at all the modifications and alterations subsequently made by the plaintiff to accomplish

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the same end, but was altogether different in its operation. Hussey used the endless apron to get rid of the difficulty which the plaintiff avoids by putting his reel further forward, cutting off the end of it and introducing a wheel-board.

The next material question is, whether or not the defendants' arrangement of the seat or position for the raker is like that of the plaintiff, and whether or not the construction and use of it by them are an appropriation of his contrivance and an infringement of his machine. Now, I lay aside the mode of constructing these respective seats. I mean their form, whether they are constructed with the seat extending between the legs of the raker, with a front piece to support him, or with no seat between his legs and only a support around his body. I lay all that out of view, because I do not think the form of the seat is embraced in the plaintiff's invention. It may be of one form or of another, and it is very likely that the practical use of the machine by the raker is the only true test for determining what form of seat would be most advantageous and least injurious. The raker would work out the best form of seat, by actual trial. He might cushion the seat or make it of any form he pleased, but that would not enter into the invention or have anything to do with its merits. The invention is, the arrangement by which the raker can be placed where he is placed, standing or sitting, and do his work. You will then take up the defendants' machines, laying the seat out of view, and see whether their construction, arrangement and combination, for the purpose of obtaining a position for the raker on the machine, involves the combination of the plaintiff. If it does, then it is an infringement. If it does not, then it is an independent contrivance, and they are entitled to its enjoyment.

It is further claimed, on the part of the defendants, that, assuming all the positions taken by the plaintiff to be true, and that he is entitled to protection in the enjoyment of this improvement, as being its first and original inventor, yet he has forfeited it to the public, or has, at least, abandoned it to the benefit of the public, by his acts and conduct. Now, as there

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is no disagreement between the counsel upon the law applicable to this branch of the case, I will not take up your time by expounding the Act of Congress at large, but will assume the law to be as it has been laid down by the Court in this Circuit. Since the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 353,) a patentee may make and vend or use his improvement or invention within two entire years before the time when he makes his application for a patent, without forfeiting or necessarily abandoning his right to a patent. As I understand this statute, and as, I believe, it has been generally construed and applied thus far in the several Circuits, it virtually extends the patentee's privilege to sixteen years instead of fourteen; that is, he may use his improvement, by making and using his machines, and by vending and taking pay for them, for two years previous to his application for a patent, without forfeiting the benefits conferred upon him by his patent. But, if he either sells a machine or uses one, or puts one into public use, at any time more than two years before his application, it works a forfeiture of his right.

It is claimed by the defendants, first, that the plaintiff has forfeited his right in this case; and secondly, that he has abandoned it.

The plaintiff's application for the patent which was issued on the 23d of October, 1847, was made on the 3d of April, 1847. Any sale, therefore, or any use of the improvement, subsequent to the 3d of April, 1845, is protected by the statute of 1839, and cannot be relied upon as working a forfeiture. It is necessary, therefore, that the defendants should show a sale or putting into public use of the patented improvement prior to the 3d of April, 1845. That involves a question of fact. I have had some difficulty, on looking through the testimony, in ascertaining the precise time when the improvement embodied in the patent was made by the plaintiff. The exact time has not been shown, but it appears in evidence, and I have looked into this with great care, that this patented improvement in regard to the seat, as claimed

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by the plaintiff, was not in the machines constructed for the harvest of 1845. Those machines were made by Brown, by Magnes and by Zink. They had a board seat put upon them, without any change being made in the arrangement of the machine or of the reel, and had no wheel-board. That seat went out of use and was a failure. Of course, none of the machines with that seat, although used with the assent of the plaintiff, come within the rule of law in relation to the question of forfeiture, because they do not embody the improvement claimed in the patent, and it is *that* which must be put in use more than two years prior to the application, in order to work a forfeiture of the right. There was one machine made for the harvest of 1845, the one of which Chappell and Barnet gave an account, that was carried to Geneseo and Mount Morris in July, 1845, and operated there. It was the one which had a box upon it, and it also had a seat with a front-piece, there having been no piece in front of the raker in the other machines made for the harvest of 1845. But, although the Mount Morris machine had the seat thus arranged, it did not embrace the arrangement subsequently made, and described in the patent of 1847. It was merely one of the old machines with the form of the seat changed; and, so far as I can gather the date, from my examination of the testimony, no machine, with the arrangement and combination described in the patent of 1847, was put into use or on sale until the harvest of 1846.

The next question is that of abandonment. The mere fact of making and selling an improvement or invention, or of putting it into public use, at any time within two years before the application for a patent, is not, of itself, an abandonment of the invention to the public. The right thus to use his invention before the granting of a patent, is a right conferred on the inventor by the Act of 1839. Something more must be done within the two years—there must be some acts of the inventor, indicating an intention on his part to devote his improvement to the public in general, in order to authorize the jury to come to the conclusion that he has so aban-

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doned it. It is for them to say whether the acts of the plaintiff within the two years, satisfy them that it was his design and intention to devote the invention to the public at large, as a gratuity, and without receiving a consideration for its bestowal.

It is proper for me to say, also, that those who rely upon the ground that a party has forfeited a legal right secured to him in due form of law, for the purpose of defeating his enjoyment of that right, must make out the point clearly and satisfactorily, beyond any reasonable doubt or hesitation; because, the law does not favor an abandonment, and throws upon the party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question.

I have thus gone through with the three claims, the divider and the reel-post in the patent of 1845, and the raker's seat in the patent of 1847. If you are with the plaintiff on either one of these claims, he is entitled to your verdict. You will take them up, one by one, and decide whether or not the plaintiff has made out his title to them as inventions, and also, whether or not the defendants have violated his rights. If you find for the plaintiff on any one of the claims, he is entitled to your verdict; and, if you find for the defendants on all of them, your verdict will be for the defendants.

The only remaining question is that of damages. The rule of law on this subject is a very simple one. The only difficulty that can exist, is in the application of it to the evidence in the case. The general rule is, that the plaintiff, if he has made out his right to recover, is entitled to the actual damages he has sustained by reason of the infringement; and those damages may be determined by ascertaining the profits which, in judgment of law, he would have made, provided the defendant had not interfered with his rights. That view proceeds upon the principle, that if the defendant had not interfered with the patentee, all persons who bought the defendant's machine would necessarily have been obliged to go to the patentee and purchase his machine. And the profits that the patentee might have made out of the machines thus

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unlawfully constructed, present, therefore, a ground that may properly aid the jury in arriving at the damages which the patentee has sustained.

It has been suggested by the counsel for the defendants that, inasmuch as the claims of the plaintiff in question here are simply for improvements upon his old reaping machine, the patent for which expired on the 21st of June, 1848, and not for an entire machine and every part of it, the damages should be limited in proportion to the value of the improvements thus made; and that, therefore, a distinction exists, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine. I do not assent to this distinction. On the contrary, according to my view of the law regulating the measure of damages in cases of this kind, the rule which is to govern is the same whether the patent covers an entire machine or an improvement on a machine. Those who choose to use the old machine in this case, have a right to use it without incurring any responsibility. But if they engraft on it an improvement secured by a patent, and use the machine with that improvement, they have deprived the patentee of the fruits of his invention, the same as if he had invented the entire machine; because, it is his improvement that gives value to the machine, on account of the public demand for it. The old instrument is abandoned, and the public call for the improved instrument, and the whole instrument, with the improvement upon it, belongs to the patentee. Any person has a right to use the old machine, but, if an inventor engrafs upon the old machine which he has a right to use, an improvement that makes it superior to anything of the kind for the accomplishment of its purposes, he is entitled, under a patent for the improvement, to the benefit of the operation of the machine under all circumstances, with the improvement engrafted upon it, to the same degree in which the original patentee was entitled to the old machine.

There are some data furnished by the counsel on both sides, which it is proper the jury should take into view, in

ascertaining the damages, provided they arrive at this question in the case. It is conceded that just three hundred machines have been made by the defendants, of the description to which I have called your attention, and testimony has been gone into on both sides, for the purpose of showing the cost of the machines and the prices at which they sold. In order to ascertain the profits accruing to the party who makes machines of this description, you must first ascertain the cost of the materials and labor, and the interest on the capital used in the manufacture of the machines. You must also take into account the expense to which the manufacturer is subjected in putting them into market, such as that of agencies and transportation and insurance; and, where the article is sold on credit, a deduction must also be made for bad debts. All these things must be taken into account, in order to bring into the cost every element that properly goes to constitute it in the hands of the manufacturer. When you have ascertained the aggregate sum of the cost, deduct it from the price paid by the purchaser, and you have the net profit on each machine. By this process you are enabled to approximate to something like the actual loss that the patentee sustains, in a case where his right has been violated by persons interfering with him and putting into market his improvement. There is considerable difference between the witnesses for the respective parties, in their testimony as to the cost of constructing the machine. I believe that the witnesses on the part of the plaintiff brought down the cost to thirty-seven dollars on each machine, and stated the net profit on each to be, on an average, over sixty dollars; while the witnesses on the part of the defendants put the cost at some sixty-seven dollars, including work, labor and expenses, and some made it even higher than that, including the expense of collecting debts and of agencies. It appears that the machines have been sold at prices varying from one hundred dollars, for cash, up to one hundred and twenty dollars and one hundred and twenty-five dollars, on credit, depending somewhat upon the place to which they have been sent.

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Many have gone to a considerable distance into various States, and there is a difference in the price of the machines, whether they are bought at the factory or at distant points.

The question of damages will depend upon the good sense and sound judgment of the jury, upon the facts which have been introduced to show the loss which has been sustained by the patentee, or, in other words, the profits he would have made if the infringement had not occurred. The plaintiff will be entitled, provided, on an accurate estimate, you can arrive at the actual damages, to interest on them from the commencement of the suit in August, 1850 ; and, in addition to all this, if the jury are satisfied that the plaintiff has sustained damages beyond those arising from the actual interference of the defendants in making and putting into market similar machines, they will be justified in allowing them. I allude now to the publications by the defendants, disparaging and denouncing the improvement of the plaintiff, in connection with their infringement by making and vending the article, and while they were thus engaged in the violation of the patent. This question of damage is very much at large, and rests in the sound discretion of the jury. It is always much easier to calculate large profits upon paper than it is to realize them by practical experience in the business of mankind. The question, therefore, is one which the jury must decide with caution, care and prudence, and they must confine the measure of damages to the fair and actual loss which the patentee has, in their judgment, sustained, on account of the infringement by the defendants.

The jury failed to agree upon a verdict.

At the October Term, 1851, at Albany, before Mr. Justice NELSON, the case came on again for trial, when the defendants moved its postponement on account of the absence of a material witness in regard to the patent of 1845. The Court holding that sufficient cause for a postponement had been shown, the plaintiff waived all claim to recover in the suit

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upon the patent of 1845, and the Court directed the trial to proceed upon the patent of 1847 alone. The evidence given on both sides, as to the latter patent, was very much the same as on the previous trial, and the charge of the Court was substantially the same. The jury found a verdict for the plaintiff, for \$17,306 66.*

Samuel Stevens, Charles M. Keller, Edwin W. Stoughton and Samuel Blatchford, for the plaintiff.

Ransom H. Gillet and Henry R. Selden, for the defendants.

ELISHA FOOTE vs. HORACE C. SILSBY AND OTHERS. IN EQUITY.

In Foote's patent for an "improvement in regulating the draft of stoves," the first claim, being a claim to "the application of the expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue," is a claim independent of any particular arrangement or combination of machinery or contrivance for the purpose of applying the principle to the regulation of the heat of stoves.

Where a party has discovered a new application of some property in nature never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying the new property.

Hence, the inventor has a right to use any means, old or new, in the application of the new property to produce the new and useful result, to the exclusion of all other means.

The case of *Neilson v. Harford*, (*Webt. P. C.* 295,) cited and approved.

A mere abstract conception cannot be the subject of a patent; but, when it is

* Judgment having been entered on this verdict, the defendants carried the case by writ of error to the Supreme Court, where it is reported as *Seymour v. McCormick*, (16 How. 480.) That Court reversed the judgment, on the ground of misdirection by the Court below, in its charge as to the rule of damages, but, sustained its other rulings.

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reduced to practice, by any means, old or new, resulting usefully, it is the subject of a patent, independently of the machinery by which the application is made.

In the case of such a patent, although old means be used by the patentee for giving application to the new conception, yet the patent excludes all persons other than the patentee from the use of those means, and of all other means, in a similar application.

The novelty of the invention covered by said first claim, can be defeated only by showing the prior application of the principle of the expansion and contraction of the metallic rod to regulate the heat of a stove, *by means of the heat produced by the stove itself*. It is not defeated by showing a prior application of the expansion and contraction of a metallic rod to open and close a damper, where the metallic rod was heated *indirectly* by the heat of a furnace, by being immersed in hot water.

But the prior application, in order to defeat the novelty of the said first claim, need not have been made by the very best apparatus that could be devised. The question does not depend upon the degree of usefulness, but upon the practically useful and successful prior application of the principle.

Where, prior to the plaintiff's invention of the application covered by the said first claim, the principle of the expansion and contraction of a metallic rod heated by the stove itself, had been applied to regulate its heat, the rod being, however, a compound rod, composed of a slip of brass and a slip of iron, firmly fastened together, and the motion of the damper being produced through a deflection of the rod resulting from its curvature, caused by the unequal dilatation, under a given degree of heat, of the two metals composing it, that of brass being greater than that of iron, whereas, in the plaintiff's invention, the motion was produced by the direct linear expansion of a brass rod used in connection with an iron stove: *Held*, that the principle of the application of the expansion and contraction of the metallic rod to regulate the damper, by causing it to open and close according to the degrees of heat in the stove itself, as covered by the said first claim, was the same in the two applications.

The said first claim does not involve any mode or method of application, or any question of difference in degree—as that an apparatus having the linear expansion as distinguished from curvature, possesses greater power or can perform what the other cannot.

The third claim of the patent, being a claim to “the combination, above described, by which the regulation of the heat of a stove in which it may be used is effected,” *Held* to be a claim for a *combination*, consisting of four parts, specifically defined.

Though the parts separately may all be old, yet, if the plaintiff was the first to combine all four of them, for the particular purpose of regulating the heat of a stove by means of its own heat, he is entitled to be protected in that improvement.

The novelty of the said third claim is not defeated by showing a prior combination of the same four parts, in which the expansion and contraction of the

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metallic rod were produced by its immersion in hot water, and not directly by the heat of the stove itself whose heat was to be regulated.

The prior combination, to defeat the novelty of said third claim, must have been an apparatus of practical utility, and must have embraced all the elements embraced in the plaintiff's combination.

(Before NELSON, J., Northern District of New York, July 10th, 1851.)

THIS was the trial, before Mr. Justice NELSON, of a feigned issue ordered in this case, (1 *Blatch. C. C. R.* 545,) to try the question, whether the plaintiff was the original and first inventor of the first and third improvements claimed in Letters Patent granted to him May 26th, 1842, for an "improvement in regulating the draft of stoves." The specification of the plaintiff's patent, and, also, descriptions of the apparatus of Dr. Ure and of the egg-hatcher of Bonnemain, put in evidence by the defendants, and referred to in the charge of the Court, are set forth at length in 1 *Blatch. C. C. R.* 446 to 454. All other facts necessary to an understanding of the case sufficiently appear in the charge of the Court.

In charging the jury, NELSON, J., remarked as follows:

The patentee in this case describes particularly, and with great fulness, two modes of applying the improvement which he claims to have made. They differ, I believe, only in one respect, and that consists in the method of detaching the connecting-rod, which is operated by the brass rods, from the damper, so as to prevent all difficulty in extreme heat, and give to the brass rods full operation in any degree of heat that may be applied to them. After giving these two descriptions of the machinery used to carry out the improvement, the patentee then specifies the several improvements which he claims to have invented, as follows: (The Judge here read the four claims in the specification.)

The second claim, which is the adjusting process, and the fourth claim, which is the detaching process, are not in controversy between the parties to this suit, as individual claims, and may be laid out of view; leaving the first and the third as improvements claimed by the plaintiff which are contro-

verted by the defendants, and which present the two questions for your examination and decision. These questions are presented in the form of a feigned issue sent from a Court of Equity to be tried in a Court of law before a jury, and it will, therefore, be necessary for you to take them up separately, and examine them, and return a special verdict on each issue, expressing either affirmatively or negatively your answer to each of the questions.

The first question arises on the first claim set forth in the patent of the plaintiff. You are to examine the evidence which has been furnished by the respective parties, subject to the rules of law which will be given to you, and to determine whether or not the plaintiff was the first and original inventor of the improvement covered by the first claim. If he was, you will respond in the affirmative. If he was not, you will respond in the negative.

There has been some difference of opinion between the counsel for the respective parties, as regards the true construction to be given to the first claim, and it will, therefore, be necessary for the Court to call your attention particularly to this branch of the case. It will be seen that the patentee, after he has set forth, in general terms, that he has made a new and useful improvement in regulating the heat of stoves, has set forth, with great particularity, two modes by which he adapts this improvement to use, through the arrangement of various machinery; and that then, in this first claim, he claims the application of the expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue. Now, it is the application of the expansive and contracting power of the metallic rod to regulate the heat of the stove by opening and closing the damper, the whole being self-acting in the admission or exclusion of air, that is specifically claimed in this part of the patent; and, according to the construction that I give to it and have always

given to it, it is a claim independent of any particular arrangement or combination of machinery or contrivance for the purpose of applying the principle to the regulation of the heat of stoves. I have always supposed, therefore, that the peculiar arrangement or construction of the machinery used did not enter into this branch of the claim. Where a party has discovered a new application of some property in nature, never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying the new property in nature; and, hence, the inventor has a right to use any means, old or new, in the application of the new property to produce the new and useful result, to the exclusion of all other means. Otherwise, a patent would afford no protection to an inventor in cases of this description; because, if the means used by him for applying his new idea must necessarily be new, then, in all such cases, the novelty of the arrangement used for the purpose of effecting the application would be involved in every instance of infringement, and the patentee would be bound to make out, not only the novelty in the new application, but also the novelty in the machinery employed by him in making the application.

To illustrate my view, I will call your attention to a decision upon this point. It is a principle established in the case of *Neilson v. Harford*, (*Webster's Patent Cases*, 295, 310, 328,) and is quoted in *Curtis on Patents*, § 80: "Where the invention consisted in the application of heated air as a blast for fires, forges and furnaces, but the patentee claimed no particular form of apparatus for heating the air, but described an apparatus by which it might be heated, and the defendant had employed an apparatus confessedly superior in its effects to that described in the plaintiff's specification, and such an improvement as would have supported a patent; but, as it involved the principle of the plaintiff's invention, it was held an infringement." Although the defendant in

that case had got up an apparatus which was superior to the apparatus of the patentee, yet, inasmuch as, in his apparatus, he was applying heated air as a blast for furnaces, he was an infringer, because he availed himself of the new idea of the patentee. In § 81 it is further laid down: "In cases of this class, where the most important part and merit of the invention consists in the conception of the original idea, rather than in the manner in which it is to be carried out or applied in practice, it is clear that a principle carried into practice by *some* means constitutes the subject-matter of the patent. Inventions of this class may have a character totally independent of the particular means by which they are applied, although the patentee must have applied the invention by some means; and, when he has done so, the imitating that character may be a piracy of that invention, although the means may be very different, and such as in themselves might constitute a distinct or substantial invention. The machinery employed is not of the essence of the invention, but incidental to it."

Now, in this case, as I understand the claim of the patentee, he claims the application of the principle of expansion and contraction in a metallic rod to the purpose of regulating the heat of a stove. That is the new conception which he claims to have struck out; and, although the mere abstract conception would not have constituted the subject-matter of a patent, yet, when it is reduced to practice by any means, old or new, resulting usefully, it is the subject of a patent, independently of the machinery by which the application is made. I think, therefore, that in examining the first question presented to you, you may lay altogether out of view the contrivance by which the application of the principle is made, and confine yourselves to the original conception of the idea carried into practice by some means; but, whether the means be old or new is immaterial, for, although old means be used for giving application to the new conception, yet the patent excludes all persons other than the patentee from the use of those means and of all other means in a similar application.

The question, then, is whether, anterior to the patent of the plaintiff, any person had discovered the application of the principle in question to regulate the heat of a stove, and applied it by some apparatus which operated usefully to effect that object. On this branch of the case you have the description of the use of this principle by Dr. Ure, for regulating heat in a stove or furnace. Two illustrations and descriptions of Ure's apparatus are furnished by the defendants. You have also the description and model of the application of the principle by Bonnemain, called the egg-hatcher; also the description of the application by Ward, in his ventilator; and the description and model of Evans' contrivance to regulate the admission of cold water into a boiler, with a view to regulate the temperature of the water. You have also the Saxton stove, made in 1838, and produced in Court, and the description of Dr. Arnott's stove improved, and the various models of it furnished by the respective parties. In all these cases, the principle of the contraction and expansion of a metallic rod has been adapted to the regulation of heat for what is claimed to have been a beneficial purpose.

As respects the various contrivances of Ure, Bonnemain and Evans, it does not appear that any one of those persons ever applied the principle of the expansion and contraction of the metallic rod to regulate the heat of a stove, by means of the heat produced by the stove itself, thereby producing a self-regulator; and it is, therefore, quite obvious that no one of them had reached the idea. In all these contrivances, with the exception of Ward's, the metallic rod used to produce the motion by which the damper was opened and closed, was not heated by the air of the furnace, but was heated indirectly by the heat of the furnace, by being immersed in hot water. They all, therefore, fell short of the whole idea embraced in the first claim of the patent. Ward's application was applied to the ventilation of a room, and, so far as regards the conception of the idea of regulating the heat of a stove by the use of an expanding and contracting metal, was altogether different from the plaintiff's. It was a

use of the principle to regulate a damper, but it was not adapted to regulate the heated air of a stove, which is the application in question here. In this respect, therefore, it was the same as Ure's, Bonnemain's and Evans'.

But, in the Saxton stove, you have the application of the principle in question directly to the regulation of the heated air of the stove, by the opening and closing of a damper to admit or exclude the air for the supply of combustion, by the use of a metallic rod heated by the heated air of the stove itself. The same remark may be made in relation to Dr. Arnott's stove improved, if the counsel for the defendants are right in their version of the description of that stove, and if the model they have produced of it be correct. It is of no great moment, however, on this branch of the case, whether they be right or wrong, as the question will turn on the Saxton stove, made in 1838.

Now, it is insisted by the counsel for the plaintiff, that although there is in the Saxton stove an application of the principle of the expansion and contraction of a metallic rod heated by the stove itself, to regulate its heat, yet the rod is a compound rod, composed of a slip of brass and a slip of iron, firmly fastened together, and the motion of the damper is produced through a deflection of the rod resulting from its curvature, caused by the unequal dilatation, under a given degree of heat, of the two metals composing it, that of brass being greater than that of iron; that such an application is distinguishable from an application of the principle made by the direct linear expansion of a brass rod used in connection with an iron stove; and that, in that respect, the improvement of the plaintiff is distinguishable from the principle or conception applied in the Saxton stove. I lay entirely out of view the machinery, and speak only of the idea of applying the principle to regulate the heat of stoves. Such is the distinction relied on to take the plaintiff's improvement specified in his first claim out of the conception found in the application of the metallic rod in the Saxton stove.

It must be remembered, however, that in the patent the

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broad claim is made to "the application of the expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue." And one thing must be admitted, that in the Saxton stove the principle of the expansion and contraction of the metallic rod was applied in the regulation of the damper, by causing it to open and close according to the degrees of heat in the stove itself. The means by which Saxton produced this adaptation were indeed different from the means used by the plaintiff, but the principle was the same. This is obvious from the testimony, and so say all the witnesses who have been examined on the question. Saxton's conception of the idea was anterior to that of the plaintiff. He applied the principle by means of a double bar, which produced a curvature. Still, that curvature was produced by the expansion and contraction of the brass rod, which, being greater under the same temperature than the expansion and contraction of the iron rod, resulted in the curvature, giving a motion which was applied to the regulation of the damper.

The plaintiff is presumed, in judgment of law, although I suppose the fact was otherwise, to have had a knowledge of the Saxton stove, and of the application of the metallic rod to regulate its heat, when he applied the rod to the regulation of the stove described in his patent, and he there saw the principle applied by means of the deflection produced by the two compound bars, and of the motion resulting from the curvature.

The difficulty in this branch of the case, on the part of the plaintiff, lies in his claim to the original conception of the adaptation of the principle to the purpose. Saxton's stove having been anterior in time to the plaintiff's, the principle existed there, and was only applied by the plaintiff in a different mode to the same object. The plaintiff used the direct action of expansion and contraction to regulate the

stove, whereas the combination of the iron rod with the brass rod had been before used. That would seem to be a different mode of applying the principle, rather than an original conception of the idea of adapting the expansion and contraction of the rod to the regulation of a stove. The idea had been before conceived and applied in the Saxton stove.

I have very little more to say on this branch of the case. All that I desire is, to impress your minds distinctly with the thing that is claimed by the patentee, so that you may not confound with something else the actual claim that is made in the first clause of the patent. That claim is not for any mode or method of applying the expansion and contraction of the metallic rod to regulate the heat of the stove, but it is for the conception of the idea itself. It is for you, bearing that in mind, and weighing the evidence in the case, to say, whether the plaintiff was the original discoverer of this conception or not. If he was not, you will answer the first question in the negative. If he was, you will answer it in the affirmative.

I will now call your attention very briefly to the second question. It arises on the third claim, which is in these words: "I also claim the combination, above described, by which the regulation of the heat of a stove in which it may be used is effected." This claim applies to the apparatus used by the patentee in applying the principle. He has given two descriptions of his mode of application. He claims that he is the inventor of the apparatus thus described, and the claim embraces the whole of the apparatus he has set forth in his first description, and also the whole of the apparatus in his second description, the latter differing from the former only in including the detaching process as a part of the combination. This combination consists of, *first*, the brass rod, which is used, as it expands and contracts from the action of the heat of the stove, to give the power to open and close the valve; *second*, the apparatus by which the motion obtained by the expansion of the rod is increased, in order to operate more effectually, which is a combination of

levers; *third*, the adjusting screw, which is used to set the brass rod, with the combination of levers and the connecting-rod attached to the damper, at a given degree of temperature, by which different degrees of heat are obtained in the operation of the stove; thus, if, when the stove is cold, you were to set the brass rod with its connections so that the damper should be but just open, a very slight degree of heat would close it; consequently, the stove and the room it was designed to heat would be kept at a low temperature; but, if the apparatus was set with the damper wide open, it would require an extreme degree of heat to produce a sufficient expansion of the metallic rod to close it; *fourth*, the detaching process, by which the connecting-rod is made to act or cease acting on the damper. In the apparatus of the plaintiff, the connecting-rod operates directly and positively both to open and close the damper. The damper is not closed by its own gravity, by being released at the extreme of expansion.

This is the combination. There are four elements in it, which I have named. The claim is for the combination of all of them, not for any one of them. It is immaterial whether or not the plaintiff was the inventor of any one or two of them, or of any less than the combination of the whole. They may all be old; and yet, if the plaintiff was the first to combine all four of them, for the particular purpose of regulating the heat of a stove by means of its own heat, he is entitled to be protected in that improvement.

Now, I am inclined to think, although the question has embarrassed me, and I may possibly after all have fallen into an error in regard to it, that the combinations of Dr. Ure in the two instances before alluded to, and the models of which have been produced on the trial, the egg-hatcher of Bonnemain and the contrivances of Evans and of Ward, do not come up to the idea of the combination described and claimed by the patentee and embraced in this second question. I mean, aside from the parts composing the apparatus used by these different persons. As I have before said, when

speaking of the first question submitted to you, the contrivances devised by those persons were not constructed to regulate the damper of a stove to be operated on by the heat of the stove. In all the cases mentioned, except that of Ward, the metallic rod was heated, so as to produce the contraction and expansion, by immersion in hot water. The apparatus was made with a view to the heating of the metallic rods in hot water, and not by the heat of the stove, except through the medium of the water which was heated by the stove or furnace. It is quite obvious, that an apparatus to be operated on by the application of hot water, is necessarily different from an apparatus to be acted on by the heat of the stove itself, which is often an extreme heat. This is a view altogether independent of the peculiar arrangement of the apparatus.

It is your duty, however, to look into the arrangement of the machinery used by Ure, Bonnemain, Evans and Ward, to see whether all the elements composing the combination of the plaintiff are found in either of those contrivances—that is, whether you find, in either of them, the brass rod operated on by the heated air of the stove, with a system of leverage to increase motion, the adjusting screw to set the apparatus at a given degree of temperature, and the detaching apparatus constructed in the mode described by the patentee. It is necessary that you should find all these; not only the parts in their peculiar arrangement, but the combination of all the parts of the same peculiar arrangement in one or another of these prior contrivances, in order to make out, in judgment of law, the identity essential to overthrow the claim of novelty involved in the second question.

In addition to those other contrivances, you have again the apparatus used in Saxton's stove. There, there is a direct application of the principle to the regulation of the heat of a stove, and so there is, also, in the case of Dr. Arnott's stove improved, provided you are satisfied with the description of it, and with the accuracy of the model furnished by the defendants. You will, therefore, examine the machinery used

in Saxton's stove, which was made in 1838, and see whether the arrangement and combination are or are not substantially the same with those described in the plaintiff's patent.

There is one consideration which it is proper you should take into view, because it may have some weight on this branch of the case, as respects the comparison of the apparatus in Saxton's stove with the apparatus described by the plaintiff. It is this: In the Saxton stove, the compound-bar is used, and the motion is obtained from the curvature which results from the difference of expansion between the brass rod and the iron rod. In the plaintiff's stove, the motion is produced by the direct linear expansion of the rod. It is, therefore, proper for you to keep this in view, when you are examining the means used by each for the purpose of giving application to this expansive and contracting principle of metals, to see whether the means are the same or not, and whether the principle can be adapted and used by the same apparatus when the metal is acting by curvature and when it is acting longitudinally. This is a question of fact, and it has been so long before you and so frequently referred to and explained by the witnesses and by the learned counsel, in the course of the trial and in summing up, that it is unnecessary for me to call your attention more particularly to this branch of the subject. All that I desire is, to present the point so that you may comprehend it. The question is, whether the combination of the different parts of the machinery used by the patentee for regulating the heat of a stove by means of this principle of the expansion and contraction of a metallic rod was new and not before known, or whether the whole of it is to be found in any of the models, stoves or descriptions which have been given in evidence on the trial. If the combination was new with the patentee, then, so far as regards the second question, your response ought to be in the affirmative. If it was not new, but was known before, either in a full description or in any of the models or stoves which have been produced, your response should be in the negative.

Mr. *Stevens*, for the plaintiff, requested the Court to charge as follows :

1st. In regard to the first branch of the case, that if an apparatus having the linear expansion, as distinguished from curvature, possessed greater power, and if Saxton's stove was incapable of performing what could be performed by the plaintiff's, then the application of the principle in the plaintiff's stove was a new application.

In reply to this request the Court remarked :

The objection to that proposition is, that it involves a method or mode of application and the question of a difference in degree, which is not an ingredient in and does not belong to the first question.

Mr. *Stevens*, for the plaintiff, further requested the Court to charge as follows :

2d. That if the apparatus by which Saxton applied the principle contained within itself the elements of its own destruction, it could not interfere with the plaintiff's rights under his third claim.

In reply to this request the Court remarked :

Although the person who first conceived the idea of applying the principle to the regulation of the heat of a stove by the action of its own heat, is entitled to the merit, yet, if that application was made in a way that was useless, and if it was a failure, it is no impediment in the way of the claim of the patentee ; because, as I before stated, a person, in order to entitle himself to a patent for a new application of a property of nature to a useful purpose in the business affairs of life, must not only have conceived the idea, but must by some means have successfully given application to the new property. In other words, the person who first conceived of the application of the expansion and contraction of a metallic rod acted on by the heat of a stove, to regulate the heat of that stove, must, in order to have entitled himself to a patent, have applied the principle usefully by some apparatus or machinery. But then it is not necessary, in any improvement, that the application to the new and useful

purpose should be made by the very best apparatus that can be devised. The question does not depend on the degree of usefulness. If the application that was made of the principle operated successfully, so as to be practically useful, although it might not have been the very best, yet it was not a failure.

The jury went out at 12 M. At 6 P. M. the jury came into Court, and put to the Court the following question in writing :

" Shall the jury consider the greater utility of either apparatus, in making up their verdict ? "

In reply to this question, the Court remarked :

The degree of utility is not involved in the issues. There must have been some practical utility in the apparatus set up by the defendants as previously known, to show a want of novelty in the plaintiff's apparatus, but the degree of utility is not in question. One may be better than the other, but that fact is not to be taken into account. The one that is alleged to be prior must, however, have been an apparatus of some practical utility ; but, whether it was better or inferior in degree, is not a question.

The jury then retired again. But the Court immediately sent for them again, and, on their coming into Court, the Court remarked :

I have sent for you again, gentlemen, for fear that the answer I gave to the question you propounded might lead to confusion as respects the two issues. I want to inquire if the question you put was put with reference to the first issue or the second issue.

Foreman. The second issue. We have agreed as to the first issue.

The Court then remarked :

The second issue turns on the combination and apparatus of the plaintiff to regulate the heat of the stove, that is, the claim of the plaintiff for a combination of four elements. He alleges that that combination was new with him. In order to overthrow the claim involved in the second issue, you

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must be satisfied that the arrangement set up by the defendants, tending to disprove the novelty of the plaintiff's combination, was an apparatus of practical utility. No matter whether it was superior or inferior to the plaintiff's. It must have been an apparatus of practical utility, and must have embraced in its combination all the elements embraced in the plaintiff's combination; in other words, you must find that it contained an identity of combination.

At 12 M. the next day, the jury rendered a verdict in the negative on both issues.*

Samuel Stevens and Henry B. Stanton, for the plaintiff.

Alvah Worden, Charles M. Keller and Samuel Blatchford, for the defendants.

 SAMUEL R. TRACY

v8.

REUBEN S. TORREY and HIRAM TORREY. IN EQUITY.

Where a patentee of an improvement in cultivators claimed in his patent "the arrangement of the teeth in two rows, in combination with a pair of wheels the treads of which are in a line midway between the points of the two rows of teeth, substantially as described," and, in his specification, described the nature of his invention as consisting in the arrangement of the teeth in

* Afterwards, on a final hearing on pleadings and proofs, the Court entered an interlocutory decree for the plaintiff, notwithstanding the verdict on the feigned issues. The case went to a Master, who took an account. On exceptions, his report was modified, and a final decree was entered for the plaintiff. The defendants appealed to the Supreme Court, where the case is reported as *Silby v. Foot*, (20 How. 378.) That Court modified the decree below in some particulars.

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two rows, one back and the other front, when this was combined with a pair of sustaining and carrying wheels the bearing points of which were in a line midway between the two rows of teeth, so that any tendency which one row of teeth might have to cut too deep was resisted by the weight of earth on the other row, the tread of the wheels between them acting as the fulcrum, so that the team, by this means, was entirely relieved of any strain which they otherwise would have to sustain in consequence of the motion of the beam up and down as the teeth ran too deep or too shallow, and stated that by that arrangement the necessity for guiding-handles and the employment of four wheels were entirely dispensed with, and also described the teeth as seven in number, arranged in two straight rows, three teeth in one row and four in the other, the points of the three teeth being in front of the line of the wheels, and the points of the four teeth being behind the line of the wheels: *Held*, that a cultivator which differed from that described in the patent only in having the axle of the wheels thrown forward and the hind teeth thrown backward so far that the tread of the wheels was not midway between the points of the two rows of teeth, (which increased the leverage behind and reduced the strain on the horses still more than in the plaintiff's arrangement,) and in having the middle tooth of the forward three moved forward, and the two middle teeth of the four behind also moved forward, so that the two rows were not straight, infringed the patented combination; that the infringing machine contained the principle and substance of the patented invention, merely carrying it out further in practice than had been done by the patentee when he took out his patent; and that the infringing arrangement was not in law even an improvement on that of the patentee, because it was only the result of practical experience in the use of the patentee's arrangement, and involved no invention beyond what was embodied in that and was clearly set forth in the specification.

Held, also, that the case was a proper one for a provisional injunction; and that, the infringement being clear, and the right to the injunction manifest, the injunction ought not to be stayed on the defendant's giving security to the plaintiff and rendering a periodical account of sales, although the defendant was a man of pecuniary responsibility.

Held, also, that another machine which differed from the former infringing machine in having the middle tooth of the forward three set back instead of forward, thus bringing the points of two teeth forward of the wheels and the points of five teeth behind the wheels, infringed the patented combination.

(Before NELSON, J., Northern District of New York, August 12th, 1851.)

THIS was an application for a provisional injunction to restrain the infringement of a patent. The plaintiff was grantee of the exclusive right for Yates county, N. Y., under Letters Patent granted to Nathan Ide, of Shelby, Orleans county, N. Y., on the 18th of April, 1846, for an "improve-

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ment in cultivators." In his specification, the patentee described his cultivator as having but two wheels, and set forth the nature of his invention as follows :

"The nature of my invention consists in the arrangement of the cultivator teeth in two rows, one back and the other front, when this is combined with a pair of sustaining and carrying wheels the bearing points of which are in a line midway between the two rows of teeth, so that any tendency which one row of teeth may have to cut too deep is resisted by the weight of earth on the other row, the tread of the wheels between them acting as the fulcrum, so that the team, by this means, is entirely relieved of any strain which they otherwise would have to sustain in consequence of the motion of the beam up and down as the teeth run too deep or too shallow. By this arrangement, the necessity for guiding-handles, or the employment of four wheels, is entirely dispensed with. In all the cultivators heretofore used with which I am acquainted, when two wheels only have been used, the attendant must guide the instrument by means of the handles, which is a very laborious operation, without avoiding the strain on the team by the tendency of the teeth to run in or out of the earth ; and, when three or four wheels are employed, to avoid this strain and relieve the attendant of the labor of guiding, the teeth do not follow the slight irregularity of the surface of the ground, for, when either the front or rear wheels pass over a slight elevation, the teeth are necessarily drawn partly out of the earth, which increases the resistance, and renders the operation on the soil less perfect ; but, by my improved arrangement, all these difficulties are avoided, and, as I employ large wheels, which extend considerably above the upper surface of the frame, by turning the whole implement upside down, it answers the purpose of a cart, in going to or from the field." The patentee described the teeth as seven in number, arranged in two straight rows, three in one row and four in the other, the points of the three teeth being in front of the line of the wheels, and the points of the four teeth being behind the line of the wheels ; the

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teeth being twelve inches in perpendicular height and fourteen inches long and curving forward, and so disposed that no two should work in the same furrow; the horses being attached to a tongue. The patentee's claim was as follows: "What I claim as my invention, and desire to secure by letters patent, is the arrangement of the teeth in two rows, in combination with a pair of wheels the treads of which are in a line midway between the points of the two rows of teeth, substantially as described."

The defendants were manufacturing and selling, within the plaintiff's territory, cultivators which the bill claimed to be the same thing as Ide's. In the defendants' cultivator there were but two wheels, no guiding-handles, and seven teeth, the points of three being in front of the wheels and the points of four behind. But the defendants threw the axle of the wheels forward and the hind teeth backward so far that the tread of the wheels was not midway between the points of the two rows of teeth, and, by thus increasing the leverage behind, reduced the strain on the horses still more. They also moved forward the middle tooth of the forward three and the two middle teeth of the four behind, so that the two rows were no longer straight.

Samuel Blatchford, for the plaintiff.

Alvah Worden, for the defendants.

THE COURT held that the defendants' cultivator was an infringement of Ide's; that the defendants were using the principle and substance of Ide's invention, merely carrying it out further in practice than he had done when he took out his patent; and that the defendants' form of construction was not in law even an improvement on Ide's, because it was only the result of practical experience in the use of Ide's, and involved no invention beyond what was embodied in Ide's and was clearly set forth in his specification.

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The defendants' counsel asked that the injunction be stayed on the defendants' giving security to the plaintiff for his damages and rendering a periodical account of their sales of cultivators. This application was based on the fact that the defendants were men of pecuniary responsibility.

But the Court refused the application, on the ground that the infringement was clear and the right to the injunction manifest.

Injunction ordered.*

ROSS WINANS

vs.

THE SCHENECTADY AND TROY RAILROAD COMPANY.

The claim of Winans' patent, granted October 1st, 1834, for an "improvement in the construction of cars or carriages intended to run on railroads," which claim is "the before-described manner of arranging and connecting the eight wheels, which constitute the two bearing-carriages, with a railroad car, so as to accomplish the end proposed by the means set forth or by any others which are analogous and dependent upon the same principles," is a claim for the car itself constructed and arranged as described in the patent, and evidence that parts of the arrangement and construction were before known does not affect the novelty of the invention.

The location of the trucks relatively to each other under the body of the car, as well as the near proximity of the two axles of each truck to each other, form an essential part of the arrangement of the patentee, who states, in his specification, that the closeness of the fore and hind wheels of each truck,

* In the case of *Chamberlain v. Ganson*, argued at the same time, which was a motion for a provisional injunction for an infringement of the same patent, the defendant's cultivator was like that of the Torreys, except that it had the middle tooth of the forward three set back instead of forward, thus bringing the points of two teeth forward of the wheels and the points of five teeth behind the wheels. An injunction was granted in this case also.

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taken in connection with the use of two trucks arranged as remotely from each other as can conveniently be done for the support of the car-body, with a view to the objects and on the principles set forth by him, is considered by him as an important feature of his invention. But the improvement does not consist in placing the axles of the two trucks at any precise distance apart, or at any precise distance from each end of the body; and the specification is sufficient, although it does not state in feet or inches the exact distance from the ends of the car-body at which it would be best to arrange the trucks, or what should be the exact distance between the axles.

The patent, which was issued in 1834, had no drawings originally annexed to it, and the specification contained no reference to any drawings. The patent was recorded anew in June, 1837, under § 1 of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 191,) and a drawing of the invention, verified by the oath of the patentee under said § 1, was filed in November, 1838: *Held*, in an action for the infringement of the patent, that a certified copy of such drawing was admissible in evidence under § 2 of said Act, in connection with certified copies of the patent and specification, and that the whole together were *prima-facie* evidence of the particulars of the invention and of the patent granted therefor.

As a general rule, such a drawing cannot be used to correct any material defect in the specification, unless it corresponds with a drawing filed with the original specification for the patent; otherwise, in case of discrepancy, the specification must prevail.

Nor can such a drawing have the same force and effect as if it had been referred to in the specification, nor is it to be deemed and taken as part of the specification.

The specification of Winans' patent said nothing about the mode of attaching the car to the motive-power or to the next car in a train, nor anything about the use of side-bearings to prevent the rocking of the car from side to side, but the drawing filed in November, 1838, showed that the car was to be attached to the motive-power and to the next car in a train by its body, and not by a perch from the truck, and also showed a provision for side-bearings: *Held*, that the specification afforded a sufficient description of the invention independently of the drawing, and that the mode of attaching the car and the use of side-bearings did not enter into the essence of the invention or constitute any substantial part of the improvement.

The law allows an inventor a reasonable time to perfect his invention by experiment and ascertain its utility, before it obliges him to take out his patent; and, in the case of Winans' invention, experiments could be made only by putting the car into the service of those controlling lines of railroads. In applying the rule, a jury must take into consideration the nature of the invention, and all the circumstances of the case. But an inventor is bound to act in good faith, and must not suffer his invention to be used except for the purposes of experiment.

(Before NELSON and CONKLING, JJ., Northern District of New York, September 1st, 1861.)

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THIS was an action on the case, tried before CONKLING, J., in June, 1850, for the infringement of Letters Patent *

* The specification was as follows :

"To all whom it may concern—Be it known, that I, Ross Winans, civil engineer, of the city of Baltimore, in the State of Maryland, have invented a new and useful improvement in the construction of cars or carriages intended to travel upon railroads ; which improvement is particularly adapted to passenger-cars, as will more fully appear by an exposition of the difficulties heretofore experienced in the running of such cars at high velocities, which exposition I think it best to give in this specification, for the purpose of exemplifying the more clearly the object of my said improvement.

"In the construction of all railroads in this country, which extend to any considerable distance, it has been found necessary to admit of lateral curvatures, the radius of which is sometimes but a few hundred feet ; and it becomes important, therefore, so to construct the cars as to enable them to overcome the difficulties presented by such curvatures, and to adapt them for running with the least friction practicable upon all parts of the road. The friction to which I now allude is that which arises from the contact between the flanges of the wheels and the rails, which, when it occurs, causes a great loss of power and a rapid destruction of or injury to both the wheel and the rail, and is otherwise injurious. The high velocities attained by the improvements made in locomotive engines, and which are not only sanctioned, but demanded, by public opinion, render it necessary that certain points of construction and arrangement, both in the roads and wheels, which were not viewed as important at former rates of travelling, should now receive special attention. The greater momentum of the load, and the intensity of the shocks and concussions, which are unavoidable, even under the best constructions, are among those circumstances which must not be neglected, as the liability to accident is thereby not only greatly increased, but the consequences to be apprehended much more serious. The passenger and other cars in general use upon railroads have four wheels, the axles of which are placed from three and a half to five feet apart ; this distance being governed by the nature of the road upon which they run, and other considerations. When the cars are so constructed that the axles retain their parallelism, and are at a considerable distance apart, there is a necessary tendency in the flanges of the wheels to come into contact with the rails, especially on the curvatures of least radius, as the axles then vary more from the direction of the radii. From this consideration, when taken alone, it would appear to be best to place the axles as near to each other as possible, thus causing them to approach more nearly to the direction of the radii of the curves, and the planes of the wheels to conform to the line of the rails. There are, however, other circumstances which must not be overlooked in their constructions. I have already alluded to the increased force of the shocks from obstructions at high velocities ; and, whatever care may be taken, there will be inequalities in the rails and wheels, which, though small, are numerous, and the perpetual operation of which produces effects which cannot be disregarded. The greater the distance between the axles, while the length of the body remains the same, the less is the influence of these shocks or concussions ; and this has led, in many instances, to the placing them in passenger-cars at or near their extreme ends. Now, however, a compromise is most commonly made, between the evils resulting from a considerable separation and a near approach, as, by the modes of construction now in use, one of the advantages must be sacrificed to the other. But it is not to the lateral curvatures and inequalities of the road alone that the foregoing remarks apply. The incessant vibration felt in travelling over railroads is mainly de-

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granted to the plaintiff on the 1st of October, 1834, for an "improvement in the construction of cars or carriages intended to run on railroads."

pendent upon the vertical motion of the cars, in surmounting those numerous though minute obstructions which unavoidably exist. The nearer the axles are placed to each other, the greater is the effect of this motion upon the passengers, and the greater its power to derange the machinery and the road. It becomes very important, therefore, both as regards comfort, safety and economy, to devise a mode of combining the advantages derived from placing the axles at a considerable distance apart, with those of allowing them to be situated near to each other. It has been attempted, and with some success, to correct the tendency of the flanges to come into contact with the rails, on the curved and other parts of the road, by making the tread of the wheel conical; and, if the travelling upon railroads was not required to be very rapid, this would so far prove an effectual corrective, as the two rails would find diameters upon the wheels which would correspond with the difference in length, the constant tendency to deviation being as constantly counteracted by this construction; but, at high velocities, the momentum of the body in motion tends so powerfully to carry it in a right line, as to cause the wheel on the longer rail to ascend considerably above that part of the cone which corresponds therewith; the consequence of this is, a continued serpentine motion, principally, but not entirely, in a lateral direction; nor is this confined to the curved parts of the road, but it exists to an equal, or greater extent, upon those which are straight, especially when the axles are near to each other, the irregularities, before spoken of, constantly changing the direct course of the wheels, whilst there is no general curvature of the rails to counteract it. To avoid this effect, and the unpleasant motion and tendency to derangement consequent upon it, an additional motive is furnished for placing the axles at a considerable distance apart.

"The object of my invention is, among other things, to make such an adjustment or arrangement of the wheels and axles, as shall cause the body of the car or carriage to pursue a more smooth, even, direct and safe course than it does, as cars are ordinarily constructed, both over the curved and straight parts of the road, by the before-mentioned desideratum of combining the advantages of the near and distant coupling of the axles, and other means to be hereinafter described. For this purpose, I construct two bearing-carriages, each with four wheels, which are to sustain the body of the passenger or other car, by placing one of them at or near each end of it, in a way to be presently described. The two wheels on either side of these carriages are to be placed very near to each other; the spaces between their flanges need be no greater than is necessary to prevent their contact with each other. These wheels I connect together by means of a very strong spring—say double the usual strength employed for ordinary cars—the ends of which springs are bolted, or otherwise secured, to the upper side of the boxes which rest on the journals of the axles; the longer leaves of the springs being placed downwards, and surmounted by the shorter leaves. Having thus connected two pairs of wheels together, I unite them into a four-wheel bearing-carriage, by means of their axles and a bolster of the proper length, extending across, between the two pairs of wheels, from the centre of one spring to that of the other, and securely fastened to the tops of them. This bolster must be of sufficient strength to bear a load upon its centre of four or five tons. Upon this first bolster I place another of equal strength, and connect the two together by a centre-pin or bolt passing down through them, and thus allow them to swivel or turn upon each other in the manner of the front

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At the trial, the plaintiff gave in evidence the original patent. It had been recorded anew on the 7th of June,

bolster of a common road wagon. I prefer making these bolsters of wrought or cast iron; wood, however, may be used. I prepare each of the bearing-carriages in precisely the same way. The body of the passenger or other car I make of double the ordinary length of those which run on four wheels, and capable of carrying double their load. This body I place so as to rest its whole weight upon the two upper bolsters of the two beforementioned bearing-carriages or running gear. I sometimes place these bolsters so far within the ends of the body of the car as to bring all the wheels under it, and, in this case, less strength is necessary in the car-body, than when the bolster is situated at its extreme ends. In some cases, however, I place the bolster so far without the body of the car at either end as to allow the latter to hang down between the two sets of wheels or bearing-carriages, and to run, if desired, within a foot of the rails. When this is done, a strong frame-work projects out from either end of the car or carriage-body, and rests upon the upper bolsters of the two bearing-carriages. This last arrangement, by which the body of the car is hung so low down, manifestly affords a great security to the passengers, exempting them, in a great degree, from those accidents to which they are liable when the load is raised. Several bodies may be connected or rest on a common frame, and be supported on the bearing-carriage, in a manner similar to that of a single body. When the bolsters of the bearing-carriages are placed under the extreme ends of the body, the relief from shocks and concussions, and from lateral vibrations, is greater than it is when the bolsters are placed between the middle and the ends of the body, and this relief is not materially varied by increasing or diminishing the length of the body, while the extreme ends of it continue to rest on the bolsters of the bearing-cars, the load being supposed to be equally distributed over the entire length of the body.

"Although I prefer the use of a single spring to a pair of wheels, as above described, instead of the ordinary spring to each wheel, and consider it as more simple, cheap and convenient than any other arrangement, the end which I have in view may, nevertheless, be obtained by constructing the bearing-carriages in any of the modes usually practised, provided that the fore and hind wheels of each of them be placed very near together; because, the closeness of the fore and hind wheels of each bearing-carriage, taken in connection with the use of two bearing-carriages coupled remotely from each other as can conveniently be done for the support of one body, with a view to the objects and on the principles herein set forth, is considered by me as a most important feature of my invention; for, by the contiguity of the fore and hind wheels of each bearing-carriage, while the two bearing-carriages may be at any desirable distance apart, the lateral friction from the rubbing of the flanges against the rails is most effectually avoided, whilst, at the same time, all the advantages attendant upon placing the axles of a four-wheeled car far apart are thus obtained. The bearing of the load on the centre of the bolster, which also is the centre of each bearing-carriage, likewise affords great relief from the shocks occasioned by the percussion of the wheels on protuberant parts of the rails, or other objects, and from the vibrations consequent to the use of coned wheels; as the lateral and vertical movements of the body of the car, resulting from the above causes, are much diminished. The two wheels on either side of one of the bearing-carriages may, from their proximity, be considered as acting like a single wheel; and, as these two bearing-carriages may be placed at any distance from each other, consistent with the required strength of the body of the car, it is evident that all the advantage is obtained which results from having the two axles of a four-wheeled car at a distance from each other, whilst

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1837, under § 1 of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 191,) as appeared by a memorandum to that effect indorsed upon it. No drawings were annexed to the original patent, nor was there any reference in the specification to any drawings. On the 25th of September, 1848, the patent was extended for seven years from the 1st of October, 1848, as appeared by a certificate of extension indorsed on the original patent. The plaintiff then offered in evidence a certified copy from the Patent Office of the patent; of the specification; of the certificate of extension; of a drawing accompanied by written references thereto, which drawing was not filed at the time the patent was recorded anew, but was filed on the 19th of November, 1838; and of an affidavit made by the plaintiff on the 19th of November, 1838, and filed in the Patent Office. The written references accompanying the drawing were in these words: "References to the annexed drawings of Ross Winans' improvement in the construction of cars or carriages intended to run on railroads, for which letters patent were issued, dated October 1st, 1834. Fig. 1. Side view of an eight-wheel car. Fig. 2. End view of the same. Fig. 3. Upper and lower bolsters, detached from the body and bearing-car-

its inconveniences are avoided. Another advantage of this car, compared with those in common use, and which is viewed by me as very important, is the increased safety afforded by it to passengers, not only from the diminished liability to breakage or derangement in the frame-work, but also from the less disastrous consequences to be apprehended from the breaking of a wheel, axle, or other part of the running gear, as the car-body depends, for its support and safety, upon a greater number of wheels and bearing points on the road.

"I do not claim as my invention the running of cars or carriages upon eight wheels, this having been previously done; not, however, in the manner or for the purposes herein described, but merely with a view of distributing the weight carried more evenly upon a rail or other road, and for objects distinct in character from those which I have had in view, as hereinbefore set forth. Nor have the wheels, when thus increased in number, been so arranged and connected with each other, either by design or accident, as to accomplish this purpose.

"What I claim, therefore, as my invention, and for which I ask a patent, is the before-described manner of arranging and connecting the eight wheels, which constitute the two bearing-carriages, with a railroad car, so as to accomplish the end proposed by the means set forth, or by any others which are analogous and dependent upon the same principles."

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riages. A A represents the body of the car resting on the bearing-carriages B and C, as exhibited at D D, on pivots equidistant from the wheels of each bearing-carriage. H represents an upper bolster of cast iron, separate from the body of the car, with its pivot X corresponding with the socket Y in the lower bolster E, also shown as separated from the bearing-carriage." The said affidavit was in these words: "State of Maryland, Baltimore, Oct. : On this 19th day of November, in the year eighteen hundred and thirty-eight, before me, the subscriber, a Justice of the Peace of the said State, in and for the said city, personally appeared Ross Winans, and made solemn oath that he is the inventor of an improvement in the construction of cars or carriages intended to run on railroads, for which letters patent of the United States were granted him, dated the first day of October, 1834, and that the annexed drawing is, as he verily believes, a true delineation of the invention, as described in the said letters patent. Sworn before James Blair, Justice of the Peace." The defendant objected to the evidence offered, on the grounds, first, that it appeared no drawing was annexed to the original patent; second, that the Act of Congress did not make such a drawing as this evidence. The Court overruled the objection and admitted the evidence. It was claimed by the plaintiff that the drawing showed that his car was to be attached to the motive-power, and to the next car in a train, by its body, and not by a perch from the bearing-carriage or truck, it being conceded that this connection by the body was indispensable to the free action of the plaintiff's trucks; and that the drawing also showed a provision in the arrangement of the trucks for side-bearings, to prevent excessive rocking of the car from side to side. It was insisted by the defendants that the specification was defective in saying nothing about the mode of attachment of the car or about the side-bearings; and that the plaintiff could not give any evidence to show in what manner his car, as perfected and used, and the various arrangements of trucks which he tried while experimenting, were connected

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in a train for the purpose of draught, or use the drawing to show anything which was not set forth in the specification. The Court decided that the drawing might be referred to to illustrate the specification, but not to enlarge the claim of the patent, and allowed the plaintiff to give evidence as to what was represented in the drawing in regard to a mode of attachment and to side-bearings, and as to the mode of attachment actually used in the car as perfected and the various modes tried while the plaintiff was experimenting. The evidence was, that the plaintiff was experimenting at Baltimore, Md., to produce an eight-wheeled railroad car, for about four years prior to October, 1834; that the first car made by him, the Columbus, was made in July, 1831; that three others were made, all of them unsatisfactory, prior to the car described in the patent, which was completed and found to be successful but a short time before the date of the patent; that one of the chief defects in the various arrangements of trucks tried during the course of the experiments was, in the cars being coupled together by the trucks and not by the bodies; and that the car, as finally successful, and as shown in the drawing, was drawn by the body. The car Columbus, made in July, 1831, had two trucks, with four wheels in each, but was drawn by a perch from one of the trucks, and the axles of each truck were too far apart from each other, which defects caused the car to run off the track in turning curves.

The defendants set up that one Conduce Gatch, of Baltimore, was the actual inventor of the successful car made in 1834; and that the claim of the plaintiff's patent was void for want of novelty. The various points raised by the defendants in connection with this latter defence, and the nature of the evidence adduced in its support, will sufficiently appear from the instructions prayed for by the defendants, as hereafter set forth.

After the close of the evidence, the defendants requested the Court to charge the jury: (1.) That the mode of attaching the car to the motive-power, or to other cars to be drawn in trains, formed no part of the improvement claimed by

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the plaintiff, and, therefore, could not be taken into consideration in determining whether all or any part of the improvement claimed by the plaintiff was new. The Court refused so to charge, but instructed the jury, that although the mode of attachment formed no part of the improvement claimed by the plaintiff, yet it might be taken into consideration for the purpose of ascertaining whether the plaintiff had complied with the law by describing his invention and showing how it was to be used; that the specification was sufficient if the patentee had described a carriage susceptible of an attachment of the power to the body, if the drawing showed such mode of attachment; that the plaintiff could suffer no disadvantage from not having stated it in his written specification; and that, although the drawing was not to be taken into consideration for the purpose of measuring the extent of the patentee's claim, yet it might be considered in ascertaining whether what he claimed was new, if the jury could discover that it had any bearing on that point. The Court also charged, that the drawing, of which a certified copy had been given in evidence, was to have the same force and effect as if it had been referred to in the specification, and was to be deemed and taken as a part of the specification.

The defendants also requested the Court to charge: (2.) That the remoteness of the two bearing-carriages from each other when attached to the car, was not so expressed or described in the specification as to constitute any part of the improvement claimed by the plaintiff. The Court charged to the contrary of this instruction.

The Court further charged that the improvement claimed by the plaintiff consisted, 1st. Of the manner of arranging the eight wheels into the two trucks which constituted the two bearing-carriages, which arrangement included the bolsters placed on the centre of each bearing-carriage, and the placing the axles of each truck as near together as could be done without the flanges of the wheels interfering with each other. 2d. Of the manner of connecting the two bearing-carriages to the body of the car by a centre-pin or king-bolt

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passing through the centre of the upper bolster, which was attached to the body of the car, into the lower bolster on the bearing-carriage. The Court also charged that the position of the trucks at or near the ends of the car, was to be considered as constituting a part of the arrangement claimed by the plaintiff as his invention.

The defendants also requested the Court to charge: (3.) That if the jury should find that any part of the arrangement of the eight wheels into the two trucks, or the manner of connecting these trucks to the body of the car, was known and used before the alleged improvement by the plaintiff, the patent was void. But the Court refused so to charge.

The defendants also requested the Court to charge: (4.) That if the jury should find that, prior to the alleged invention of the plaintiff, there was published, in any public work, a description of a car to run on railroads, resting on two bearing-carriages composed of four wheels, each having a bolster extending across in the centre between the two wheels, fastened to and forming a part of the carriage, and attached to these bolsters by a centre-pin or bolt passing through the substantial frame of the car in the centre of the bolsters, so as to allow the frame of the carriage to turn and swivel upon the bolsters of the bearing-carriages, the plaintiff's patent was void. (5.) That if the jury should find that any part of the arrangement of the eight wheels into bearing-carriages, or the manner of their connection with the frame or body of the car, was described or delineated in Chapman's patent, or the plates accompanying it, as set forth in the 24th volume of the *Repertory of Arts, &c.*, second series, published in London in 1814, or in Wood's *Treatise on Railroads*, published in London in 1825, at pages 154 to 157, or in the plate between pages 294 and 295 of the latter book, the plaintiff's patent was void. The Court declined to give the instructions specified in the fourth and fifth prayers, in the form therein requested, but left it to the jury to say whether, in their opinion, it had been shown that the alleged invention of the plaintiff

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was substantially described in either of the books mentioned in the fifth prayer, and instructed the jury that, if it was so, the patent was void.

The defendants also requested the Court to charge: (6.) That if the jury should find that it was known to persons acquainted with the science of mechanics and mechanical motion, that a four-wheeled carriage, with its axles in close proximity, would traverse a curve more easily than if they were further apart, then that part of the arrangement described and claimed in the specification was not new, and the patent was void. But the Court refused so to charge.

The defendants also requested the Court to charge: (7.) That if the jury should find that the timber-car found to have been used on the Baltimore and Ohio Railroad before the car Columbus was built, embraced any part of the manner of arranging or connecting the eight wheels to the body of the car, as claimed in the plaintiff's specification, his patent was void, and that it made no difference that said timber-car was only used temporarily or for a temporary purpose. (8.) That if the jury should find that the car Columbus did not substantially embody the whole improvement claimed by the plaintiff, and should also find that the truck of four wheels constructed by Mr. Jervis in the winter of 1832 for the locomotive Experiment, and put in use on the Mohawk and Hudson Railroad in April, 1832, or that the timber-car proved by Mr. Williams and Mr. Whitney to have been constructed and put in use on said road in April or May, 1832, contained any part of the arrangement or connection of the eight wheels to the body of the car claimed in the plaintiff's specification, his patent was void. The Court refused to give the instructions mentioned in the seventh and eighth prayers, in the form therein requested; but, after informing the jury that unless the plaintiff appeared by the evidence to be the first inventor of all that by his patent he claimed as his invention, his patent was void, and after submitting to them the evidence relative to the timber-carriage mentioned in the seventh prayer, and also that respecting the four-wheeled

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truck devised by Mr. Jervis for the locomotive Experiment, and the timber-carriage mentioned in the eighth prayer, the Court left it to the jury to decide whether or not it was shown by this evidence that the plaintiff was not such inventor, and declined to give any other or further instructions in answer to these prayers.

The defendants also requested the Court to charge: (9.) That if the Court should be of opinion that the remoteness of the two bearing-carriages, as described in the plaintiff's specification, constituted a part of the arrangement of the eight wheels into bearing-carriages and the connection to the body of the car, as claimed in the plaintiff's specification, then the patent was void, unless the jury should find that the specification described, with sufficient precision, the proper and necessary location of those bearing-carriages under the body of the car, to enable a mechanic of sufficient skill to construct railroad cars, to locate the bearing-carriages under the car the necessary distance apart, without any experiment, invention or addition of his own. The Court gave the instructions contained in this prayer, and left it to the jury to say whether the plaintiff had not sufficiently indicated the position of the trucks with respect to the ends of the carriage; and remarked that their distance apart must depend on the length of the carriage.

The defendants also requested the Court to charge: (10.) That if the jury should find that a car constructed as described in the plaintiff's specification, without side-bearings at the ends of the bolsters, would not be entirely safe to passengers, the patent was void. In answer to this prayer, the Court instructed the jury that, in order to find for the plaintiff, the jury must be convinced that what the plaintiff had patented was useful, but that any degree of utility was sufficient to support a patent, the word *useful* in the patent law being used in opposition to *frivolous* or *noxious*; and that, with regard to the question of side-bearings, although the jury should think it better to have longer bearings than the plaintiff contemplated, that would not warrant them in finding the

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patent void, if the invention was useful, within the instructions given, as it was not necessary that the thing patented should be the best possible thing of the kind that could be made; and the Court refused to charge the jury otherwise in relation to this prayer.

The defendants also requested the Court to charge: (11.) That if the jury should find that the car Columbus embraced in substance the improvements claimed in the plaintiff's specification, and that said car was put into use by the Baltimore and Ohio Railroad Co., on the 4th of July, 1831, and that it was occasionally used by said Company from that time, by the consent of the plaintiff, then the patent was void. In relation to this prayer, the Court instructed the jury that the law allowed to an inventor a reasonable time to perfect his invention and ascertain its utility, before, in order to secure to himself its exclusive use, it obliged him to take out his patent; that, in applying this rule, it was the duty of the jury to take into consideration the nature of the invention and all the circumstances of the case; but that an inventor was bound to act with sincerity and good faith towards the public, and in accordance with the policy of the patent laws; that if he unnecessarily deferred his application for a patent, and suffered his invention to be used, except for the purposes already mentioned, and beyond what he had reason to believe necessary for those purposes, his patent would be void; and that this instruction was intended to embrace the evidence relating as well to the Winchester, Dromedary and Comet, as to the Columbus mentioned in this prayer. And, in relation to this prayer, the Court refused to give any further or other instruction.

The defendants also requested the Court to charge: (12.) That if the proximity of the axles of the bearing-carriages, and any particular remoteness of those bearing-carriages from each other, formed any valid part of the improvement claimed by the plaintiff, then, unless the jury found that both the proximity of said axles and the remoteness of said bearing-carriages from each other in the defendants' cars, were

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the same as that claimed by the plaintiff to be his improvement, there had been no infringement, and the defendants were entitled to a verdict. The Court instructed the jury, that in order to warrant them in finding the fact of infringement, they must be satisfied, from the evidence, that the defendants had used either the same thing, or substantially the same thing, as the plaintiff's invention; and the Court refused to charge otherwise in relation to this prayer.

The defendants also requested the Court to charge: (13.) That the patent was void on its face, because, 1st. There was not in the specification any sufficiently precise or certain rule for the arrangement and connection of the bearing-carriages with the car, to accomplish the objects of the pretended invention. 2d. The end proposed by the patentee was stated in the specification, but no means of accomplishing it were described, other than the application of known mechanical principles in such manner as would best accomplish that end or object. 3d. The claim was for an improvement to accomplish the "end proposed," by such arrangement and adjustment of things in use as would accomplish that end, but the specification left the rule or particular manner of arrangement and adjustment to be discovered and applied. 4th. The specification left the manner of arrangement and connection of the bearing-carriages or wheels, for the accomplishment of the purpose or end the patentee had in view, as much a matter of accident or experiment as they were before the specification was written. 5th. The patent was for a car to be constructed upon such known mechanical principles and with such mechanical arrangement as might be found necessary to attain the "end," or accomplish the purpose stated in the specification and claimed, without describing what that mechanical arrangement or combination must be. But the Court refused so to charge.

The Court also instructed the jury, that the drawing—a certified copy of which had been given in evidence by the plaintiff—was to have the same force and effect as if it had

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been referred to in the specification, and was to be deemed and taken as a part of the specification. The Court further instructed the jury, that the application of a thing already known to a new and useful purpose, might be the subject of a patent, provided the new use was not analogous to the old, and required the exercise of the inventive faculties.

The jury found a verdict for the plaintiff, and the defendants, upon a case made, now moved for a new trial.

Samuel Stevens, for the defendants.

Joshua A. Spencer and *Samuel Blatchford*, for the plaintiff.

NELSON, J. I. We have examined the various grounds presented by the counsel for the defendants on the motion for a new trial, and, after the fullest consideration, are of opinion that the motion must be denied.

Most of the exceptions taken at the trial, and relied on in the argument here, are founded on what we regard as an entire misapprehension of the thing claimed to have been discovered by the plaintiff and for which the patent has been issued. This will be seen on a reference to the instructions prayed for by the defendants, upon which most of the questions in the case arise. They assume that if any material part of the arrangement and combination in the construction of the cars or carriages described in the patent was before known or in public use, it is invalid; and hence, various parts were pointed out by the counsel at the trial, and the Court was requested to charge, that if either of them was not new, the jury should find a verdict for the defendants.

Now, the answer to all this class of exceptions is, that the patentee sets up no claim to the discovery of the separate parts which enter into his arrangement in the construction of his cars. These may be old and well-known, when taken separately and detached, for aught that concerns his invention. His claim is for the car itself constructed and arrang-

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ed as described in his patent. This, we think, is the clear meaning of the specification, and of the claim as pointed out in it. Proving, therefore, that parts of the arrangement and construction were before known, amounted to nothing. The question was, whether or not cars or carriages for running on railroads, as a whole, substantially like the one described in the patent, had been before known or in public use; not whether certain parts were or were not substantially similar. The argument presupposes that the claim is for the discovery of a new combination and arrangement of certain instruments and materials, by means of which a car is constructed of a given utility; and that, if any one or more of the supposed combinations turns out to be old, the patent is invalid. This is the principle upon which much of the defence has been placed; but no such claim is found in the patent. No particular combination or arrangement is pointed out as new or claimed as such. The novelty of the discovery is placed upon no such ground. On the contrary, the result of the entire arrangement and adjustment of the several parts described, namely, the railroad car complete and fit for use, is the thing pointed out and claimed as new. This is the view taken of the patent by the Chief Justice, in the case of the present plaintiff against the Newcastle and Frenchtown Turnpike and Railroad Company, tried before him in the Maryland Circuit, and which was adopted by the Judge on the trial of this case.

II. It was further insisted, on the part of the defendants, that if the relative position of the two bearing-carriages to each other constituted a material part of the arrangement in the construction of the car, the patent was void, unless the jury should find that the specification described with sufficient precision the location of these bearing-carriages under the body of the car, so as to enable a mechanic of skill in the construction of cars, to place them at the proper distance apart without experiment or invention. It was also contended, that the remoteness of the bearing-carriages from each other was not so described in the specification as

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to constitute any part of the improvement. In respect to this branch of the case, the Court charged that the relative position of the bearing-carriages to each other, in the construction of the car, was a material part of the arrangement of the patentee, and left the question to the jury whether or not he had sufficiently described the position of the trucks, having in view their distance apart and also their distance from the ends of the car-body, suggesting, at the same time, that their location must always depend, in a measure, on the length of the body.

It will be seen, on looking into the specification, that the location of the trucks relatively to each other under the body of the car, as well as the near proximity of the two axles of each truck to each other, form a most essential part of the arrangement of the patentee in the construction of his cars. Great pains are taken to point out the defects in the existing four-wheel cars, and the impediments to be encountered and overcome in the running of cars upon railroads, as the latter are usually constructed. The patentee states that, in the construction of them, especially when of considerable length, it has been found necessary to admit of lateral curvatures, the radius of which is sometimes but a few hundred feet, and that it becomes important, therefore, to so construct the cars as to enable them to overcome the difficulties presented by these curvatures, and to adapt them for running, with the least friction practicable, on all parts of the road. The friction referred to is that which arises between the flanges of the wheels and the rails, causing great loss of power and destruction of the wheels and rails, besides other injuries. For this purpose, he constructs two bearing-carriages, each with four wheels, which are to sustain the body of the passenger or other car, by placing one of them at or near each end of it, as particularly described. The two wheels on either side of the truck are to be placed very near each other—the spaces between the flanges need be no greater than is necessary to prevent their contact with each other. The car-body rests upon bolsters supported on each of the two bearing-car-

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riages or four-wheeled trucks, the bolsters so constructed as to swivel or turn on each other like the two front bolsters of a common wagon. The body of the car may be made of double the length of the four-wheeled car, and is capable of carrying double its load. The truck may be so placed within the ends of the car as to bring all the wheels under it; or, without the end, so as to allow the body to be suspended between the two bearing-carriages. The patentee further states, that the closeness of the fore and hind wheels of each bearing-carriage, taken in connection with the use of the two bearing-carriages arranged as remotely from each other as can conveniently be done for the support of the car-body, with a view to the objects and on the principles before set forth, is considered by him as an important feature of the invention; for, by the contiguity of the fore and hind wheels of each bearing-carriage, while the two bearing-carriages may be at any desirable distance apart, the lateral friction from the rubbing of the flanges against the rails is most effectually avoided, while at the same time all the advantages attendant upon placing the axles of a four-wheeled car far apart are obtained. The two wheels on either side of the bearing-carriages may, from their proximity, be considered as acting like a single wheel; and, as these two bearing-carriages may be placed at any distance from each other, consistent with the required strength of the body of the car, it is apparent that all the advantages are obtained which result from having the two axles of a four-wheeled car at a distance from each other, while its inconveniences are avoided. Among the principles stated by the patentee to be taken into consideration, in the construction of the car is, that the greater the distance between the axles, while the length of the body remains the same, the less the influence of shocks and concussions occurring on the road; and hence the relief from them, when the trucks are placed under the extreme ends of the body, is greater than when they are placed midway between the centre and the ends.

It is apparent, from what we have already referred to in

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the specification, and still more manifest on a perusal of the whole of it, that the improvement in this part of the arrangement does not consist in placing the axles of the two trucks at any precise distance apart, in the construction of the car, or at any precise distance from each end of the body. The distance used must necessarily depend somewhat upon the length of the car and the strength of the materials of which it is built, and hence it was impracticable to specify in feet or inches the exact distance from the ends of the car-body at which it would be best to arrange the trucks. Neither do the advantages of a car constructed and arranged as described, depend upon the trucks being placed at a specified distance from the ends, or so that there may be a specified distance between the axles. Having in view the defects in the existing cars, and other difficulties to be encountered, some considerable latitude may be allowed in this respect, consistent with the object sought to be attained, to remedy the defects in the existing cars. All the principles for the construction of a car for the purpose of overcoming these difficulties and remedying these defects, are particularly set forth in the description given by the patentee. We think the specification sufficient, and that the Court was right in the opinion expressed on this branch of the case. Any mechanic of skill could readily arrange the bearing-carriages in connection with the body of the car, so as to secure the advantages so minutely and clearly pointed out, and which are shown to attend the practical working of cars constructed in the manner described.

III. The questions of originality and of infringement were questions of fact, depending upon the evidence, and were properly submitted to the jury. We think the weight of it decidedly with the verdict.

IV. The patent in this case was originally issued on the 1st of October, 1834, and was recorded anew on the 7th of June, 1837, according to the Act of Congress of the 3d of March, 1837, (5 *U. S. Stat. at Large*, 191.) No drawings were attached to the original patent, nor was there any reference

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therein to drawings. On the 25th of September, 1848, the patent was extended for the term of seven years from the 1st of October, 1848. The plaintiff gave in evidence, at the commencement of the trial, a certified copy of the patent and specification, of the certificate of extension, of a drawing with references to the same, and of an affidavit of the plaintiff, made November 19th, 1838. The drawing was not filed at the time the patent was recorded anew, but was filed on the 19th of November, 1838. The counsel for the defendants objected to the evidence, on the grounds: 1st. That it appeared that no drawing was annexed to the original patent; and, 2d. That the Act of Congress did not make such a drawing evidence. The Court also instructed the jury, in summing up the case, that the drawing, a certified copy of which had been given in evidence, was to have the same force and effect as if it had been referred to in the specification, and was to be deemed and taken as part of the specification.

The 1st section of the Act of 1837 provides that any person interested in a patent issued prior to the 15th of December, 1836, may, without charge, have the same recorded anew, together with the descriptions, specifications of claim and drawings annexed or belonging to the same, and it is made the duty of the Commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed and copied into books of record kept for that purpose; and that, whenever a drawing was not originally annexed to the patent and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require, may be transmitted and placed on file, or copied as aforesaid, together with the certificate of the oath, or such drawings may be made in the office, under the direction of the Commissioner, in conformity with the specification. The 2d section provides, that copies of such record and drawings, certified by the Commissioner, or, in his absence, by his chief clerk, shall be

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prima-facie evidence of the particulars of the invention and of the patent granted therefor in any judicial Court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals. This section also provides, that no patent issued prior to the aforesaid 15th day of December, 1836, shall, after the 1st day of June then next, be received in evidence in any Court on behalf of the patentee, unless it shall have been so recorded anew, and a drawing of the invention, if separate from the patent, verified as aforesaid, shall have been deposited in the Patent Office. (See, also, § 3 of the same Act.)

It is quite clear, from the above provisions of the Act, that the Court was right in admitting the drawing in evidence, in connection with the patent and specification. The whole together are made *prima-facie* evidence of the particulars of the invention and of the patent granted therefor. The weight to be given to the drawings furnished under the Act, by way of enlarging or explaining the description as given in the specification, is another question. That will depend upon the circumstances of each particular case. As a general rule, they will not be effectual to correct any material defect in the specification, unless it should appear that they correspond with drawings which accompanied the original application for the patent; otherwise, in case of discrepancy between the drawings and specification, the latter should prevail. Care must be taken to avoid imposition by the use of the newly-furnished drawings, and, for this purpose, the specification will afford the proper correction, unless the plaintiff goes further and shows that the drawings conform to those originally filed.

The charge that the drawing in this case was to have the same force and effect as if it had been referred to in the specification, and was to be deemed and taken as part of it, was, perhaps, too strong, as it respects the drawings furnished under the Act of 1837. The principle is true as it respects those accompanying the original application for the patent,

but can hardly be said to be applicable, to the full extent stated, in the case of these newly-furnished drawings. The principle might open the way to imposition and fraud. Assuming that there is nothing but the oath of the party attesting that the drawing affords a true delineation of the invention, the specification should prevail, in case of a material discrepancy. But, admitting the instruction in this respect not to be strictly correct, and that too much weight was given to the drawing, we do not see that it would have altered the result. The specification afforded a sufficient description of the invention, independently of the drawing. It was open to some question whether some slight additions that improved the working of the car, were embraced in the specification, but they did not enter into the essence of the invention or constitute any substantial part of the improvement. Time and experience usually indicate these slight additions and alterations, and they should be regarded as consequential results, belonging to the inventor. It requires time and experience usually to perfect the machine, and improvements derived therefrom are justly due to him.

V. We think that the Court was correct in its instructions as to the prior use of the car Columbus and of others constructed by the patentee before he made application for his patent. The law allows the inventor a reasonable time to perfect his invention by experiments; and these could be made, in this instance, only by putting the car into the service of those controlling lines of railroads. There were repeated failures in the experiments tried and in the cars which were abandoned before the perfection of the car described in the patent. These experiments and trials sufficiently account for the previous use set up by way of forfeiture of the invention.

Upon the whole, after a careful examination of the case, and of all the points made by the defendants on the argument, many of which have been noticed above, we are satisfied that the verdict is right, and that a new trial should be denied.

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REUBEN R. FINCH

vs.

CORNELIUS RIKEMAN AND DAVID L. SEYMOUR.

Under § 15 of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 82,) the Courts of the United States have power, on the application of a party to an action, to require the production of books or writings in the possession or power of the adverse party, which contain evidence pertinent to the issue, only in cases and under circumstances in which a Court of Chancery, by the ordinary rules of proceeding in that Court, would compel the production of the same.

The authority conferred by the Act can be exercised, therefore, only in cases where the relief might have been had by a bill of discovery, and as a substitute for that proceeding.

Where, in an action at law for the infringement of a patent, the plaintiff applied to this Court for an order requiring the defendant to produce his books, for the purpose of enabling the plaintiff to establish therefrom the quantity and value of certain machinery made by the defendant, which the declaration charged to have been made in violation of the patent: *Held*, that the application could not be granted, because the direct consequence of the evidence, if obtained, would be to subject the defendant to a penalty under § 14 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) and the plaintiff had not relinquished his claim to the penalty.

A bill of discovery will not be allowed in any case where the discovery will subject the defendant to a penalty, unless the bill relinquishes all claim to the penalty.

(Before NELSON and BETTS, JJ., Southern District of New York, September, 1851.)

THIS was an action on the case, to recover damages for the infringement of Letters Patent for an improvement in railroad cars. The plaintiff set forth, by affidavit, that the action was at issue; that the defendants had made the patented cars in whole and in part, and had sold the same to various persons in different States, and had kept books of account, in which were entered the numbers of cars or parts of cars sold by them; and that the production of those books would show the extent of the damages or loss sustained by the plaintiff, for which the action was brought. On this affidavit, the

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plaintiff moved, that the defendants be ordered to produce, under oath, their books of account; that the plaintiff have leave to take copies of such parts thereof as related to the matters stated in his affidavit; and that, on the failure of the defendants to produce their books, final judgment be rendered against them in the action. The defendants, by affidavit, denied the infringement complained of, and set forth that they were iron-founders and machinists by trade, and kept only one set of books, in which were entered all charges for goods sold and work done in their line of business, and that they kept no separate entry or account of any particular jobs of work or articles sold.

BETTS, J. The provisions of the Act of Congress under which this motion is made are, that the Courts of the United States shall have power, in the trial of actions at law, on motion and due notice thereof being given, to require the parties to produce books or writings in their possession or power, which contain evidence pertinent to the issue, in cases and under circumstances where they might be compelled to produce the same by the ordinary rules of proceedings in Chancery. (*Act of September 24th, 1789, 1 U. S. Stat. at Large, 82, § 15.*) It is plain, from the language of this statute, that Congress did not intend to vest in parties litigant an unrestricted right to all written evidence in the possession of an adverse party, which might be pertinent to an issue in a trial at law; the qualification being explicit, that the right is allowable only in cases and under circumstances in which the Court of Chancery, by the ordinary rules of proceeding in that Court, would compel the production of books and documents.

We find no decision of the Courts of the United States upon the effect of this qualifying clause in the statute. The practice in this Court, so far as it has come to our knowledge, has been uniform, to regard the summary authority given by this statute as one to be exercised only in cases where the relief might have been had by a bill of discovery, and as a

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substitute for that proceeding. This Act of Congress was probably the earliest regulation of the subject, within the United States, by positive law. The substance of its provisions has since been adopted in most of the States, either by express legislative enactments or by rules of Court authorized by existing laws or usages. The English practice, however, obtained in some of the States long after the passage of this Act, and the party claiming to use the contents of papers in the hands of his adversary, was obliged to resort to a notice to produce them, and, on non-compliance, to secondary evidence of their contents; or, under particular circumstances, he might have an order of the Court compelling their production. (1 *Tidd's Pr.*, 639; 1 *Greenl. Ev.*, §§ 559, 560.) But the practice in England and in the State Courts did not enable one party to bring from the possession of the other party, as a matter of course, documents to be used on a trial, nor to compel the latter to disclose whether they were in his hands or under his control. The relief proposed to suitors by that practice was, however, more especially defective in affording no summary sanction to an order to produce papers, which should apply to and affect the cause itself. The Act of Congress remedies this deficiency, by authorizing a final judgment or a judgment of non-suit, as the case may require, so that the rights of the party in the suit are made dependent on his compliance with the order against him to produce the books or papers. These are stringent conditions, and require from Courts a careful consideration of the provisions of the Act, before enforcing them. The plain limitation to the right to the interposition of this Court by giving final judgment, is, that the application by a party for the production of papers be one which a Court of Equity would sustain on a bill of discovery. The right, in our opinion, rests entirely on that condition.

This motion demands the production of the defendants' books, to establish the quantity and value of the manufactures of machinery made by the defendants, which manufacture is charged in the declaration to be an infringement of

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the plaintiff's patent. The effect of the evidence sought for will be not only to enable the plaintiff to recover his entire damages, but its direct consequence will be to subject the defendants to a penalty of three times the amount of those damages, under § 14 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123.) We think it against the rules of Equity, to allow a bill of discovery in such a case, unless the bill relinquishes all claim to the penalty which may be superinduced by the production and exhibition of the books, and, for that cause, the motion must be denied. (2 *Story's Eq. Juris.*, § 1494; *Story's Eq. Pl.*, § 575, and notes; 2 *Daniel's Ch. Pr.*, 625, 821.)

HENRY COGGILL AND OTHERS *vs.* CORNELIUS W. LAWRENCE.

In suits at common law, in the Circuit Courts of the United States, neither party can recover costs upon any equity in the case, nor do those Courts possess authority to award them as an incident of their power over the parties or the subject-matter in litigation. They are purely a subject of legislative appointment.

Where an action was commenced in a State Court against a collector, to recover back an excess of duties paid on the importation of foreign merchandise, and the action was removed into this Court by the defendant, under § 3 of the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 633,) and the plaintiff obtained a verdict for \$9 50: *Held*, that the plaintiff was not entitled to any costs.

It was the intention of Congress that the description of revenue cases mentioned in § 3 of said Act, should, when removed into this Court, after being commenced in a State Court, be proceeded in, in all particulars, as cases originally commenced in this Court.

Such removal does not bring with it the State law as to costs, and, therefore in cases of that kind, the costs in this Court are regulated by § 20 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 83,) which allows no costs to a plaintiff when he recovers less than \$500, and provides that he may, in such case, be adjudged to pay costs, at the discretion of the Court.

Where, in a cause removed into this Court under § 3 of said Act of 1833, the plaintiff obtained a verdict for \$9 50: *Held*, that the case was not a proper one for the allowance of costs to the defendant.

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Semble, that cases removed into this Court from a State Court, under § 12 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) do not bring with them the State law of costs, but are subject to the provisions, as to costs, of § 20 of the same Act.

(Before NELSON and BETTS, JJ., Southern District of New York, September, 1851.)

THIS was an action originally brought in the Superior Court of the city of New York, against the defendant, as Collector of the port of New York, to recover the sum of \$150, as so much duty charged and received by the defendant on the importation and entry of foreign merchandise by the plaintiffs, above the amount collectable by law. Under the provisions of the 3d section of the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 633,) the defendant removed the cause into this Court, and, on a trial before a jury, the plaintiffs obtained a verdict for \$9 50. The plaintiffs now moved that full costs of suit, according to the rate of costs in this Court, be awarded to them; and the defendant made a counter application that full costs be adjudged to him.

BETTS, J. In common law cases in this Court, neither party can recover costs upon any equity in the case, nor does the Court possess authority to award them as an incident of its power over the parties or the subject-matter in litigation. They are purely a subject of legislative appointment. *Kneass v. The Schuylkill Bank*, 4 *Wash. C. C. R.* 106.) In that case, Judge Washington held that there was no distinction between cases over which a Circuit Court of the United States had jurisdiction because of the amount in controversy, and those over which it had jurisdiction because of the subject-matter; and, accordingly, he denied costs to the plaintiff in a patent cause where the recovery was less than \$500. The Patent Acts of April 10th, 1790, and February 21st, 1793, (1 *U. S. Stat. at Large*, 109 and 318,) did not grant costs to plaintiffs in patent suits, and, accordingly, costs in those suits were recoverable only by virtue of the provisions of the 20th section of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat.*

at Large, 83.) This construction seems to have been acquiesced in by Congress, as it has since regulated costs in patent cases by express enactment. (*Act of July 4th*, 1836, 5 *U. S. Stat. at Large*, 123, § 14.) It has also made express provision in regard to costs in suits brought by the United States for penalties, without respect to the amount demanded or recovered. (*Act of May 8th*, 1792, 1 *U. S. Stat. at Large*, 277, § 5.)

The Act of Congress of March 2d, 1833, (4 *U. S. Stat. at Large*, 633, § 3,) under which this cause is removed into this Court, makes no provision respecting costs to plaintiffs, but, in a certain contingency, gives them to defendants. It moreover expressly declares, that a cause removed from a State Court by virtue of the Act, and entered on the docket of the Circuit Court, shall *be thereafter proceeded in as a cause originally commenced in that Court*. (*Id.* § 3.) We are of opinion that the plaintiffs cannot recover costs in this case, although it was originally commenced in a State Court; because costs are not given by the Act authorizing the removal of the cause, nor are they given, upon a verdict of like amount, by any other Act of Congress, and because it seems to have been the purpose of Congress to place all actions against revenue officers, for acts done in relation to the collection of imposts and duties, upon the footing of causes originally commenced in a Circuit Court. In such cases, no costs are allowed to the plaintiff, if he recovers less than \$500, but he may be adjudged to pay costs, at the discretion of the Court.

So, also, if the doctrine of Judge Story in *Ellis v. Jarvis*, (3 *Mason*, 457,) in relation to causes removed from a State Court into a Circuit Court of the United States under the 12th section of the Judiciary Act of 1789, applies to causes removed by virtue of the Act of 1833, and they are to be held to carry with them the law of costs of the Court in which they are instituted, the plaintiffs must be denied costs in this case, because the recovery, being under fifty dollars, would not carry costs in the State Court where the action was commenced. (*Laws of New York of 1849, chap. 438, § 304.*)

The rule adopted by Judge Story is eminently equitable, but it is not clear to our minds that the quality attached by the 12th section of the Judiciary Act of September 24th, 1789, to the cases provided for by it, that *the cause shall there proceed in the same manner as if it had been brought there by original process*, does not bring them under the general law of costs established by the 20th section of the same Act.

The variance of phraseology employed in the 3d section of the Act of 1833, in our opinion, makes the intention of Congress clear, that this description of revenue cases commenced in a State Court must, after being brought into this Court, be proceeded in, in all particulars, as cases originally commenced here, and will thus necessarily be subject to the restrictions as well as partake of the privileges applicable to original actions in this Court.

The defendant in the present case would, by the State law, have been entitled to costs on the present recovery, had the case remained in the State Court. Section 305 of the State Act before cited provides, that "costs shall be allowed of course to the defendant in the actions mentioned in the last section," (which includes actions for the recovery of money,) "unless the plaintiff be entitled to costs therein." If, as before suggested, the removal of the cause does not bring with it the State law of costs, there is manifest reason against allowing the defendant to impose the costs of a jurisdiction into which he forces an unwilling plaintiff, without the object of correcting an erroneous judgment against him, and, unless controlled by a positive law on the subject, this Court would, upon the equity of the case, refuse him costs against such plaintiff. The 20th section of the Judiciary Act leaves this matter to the discretion of the Court, and, under the circumstances, we think that costs should be denied to the defendant.

There must be a judgment for the plaintiff for \$9 50, without costs to either party.

Tyler v. Hyde.

PHILoS B. TYLER AND WILLIAM S. PENDLETON

vs.

EDWARD F. HYDE AND OTHERS.

Where T., a patentee, and P., his assignee of an undivided interest in the patent, brought a suit in Equity in the Circuit Court of the United States in Louisiana, under § 16 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) against D., the patentee of a junior patent, and other parties claiming under him, founded on the interference of D.'s patent with T.'s patent, and praying that D.'s patent might be declared void, and subsequently T. and P. brought an action at law in this Court for the infringement of T.'s patent, against H., who was not a party to the suit in Louisiana, but who owned an undivided interest in D.'s patent, by title derived from D. after the commencement of the suit in Louisiana, although prior to the rendition of any judgment in that suit: *Held*, that the parties to the suit in this Court were virtually within the proviso to said § 16, and that their rights would be bound by a decision in the suit in Louisiana pronouncing judgment that the two patents interfered or that either of the patents or any part of them was valid or invalid.

But, where H. pleaded in bar the bringing of the suit in Louisiana and the dismissal of the bill therein by the judgment of the Court upon the merits thereof: *Held*, that that judgment did not necessarily import that the patents of T. and D. interfered or that T.'s patent was adjudged void and inoperative.

In order to be received and acted upon in this Court, as against T.'s patent, and in a trial between other parties, the judgment should have been direct and affirmative in terms, and should have asserted the interference of the patents, and have declared T.'s patent void in the whole or in part, or inoperative and invalid in some particular part of the United States.

Such a judgment would, under the decision in *Smith v. Kernochen*, (7 *How.* 198, have been a bar to the action at law in this Court.

(Before NELSON and BETTS, JJ., Southern District of New York, October, 1851.)

THIS case came up on a demurrer to a plea *puis darrein continuance*. The action was brought for the infringement of Letters Patent. The original patent was granted to the plaintiff Tyler, on the 16th of January, 1845, for an "improvement in cotton-presses." That patent was surrendered by the patentee on account of a defect in the specification, and a new patent was granted to him, on a corrected specifi-

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cation, on the 1st of May, 1847. On the 22d of February, 1848, the patentee assigned an equal undivided half of the patent to the plaintiff Pendleton. The plea averred that Letters Patent were granted to one Augustus Devall, on the 17th of April, 1847, for an "improvement in cotton-presses;" that the present plaintiffs, on the 31st of March, 1848, commenced a suit in Equity, by bill, in the Circuit Court of the United States for the Eastern District of Louisiana, against the said Devall and three others, setting forth the patent to Tyler, and its re-issue, and the right of the plaintiffs under it, and the patent to Devall, and charging that the defendants had made and put into use, in New Orleans, a cotton-press constructed in conformity to the specification and drawings of Devall's patent, and that that press was a tame imitation of the cotton-press described in Tyler's patent, involved the same principles of action and the same combination of mechanical powers, and operated, to every material extent, in the same way as Tyler's press, and was a palpable infringement of the same, and further charging that the press, as constructed and put in use by the defendants and as patented to Devall, was, in its principles of construction, identical with the invention of Tyler, and that no patent therefor should have been granted to Devall, and that the same ought to be repealed, and praying that the defendants be ordered to account to the plaintiffs for the use and profits of the cotton-press, and that the Court should decree that the patent granted to Devall be cancelled and annulled, avoided and set aside, as improperly and inconsiderately awarded, and for such other and further relief as to justice and equity might seem meet; that Devall put in his answer to that bill, denying the novelty and originality of the invention of Tyler, and averring that his patent was null and void, and that its re-issue was obtained with an intent to defraud Devall, and that the re-issued patent to Tyler was not for the same invention as the original patent, and that the improvement patented to Devall was original, and was entirely distinct from that patented to Tyler, and was not in any part embraced in it, and that cotton-presses

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built in accordance with Devall's patent were no infringement upon Tyler's patent, even if the same were valid ; that the patent to Tyler, on which this action was founded, was the identical patent described in the bill of complaint in the Louisiana Circuit Court ; that, on the 1st of June, 1849, Devall assigned two-thirds of his patent, and the said interest became on that day vested in the defendant Hyde, at whose instance and request, and as whose agents, the other defendants (who composed the firm of Stillman, Allen & Co.) made all the cotton-presses complained of in this action as infringements, and which were all made in exact conformity with the cotton-press described in Devall's patent ; and that, on the 14th of June, 1850, the bill in the Louisiana Circuit Court was, by the consideration and judgment of the Court and upon the merits thereof, dismissed, with costs to Devall, the suit as against the other defendants having been previously settled.

To this plea the plaintiffs demurred, and alleged, for causes of demurrer, that the suit in Louisiana was not between the parties to this suit, nor between their privies in law or in estate, and that it did not appear by the plea, on which of the several distinct defences set up in the Equity suit, the bill in that suit was dismissed. The defendants joined in demurrer.

Edwin W. Stoughton, for the plaintiffs.

George R. J. Bowdoin, for the defendants.

BETTS, J. The bill filed by the plaintiffs in the Circuit Court in Louisiana was founded upon the 16th section of the Patent Act of 1836, (5 *U. S. Stat. at Large*, 123,) and its scope and aim were to obtain the benefit of the extraordinary powers granted by that Act to Circuit Courts. The section is as follows : " Whenever there shall be *two interfering patents*, or whenever a patent, on application, shall have been refused on an adverse decision of a Board of Examiners,

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on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have *remedy by bill in Equity*; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may *adjudge* and *declare* either the *patents void* in the whole or in part, or *inoperative* and *invalid* in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the invention patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this Act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall, in any such case, be made to appear;" *Provided, however,* that no such judgment or adjudication shall affect the rights of any person, except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment."

It is plain, from the bill referred to, that the plaintiffs claimed their equity to be the interference of Devall's junior patent with their prior one, and the relief they sought was to have the posterior patent declared void. The Court had jurisdiction of the subject-matter in Equity for no other purpose, for, although the bill prayed an account of the profits received by Devall and his co-defendants for the use and manufacture of cotton-presses, and that such profits should be decreed to the plaintiffs for their damages, yet, manifestly, that prayer was but incidental to the one demanding judgment of nullity against Devall's patent as one interfering with Tyler's. The account is not required in aid of a suit at law, nor is an injunction prayed for; and, if it be competent to a party, by original bill in Equity, to recover damages for the violation of a patent right, the bill is clearly not framed to that end, and contains nothing denoting such intent, other than the commonplace formula of a prayer "for

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such other and further relief as to justice and equity may seem meet." This Court cannot intend that, under the bill presented to the Circuit Court in Louisiana, any other question was tried than the one designated by the statute—that is, which, if either, of the patents was *void, in the whole or in part, or inoperative and invalid* in any particular part or portion of the United States. Those particulars were placed within the cognizance of the Court by the statute, and upon those the Act authorized the Court to adjudge and decree.

We consider the parties in this action to be virtually within the proviso to the 16th section of the Act of 1836, (the defendants having become assignees of and privies with the defendant in the suit in Louisiana, *pendente lite*,) and that their rights would be bound by the decision in that suit, had that Court pronounced judgment that the two patents interfered, and upon the validity or invalidity of either of the patents or of any part of them.

In support of the plea of *puis darrein continuance* it is argued, that the Court must presume that the judgment of the Court in Louisiana was adverse to the validity of Tyler's patent, because that question was involved in the issues raised in the cause, and that the judgment of the Court upon all the issues was, in effect, that the plaintiffs had no valid title to the invention claimed by them. This conclusion is, however, one of hypothesis and argument. It is not announced by the Court, in rendering its judgment, nor, in our opinion, does that judgment exclude any other conclusion. The decree of the Court upon the merits was, that the bill of complaint be dismissed with costs. This does not necessarily import that the patents interfered, or that Tyler's patent was adjudged *void and inoperative*. The plaintiffs in that suit may have failed to prove that the defendants violated their right, which would have been the case if Devall's machine was essentially different from theirs in construction and operation; or the plaintiffs may have parted with their title, or executed grants or licenses under which the defendants were protected. The plea supplies this Court with no means of

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determining upon what description or character of merits, as between those parties, the decree dismissing the bill was founded; and, if any failure of evidence on the part of the plaintiffs, or any testimony on the part of the defendants within the issues, might have produced the result and justified the decree, this Court cannot assume that the interference of the two patents, rather than any other one of such particulars, was the ground of the decision.

But, independently of the want of record proof that the Circuit Court in Louisiana heard and decided the case before it solely upon the question as to the interference of the two patents, and as to which was the valid one, we think that a judgment or decree cannot be accepted as determining that point, unless it be direct and affirmative in terms, and in the words of the statute. The Court must adjudge and declare the patent *void*, in the whole or in part, or inoperative and invalid in some particular part of the United States. A decree dismissing a bill seeking that relief does not imply such positive judgment, but, on the contrary, it indicates that the Court, on the proofs before it, was unable to render that specific judgment. At all events, it cannot, in our opinion, be received and acted upon in another Court, and in a trial between other parties, as amounting to the positive and affirmative declaration demanded by the statute. Had the decree of the Circuit Court asserted the interference of the patents and declared Tyler's patent void, that decree would have been conclusive in this Court, on a trial at law. (*Smith v. Kernochen*, 7 How. 198.) The utmost effect that can properly be given to the decree dismissing the bill is, to consider the Court as having determined that, upon the proofs adduced at the hearing, the plaintiffs had not supported, to the satisfaction of the Court, the matters of complaint set forth in the bill. This is far short of the distinct adjudication which, in *Smith v. Kernochen*, the Supreme Court held to be a bar, in a different Circuit, to a trial at law of the same subject-matter.

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Judgment must be rendered, on the demurrer, for the plaintiffs, with leave to the defendants to plead over, on the usual terms of payment of costs.

JEREMIAH WILBUR AND OTHERS vs. CORNELIUS W. LAWRENCE.

Where wool, the growth and production of Buenos Ayres, was purchased there for exportation to New York, but, on account of the blockade of Buenos Ayres, was transported in lighters to Montevideo and shipped thence to New York: *Held* that, under § 16 of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) the costs and charges of such transportation from Buenos Ayres to Montevideo could not be added as a part of the dutiable value of the wool.

The case of *Grinnell v. Lawrence*, (1 *Blatch. C. C. R.* 346,) cited, approved and applied.

(Before NELSON and BETTS, JJ., Southern District of New York, October, 1851.)

THIS was an action to recover back duties paid to the defendant as collector of the port of New York. The facts were these: The plaintiffs entered at the Custom-House, on the 17th of May, 1848, a quantity of unwashed wool, imported by them from Buenos Ayres to New York. The wool was the growth and production of Buenos Ayres, and was purchased there for exportation to New York, but, on account of the blockade of Buenos Ayres, was transported in lighters to Montevideo and shipped from that place to New York. The value of the wool at Buenos Ayres, together with the costs and charges appraised and ascertained at the Custom-House, with the addition of the usual commissions, was \$4,787. Upon this a duty of 30 *per cent.*, amounting to \$1,436 10, was paid by the plaintiffs on the entry of the wool. The charges for the transportation of the wool from Buenos Ayres to Montevideo, together with 2½ *per cent.* commission, amounted to \$1,281 25. Upon this, also, the defendant exacted a duty of 30 *per cent.*, amounting to \$384 30, which sum the plaintiffs paid under protest. They then brought this action to recover it back. A verdict was taken

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for the plaintiffs, subject to the opinion of the Court, and also subject to adjustment at the Custom-House in conformity to the decision of the Court.

George C. Goddard, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. It is contended for the defendant, that the costs and charges attending the transportation of the wool from Buenos Ayres to Montevideo, are the expenses of shipment incurred subsequent to its purchase, and are to be added to the purchase-price, to make up its market value in the country from which it was imported.

The meaning and effect of the 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) as applicable to a similar state of facts, was considered and decided by this Court in the case of *Grinnell v. Lawrence*, (1 *Blatch. C. C. R.* 346.) In that case, the goods were the production of China, and were there purchased and shipped to London, and then re-shipped to the United States. In appraising the value of the goods, the appraisers added the costs of transportation from Canton to London. The Court decided that, upon the true construction of the 16th section of the Act and of the proviso to that section, the market value of the goods, at the time of their exportation to the United States, in the principal markets of the place of production, with costs and charges to the time of shipment, was the dutiable value, and that the freight and expenses of their transportation from Canton to London could not be added. In that case, the goods were procured in the London market for shipment to the United States, and were not, as in this instance, on a continuous course of transmission from the place of production, nor were they purchased and invoiced at the latter place for this market. In these features there was more colorable ground for computing the expenses of transportation to London as part of the dutiable value, than there is in this case, where the purchase of the wool was made at Buenos Ayres

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by the plaintiffs, and its transmission direct to the United States was commenced at that port. The employment of a vessel at Montevideo to carry the cargo, because of the inability to send one from Buenos Ayres, or for any other cause, did not interrupt the continuity of the voyage. This very point has been before the Court in former cases, in which it was ruled, *at nisi prius*, that the charges of such transportation of the cargo could not be estimated in appraising the market value of the goods, and that the amount of costs and charges was limited to what had accrued at the time the goods left Buenos Ayres. The decision of the Court that those cases were embraced within the principle of *Grinnell v. Lawrence* was not excepted to, and the judgments rendered in those cases, on that construction of the law, were acquiesced in and satisfied by the Government.

Judgment must be rendered in this case for the plaintiffs, with a reference to the collector to adjust the true amount of duties payable by the plaintiffs upon the principles of this decision.

WILLIAM S. WILSON AND FRANCIS BROWN vs. HUGH MAXWELL.

The Tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 42,) did not vary the law previously in force regulating the method of ascertaining the quantity of merchandise imported. Such quantity is still to be ascertained by the rules prescribed in §§ 58 and 59 of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 671, 672.)

Accordingly, where soap in boxes was imported in 1850: *Held*, that the dutiable weight was the gross weight of the soap and boxes, deducting only 10 *per cent.* as tare, as prescribed by § 58 of the Act of March 2d, 1799, and that the importer was not entitled to an allowance of the actual weight of the boxes as tare.

But, the soap having been entered at the Custom-House at a valuation based upon its net weight, after deducting the actual weight of the boxes, and the Custom-House valuation, upon an allowance of only 10 *per cent.* on the gross weight as tare, having exceeded the invoice valuation by more than 10 *per cent.*, and the collector having then imposed an additional duty or penalty of 20 *per*

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cent. upon the Custom-House valuation, claiming that such penalty was authorized, in consequence of such excessive valuation, by § 8 of the Act of July 20th, 1846, (9 *U. S. Stat. at Large*, 43): *Held*, that the penalty was illegally imposed.

The weight of the boxes, cases or packages in which goods are imported is not the subject of *appraisement*, within the meaning of § 8 of the Act of July 20th, 1846.

The case of *Grinnell v. Lawrence*, (1 *Blatch. C. C. R.* 346,) cited and applied.

(Before NELSON and BETTS, JJ., Southern District of New York, October, 1851.)

THIS was an action to recover back money paid to the defendant as collector of the port of New York. The facts were these: The plaintiffs imported from Marseilles into New York a quantity of castile soap in boxes, and entered it at the Custom-House, in July, 1850, at the invoice weight of 11,749 pounds, and at the net weight, deducting the weight of the boxes as tare, of 9,436 pounds. The weight returned by the public weigher was 11,760 pounds, from which a deduction of 10 *per cent.*, or 1,176 pounds, was made for tare, leaving the net or dutiable weight at 10,584 pounds. The valuation of the importation on the entry, according to the net weight on the invoice, was \$550. The valuation on the return of the weigher, after taking off the 10 *per cent.* tare, was \$619 94, being an excess over the invoice valuation of \$69 94, or more than 10 *per cent.* The price or value of the soap itself was not changed by the Custom-House valuation. The plaintiffs claimed the right to enter the soap at its net weight of 9,436 pounds, deducting the actual weight of the boxes, but the collector imposed duties on 10,584 pounds, allowing only the 10 *per cent.* tare. He also imposed an additional duty or penalty of 20 *per cent.* upon the Custom-House valuation of \$619 94, because that exceeded the invoice valuation by more than 10 *per cent.* The plaintiffs paid, under protest, this additional duty or penalty, and also the duty on all beyond 9,436 pounds of soap, and then brought this action to recover back the amount so paid. A verdict was taken for the plaintiffs, subject to the opinion of the Court.

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John S. McCulloh, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. We think that the collector adopted the true interpretation of the law, in relation to the tare allowable. When duties are imposed on merchandise by the weight or measure, the importer is not required to pay for a greater quantity than actually arrives in the United States. (*United States v. Southmayd*, 9 How. 637; *Marriott v. Brune*, *Id.* 619.) But it lies with Congress to prescribe the rules by which the quantity or value of merchandise imported shall be ascertained. Accordingly, it rests in its discretion to fix the particulars to be regarded in determining the quantity by weight of goods imported in boxes, casks, bags or other packages, and to exclude or include the boxes, &c., in the computation. If no regulation in that respect is adopted, the true principle is to consider the merchandise alone as subject to duty. (*Marriott v. Brune*, 9 How. 619.)

It is contended that the Treasury Circulars of March 24th, 1847, and January 5th, 1848, give the importer a right to the deduction of the actual tare on the importation of articles invoiced and entered by weight. We do not think that those Circulars admit of such an interpretation. It would seem that the Secretary of the Treasury understood that the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 42,) in its arrangement of the method of imposing duties, had in effect supplanted the provisions of the 58th section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 671,) and he enjoined regulations to meet the case of importations of goods by weight in boxes, casks, &c. The regulations, however, expressly prohibit the allowance, by way of tare or draft, of a greater deduction than was given by the Act of 1799; and, if the plaintiffs adopt the Treasury Circulars as the foundation of their right to tare, they must be confined to the limits of those instructions.

But we do not understand that the Tariff Act of 1846 has

in any manner varied the law previously in force regulating the method of ascertaining the quantity of merchandise imported. The 4th section of the Act of 1846 recognizes the existence of the 58th and 59th sections of the Act of 1799 as the means of determining the weight or guage or quantity of goods imported, when the invoice does not contain the weight or quantity or measure. We do not suppose that this 4th section has operation only in case of an *entire omission*, in the invoice, of any statement of weight or measure, but are inclined to think that the provision is intended to apply the then existing law to importations which would have been subject to it previous to the Act of 1846, although the invoice is made up on a valuation only, without any statement of quantity. Otherwise the Government might be concluded by the invoice, in case it gave the weight or quantity, and would have discarded all authority to test the accuracy of that statement. We think that the language of the 4th section of the Act of 1846 may be satisfied, without attaching to it an implication evidently so directly at variance with the whole policy of the revenue laws. The language is rather indirect and involved, but the want of perspicuity seems to arise out of the aim of the person who drew the section to conform the system of *ad valorem* duties, made universal by the Act of 1846, to the provisions of the then existing laws, which require the weight or measure of particular classes of merchandise; and, under the impression that importations of such articles may, under the new Act, be made on an invoice of value alone, it directs the weight or measure of them to be made at the expense of the owner, agent or consignee. The section appears to have been introduced out of greater caution, and for the purpose of avoiding the construction contended for by the counsel for the plaintiffs, and which the Circulars of the Treasury Department tend to countenance. The revenue laws, as modified from time to time by Congress, are construed and administered as an entire system, the later Acts not superseding the prior ones, unless they are in conflict with them or expressly re-

peal them. (*Aldridge v. Williams*, 3 How. 1.) The 7th and 8th sections of the Act of 1846 recognize this principle, in the one case modifying the existing tariff law, and in the other referring to it as supplying the mode of ascertaining the dutiable value of imported commodities. The 4th section, in our view of the subject, effects two purposes only, both of them in consonance with and in furtherance of the existing law. *First*—In respect to goods subject to weight, it removes all doubt as to the application of the Act of 1799, under this new arrangement of duties, when the invoice does not contain the weight, by directing the goods to be weighed. *Secondly*—It provides that the owner or consignee shall bear the expense. When the invoice does contain a statement of weight, it must, under the directions of the 8th section of the Act of 1846, be proceeded with conformably to the Act of 1799.

The weight returned by the weighers in this case, pursuant to the 58th section of the Act of 1799, determined the quantity of soap subject to duty, and the collector properly imposed and collected duties on 10,584 pounds, because, although that was beyond the actual weight of the soap itself, yet the whole importation, including its boxes, is made subject to duty, excepting only 10 *per cent.* therefrom for the assumed weight of the boxes. It was in the discretion of Congress either to impose duties on the gross weight, or to deduct from that a fixed rate of tare, or to permit the importer to have the allowance of actual tare. The law in this instance specified the mode or rule by which the tare should be determined, and the importer can claim nothing beyond that.

The remaining question is, whether the collector could legally impose an additional duty or penalty of 20 *per cent.* on the appraised valuation of \$619 94, the price or value of the soap itself not being changed. The 8th section of the Act of July 30th, 1846, declares, that it shall be the duty of the collector to cause the dutiable value of imports to be appraised, estimated and ascertained, in accordance with the provisions of the then existing laws, and that, if the appraised

value thereof shall exceed, by 10 *per centum* or more, the value declared on the entry, then, in addition to the duties imposed by law on the same, there shall be levied, collected and paid, a duty of 20 *per centum ad valorem* on such appraised value. It is to be observed, that the valuation adopted in the entry was not changed by the appraisers, so as to affect the justness of the entry valuation. No point is made on the part of the Government, that the weight given in the entry was not accurate, and it was found to correspond with the Custom-House weight within a small fraction. The only question presented is as to the right of the plaintiffs to enter the importation according to the true weight, without obtaining the consent of the collector and naval officer to the allowance of the actual tare. Does the deficiency in weight in the entry, arising from an erroneous claim of tare, constitute an excess of value over the value declared in the entry, so as to subject the whole importation to an additional duty of 20 *per cent.*? The principle involved in this inquiry was considered and decided by this Court in *Grinnell v. Lawrence*, (1 *Blatch. C. C. R.*, 346.) The Court there say: "The eighth section of the Act of July 30th, 1836, imposes this duty" (the additional duty or penalty of 20 *per cent.*) "in cases where the *appraised value* of the goods imported shall exceed, by 10 *per cent.* or more, the value as declared in the entry." The "*appraised value*," as used in this Act of 1846 and in that of August 30th, 1842, and, indeed, in all of the revenue Acts, means the value of the goods, to be estimated and ascertained by the appraisers, either according to the "actual cost," "actual value" or "market value," as the case may be, exclusive of charges. The doctrine adopted by the Court in that case was, that the enhanced valuation which called for and authorized the additional duty of 20 *per cent.* had relation alone to the *goods* imported, and did not include those extraneous particulars which the appraisers added to the appraised value of the merchandise, under the special direction of the various tariff Acts, in order to make up the dutiable value of the importation. In that case, *charges* were so

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added ; in this case, *the weight of cases or packages* is added ; but neither of them are subjects of *appraisement*. So far from that, in this instance, the "actual cost," "actual value" or "market value" of the boxes is not a matter upon which the judgment of the appraisers is in any way exercised. On the contrary, the gross weight of the importation is ascertained by the weigher, and then the proper officer of the Custom-House, by an arithmetical process prescribed by statute, fixes the deduction to be taken from the gross weight, and the remainder is the dutiable quantity.

Our judgment upon the second point, therefore, is, that this importation was not subject to the additional duty of 20 *per cent.* exacted by the collector, and that the plaintiffs are entitled to recover that amount, with interest from the time of its payment.

Judgment accordingly.

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Where the officers and crew of a vessel of war belonging to the United States Government rendered, under the direction of her commander, and in obedience to the general instructions of the Government to all its vessels to render relief freely and promptly to American vessels in distress, services in towing into an American port an American merchant-vessel found abandoned at sea five hundred miles distant, but the delay thus caused was one of only two days, and no extraordinary service was rendered, and no unusual hardship or peril was encountered : *Held*, that the officers and crew were not entitled to salvage.

Whether the officers and crews of the naval vessels of the United States are in any case entitled to salvage for services rendered to American merchant-vessels in distress, notwithstanding such instructions, *quere.*

(Before NELSON, J., Southern District of New York, October, 1851.)

JOSEPH SMITH, on behalf of himself and others, the crew of the United States sloop-of-war Plymouth, filed a libel for

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salvage in the District Court against the American brig Josephine. The libel charged that the Plymouth, on her passage from Rio Janeiro to Boston, on the 30th of September, 1846, fell in with the wreck of the Josephine on the high seas, some five hundred miles from the port of New York, drifting about at the mercy of the waves, entirely abandoned by her crew, derelict and partly plundered; that a boat was lowered from the Plymouth and a boat's crew sent to take possession of the wreck; that, after considerable exertion, a hawser was made fast to her, and the course of the Plymouth was altered to New York, to which place she towed the brig and her cargo in safety, being engaged in such towing for four days; that, but for the assistance so rendered to the brig and her cargo, the same would have been entirely lost; that the libellants were on board the Plymouth at the time and assisted in saving the brig and her cargo; and that the captain, officers and crew of the Plymouth, for the service thus performed and the risk run, were justly entitled to reasonable salvage. The answer, after admitting substantially the facts set forth in the libel, set forth that the Plymouth, in rendering assistance to the brig, was acting under instructions from the Government of the United States to render relief freely and promptly to American vessels in distress; that, in the opinion of the Government, it best comported with the interest of the Navy and the policy of the Government, that no compensation should be asked or received for such services; that, in rendering assistance to the brig, the officers and crew of the Plymouth were in the discharge of their legal duty only, for which they were paid by the Government, and that such services were not within either the reason or the policy of the ordinary maritime law in regard to salvage. The District Court dismissed the libel, but without costs, on the ground that there was probable cause for filing it. The libellants appealed to this Court. All the other facts necessary to be stated will be found in the opinion of the Court.

Erastus C. Benedict, for the libellants. I. Salvage is the

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compensation due to persons by whose voluntary assistance a ship or its lading has been saved to the owner from impending peril or recovered after actual loss. (*Abbott on Shipping*, 554; *Hand v. The Elvira*, *Gilp. R.* 60, 66.) The right to salvage depends solely upon the consideration that property has been saved to the owner from maritime peril by the salvor. His intrepidity, humanity, relief to distress or preservation of life do not affect his right to compensation; they only affect its amount. (*The Emblem*, *Daveis' R.* 61, 64; *The India*, 1 *W. Rob.* 406, 408.) II. Salvage does not depend upon the character of the parties rendering the service, nor upon the character of the assistance rendered, nor upon the kind of peril or cause of loss, nor upon the national character or ownership of the property saved or of the owners. 1. There is no limitation to the kind of persons who may be entitled to this compensation. (a.) Persons in the employ of the nation. Officers and seamen of vessels of war. (*The Thetis*, 3 *Hagg.* 14; *The Porcher*, 2 *Hagg.* 270, note; *The Gage*, 6 *C. Rob.* 273; *The Lord Nelson*, *Edw. R.* 79; *The Pensamento Feliz*, *Id.* 115; *The Mary Ann*, 1 *Hagg.* 158; *Prich. Dig.*, 385; *The Iustre*, 3 *Hagg.* 154; *The Ervell Grove*, *Id.* 209; *The Helena*, *Id.* 430; *The Wilsons*, 1 *W. Rob.* 172; *The Iodine*, *Prich. Dig.*, 385, note; *The United States v. The Amistad*, 15 *Peters*, 518.) The Royal Coast-Guard and revenue officers. (*The Helena*, 3 *Hagg.* 430, note; *Le Tigre*, 3 *Wash. C. U. R.* 567, 572; *Prich. Dig.*, 393, § 323, and note.) (b.) Semi-official persons. Pilots. (*The Balsemao*, 2 *Hagg.* 270, note; *The Nicolaas Witzen*, 3 *Hagg.* 369; *Hobart v. Drogan*, 10 *Pet.* 108.) Lloyd's agent. (*The Traveller*, 3 *Hagg.* 370.) (c.) Persons having some relation to the subject saved. Passengers. (*Prich. Dig.*, 360, § 38; *Newman v. Walters*, 3 *Bos. & Pull.* 612; *Abbott on Shipp.*, 560.) The crew, in extraordinary circumstances. (*The Neptune*, 1 *Hagg.*, 227, 237; *Prich. Dig.*, 385, note 55.) Consorts. (*The Waterloo*, 2 *Dod.* 438, 443; *The Ganges*, *Prich. Dig.*, 389, note 62.) (d.) Persons of no independent right. Women. (*The Jane and Matilda*, 1 *Hagg.* 187, 194.) Apprentices. (*Bell v. The Sloop Ann*, 2

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Pet. Adm. Dec. 278, 282; *Mason v. The Ship Blaireau*, 2 *Cranch*, 240, 270; *The Two Friends*, 8 *Jur.* 1011; *The Columbine*, 2 *W. Rob.* 186; *Prich. Dig., Salvage, (Civil.)* §§ 308, 314, 320, 335, 337.) Boys. (*Prich. Dig., Salvage, (Civil.)* §§ 327, 330.) Slaves. (*Small v. Goods*, 2 *Pet. Adm. Dec.* 284, 287; *Mason v. The Ship Blaireau*, 2 *Cranch*, 240, 241.) Masters, mates, sailors, cooks, surgeons, carpenters, passengers and landsmen of every national character. 2. Neither does salvage depend upon the character of the assistance rendered, nor upon the kind of peril or the cause of loss. It need only be the saving a vessel or cargo in danger—supplying stores—loaning an anchor—going for assistance—towing—helping to navigate in a storm—piloting into a port—fishing up from the bottom—quelling a mutiny—taking from pirates—recapturing from an enemy. 3. Neither does it require a request. It must be voluntary; that is to say, it must not spring from any particular duty, or from any particular relation to the saved property, or from any specific contract. It must be a service which the party may lawfully decline to render. 4. Nor does it depend upon the national character of the property saved or of the owners. III. Salvage service is highly favored in law in all commercial countries, from motives of clear public policy and a regard to the interests of commerce. (*Mason v. The Ship Blaireau*, 2 *Cranch*, 240, 266; *The Joseph Harvey*, 1 *C. Rob.* 313, note; *The William Beckford*, 3 *Id.* 355; *Hand v. The Elvira*, *Gilp. R.* 60, 69; *The Louisa*, 1 *Dod.* 317, 318, 319; *The Emblem, Daveis' R.* 61, 64 to 66; *The Centurion, Ware*, 477; *The Schooner Boston and Cargo*, 1 *Sumn.* 328.) IV. The stimulus which public policy and the interests of commerce supply is simply the spur of private interest. (*Adams v. The Sophia*, *Gilp. R.* 77, 79, 80; *The Emblem, Daveis' R.* 61, 64.) V. Compensation for salvage service is an absolute legal right. VI. This right is personal to the salvor, notwithstanding his relation to others. (*Le Tigre*, 3 *Wash. C. C. R.* 567, 572, 573.) VII. It being thus a personal right, a party cannot be deprived of it except by

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law. VIII. The right to salvage depends upon the saving of the property; but the rate or amount of salvage depends upon the amount of the property, the probability of loss, the amount of peril to the property, the value of the service to the owner of the property, and the personal toil, loss of time, daring and danger of the salvors. The highest order of merit, in a pecuniary estimate, is the safe bringing in of property entirely abandoned and lost to the owner—derelict. For such a service Courts have sometimes awarded seven-eighths for salvage, and it is usual to give one-half. The present is such a case. IX. The only real point is, that the salvage was performed by an American vessel of war, in saving American property. There was never, before this, a case decided in which the right of a national vessel to salvage was denied on that ground. The contrary has been held in numerous British, French, American, Mexican and South American cases. (*The Hope*, 3 C. Rob. 215; *The Edward and Mary*, Id. 305; *The Helen*, Id. 224; *The John and Jane*, 4 Id. 216; *The Gage*, 6 C. Rob. 273; *The Lord Nelson*, Edw. R. 79; *The Louisa*, 1 Dod. 317; *The Mary Ann*, 1 Hagg. 158; *The Iodine*, Prich. Dig., 384, note 54; *The Charlotte*, Id. note 55; *The Thetis*, 3 Hagg. 14, 42; *The Lustre*, Id. 154, 155; *The Ewell Grove*, Id. 209, 224, 225; *The Helene*, Id. 430, note; *The Wilsons*, 1 W. Rob. 172; *The Iris*, MS., South Carolina Dist. Court; *Ex-parte Kearney*, Id.; *The Ant*, in Mexico, *National Intelligencer* of Sept. 29, 1849; *The Active*, in Montevideo, Id.; *The United States v. The Amistad*, 15 Pet. 518; *The Eugenie*, *Evening Mirror* of Sept. 26, 1849; *Opinion of Atty.-Gen., Supp. to N. Y. Tribune* of Sept. 24, 1849.) X. The same law and the same principles, in civil and military salvage, apply to the Navy of the United States and to that of Great Britain. XI. Neither the Navy in the aggregate, nor any individual national vessel, nor any officer or seaman thereof, holds any particular relation to any commercial vessel, much less to property wrecked and deserted on the high seas. XII. The various Acts of Congress in relation to vessels in distress

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make no distinction between American and foreign vessels. XIII. The Executive Circular does not apply, in its letter or spirit, to salvage cases, nor has it any general or permanent operation. The Josephine was not a vessel in distress. She was wrecked property, abandoned at sea. XIV. There is no rule that salvage is to be withheld because the services were not extraordinary. XV. The objection that salvage is not due to the salvors because the commissioned officers declined to receive their share, is immaterial, if the right to salvage be personal. (*The Lustrre*, 3 *Hagg*. 154.) XVI. This is a case of highly meritorious salvage services. It is of that class for which the highest pecuniary allowance is made—a case of actual total loss—of property deserted and derelict, which could not otherwise have been saved.

William Bliss, for the claimants.

NELSON, J. The proofs show that no very extraordinary or hazardous service was required of the officers or crew of the Plymouth, or was rendered by them in saving the brig. She was discovered in latitude 37° N. and longitude 73° W., about one hundred and forty miles from the port of New York. The weather was fine from the time she was taken in tow till her arrival at that port, with the exception of some twenty-four hours, during which there was a pretty heavy blow, and on which occasion an additional hawser was used; but none of the crew were exposed on account of remaining on the wreck during the blow, as the officer and the few men on board were removed to the Plymouth. The only delay that occurred to the Plymouth in her usual service was one of about two days, owing to the change of her course from Boston to New York. All the service rendered was under the direction of the commander of the Plymouth, and agreeably to the general instructions of the Secretary of the Navy to all the naval vessels of the Government. The officers renounced all claim to salvage for the service, and so advised the Secretary of the Navy; but the crew refused to renounce.

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It is not necessary to determine, in this case, in order to dispose of it, whether or not the officers and crews of the naval vessels of the United States are in any case entitled to salvage for services rendered to American merchant-vessels in distress, notwithstanding the instructions on the subject, given by the Government. I have no doubt that cases may exist in which they are entitled to salvage compensation, both on principle and authority. (*The Gage*, 6 C. Rob. 273; *The Lord Nelson*, Edw. R. 79; *The Pensamento Feliz*, Id. 115; *The United States v. The Amistad*, 15 Peters, 518; *The Alligator and the Enterprise*, MS. decision of Judge Lee, So. Car. Dist.; *The Thetis*, 3 Hagg. 14; *The Helene*, Id. 430; *The Lustre*, Id. 154; *Le Tigre*, 3 Wash. C. C. R. 567, 572.) But, in such cases, something more than the usual peril should be encountered by the officers and crew, and an extraordinary service should be rendered, exceeding the duty imposed upon them by their employment in the public service and the special instructions of the Government on the subject. Ordinary service in rescuing American vessels in distress; requiring no great hardship or peril on the part of the officers and crew, would seem to fall directly within the line of the general duty thus enjoined. It is a service bestowed by the Government for the protection and encouragement of its commercial marine, and the right to impose this duty on Government vessels is too clear to be controverted. Great and extraordinary service and peril in rescuing a vessel and her cargo would present a different question and stand upon different principles and policy. Such acts should of themselves be the subject of reward and encouragement, and would not be necessarily comprehended in the duty resulting from the public employment of the persons rendering it or from the instructions of the Government. It appears, from the proofs in this case, that the services upon which the claim for salvage rests were in no way extraordinary or perilous, and consisted wholly in boarding the schooner, securing to her the hawsers, and towing her into port, the crew having been removed from her when the weather rendered it dangerous for them to

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remain. As a service performed in obedience to the orders of the officer in command of the sloop-of-war, and, also, in itself it was very commendable, and is deserving of all praise; but it was not specially meritorious, nor did it at all hazard the lives of any portion of the crew. There would be neither reason nor sound policy in construing this description of service, on the part of the officers and crew of a naval ship of the Government, as a salvage service, or in placing them on the footing of common salvors. I shall therefore affirm the decree of the Court below dismissing the libel, with the costs of this Court.

Decree accordingly.

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It is sufficient to give a lien, under the Statute of New York, (2 R. S. 493, § 1,) against a domestic vessel, for money advanced for supplies furnished to her in her home port, that the items of account for such advances amount in the aggregate to \$50. It is not necessary that each item should amount to \$50.

Where S., having a claim against F. for \$5,000, as the balance of \$12,000, purchase-money of a vessel, took a bill of sale of the vessel from F., with power to sell her and pay himself said balance, and at that time W. had a claim against F., for disbursements for stores and supplies for the vessel and for a commission for services in fitting the vessel for sea and procuring freight and passengers for her, of which claim S. had knowledge at the time: *Held*, on a libel *in rem* filed by W. to recover his claim, that S. was entitled to payment of his claim for the balance of the purchase-money, before W. could receive any part of his claim, but that W.'s claim had priority over a claim by S. for disbursements made by him, after taking said bill of sale, in fitting the vessel for sea.

The terms of the bill of sale, considered.

(Before NELSON, J., Southern District of New York, October 7th, 1861.)

THIS was a libel *in rem*, filed on the 23d of November, 1849, in the District Court, by Albert A. Warner against the ship St. Mary, an American vessel. The facts stated in the

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libel were these: Warner, as agent for one French, the owner of the vessel, was engaged at New York from the 15th of September, 1849, to the 22d of November, 1849, in procuring equipments and supplies and freight and passengers for the vessel, for a voyage from New York to San Francisco, and, during that time, paid and advanced to and for French, and at his request, large sums of money for stores, supplies, provisions and otherwise. After crediting various sums received by Warner for freight and passage-money, there remained due to him, on the 21st of November, 1849, for moneys so advanced, including his charge for commissions, a balance of \$2,501 30. The charge for commissions was \$1,250, being 5 *per cent.* on \$25,000. Several of the items of account claimed were less than \$50 each. On the 21st of November, 1849, the vessel being ready for sea, Warner presented his account to French, who examined it and acknowledged its contents, and, on the same day, gave Warner a mortgage on the vessel to secure the \$2,501 30, with interest.

The firm of Simes & Huffer, as claimants, put in an answer, which set up these facts: French purchased the vessel from them on the 15th of September, 1849, at New York, for \$12,000. On the same day French executed to them a paper, reciting the sale for \$12,000, and setting forth that \$3,000 of it was to be paid on the 17th of that month, \$4,000 in thirty days from date, and the balance within sixty days from date and before the vessel should leave New York; that no transfer of the vessel was to be made until the whole amount should be paid; that, in case of default in any of the payments, the vessel was to be sold at public sale, on account of French and at his expense; that Simes & Huffer were to be at liberty to purchase at the sale; and that French was to pay the deficiency, if any. Warner knew the terms of French's purchase at the time it was made, or shortly after. French took possession of the vessel, and paid the \$7,000, as agreed. On the 26th of October, 1849, \$5,000 of the purchase-money being unpaid, French made to Simes & Huf-

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fer a proposal, in writing, that they should "take possession of the ship, and charge of the management of her business for loading and getting to sea," "with the understanding that whenever" they should be "in receipt of a sufficient amount of money to cover the balance due for purchase-money, and any liabilities" they might "be under, growing out of this transaction and connection," French should "be entitled to a bill of sale of the ship, in order that" he might "sell or hypothecate her to another party, under the condition that the proceeds of such sale or hypothecation" should "pass into" their "hands for the disbursement of the ship." The proposal concluded as follows: "I further agree that, before the ship goes to sea, you shall be placed in funds sufficient to cover all the liabilities of the ship and outfits. If, therefore, you accept this proposition, you will please cause the ship to be loaded and prepared for sea with all due diligence and despatch, and, in compensation for your services, I agree to allow you two and one-half *per cent.* commission on the amount of her freight and passage-money, warranting the same to amount to twenty-five thousand dollars." On the same day, Simes & Huffer and Warner signed a memorandum indorsed on said proposal, in these words: "We accept the within proposition of Mr. French, and it is understood that Mr. A. A. Warner is to be associated with us so far as the passenger part of the business is concerned. All bills of lading are to be signed at our office, and all bills against the ship to pass through the hands of Simes & Huffer." Simes & Huffer forthwith took possession of the ship under the agreement, with Warner's knowledge, and rendered the services and made the disbursements necessary to fit her for sea. They claimed a lien on the vessel for a balance of \$7,042 37 due them for their disbursements for her, over and above the \$5,000 balance of purchase-money and interest. On the 26th of October, 1849, Warner gave to Simes & Huffer a written paper, in these words: "Having this day entered into an agreement with Messrs. Simes & Huffer, to conduct the passenger part of the ship St. Mary, now adver-

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tised for California, it is hereby agreed by me, that the amount of funds received by me from passengers is to be applied solely to the account of the ship St. Mary, or subject to the order of Messrs. Simes & Huffer for the use of said ship." On the 22d of November, 1849, another agreement was made between French and Simes & Huffer, by which, after a recital that French still owed them, on his purchase, \$5,000, and interest from November 15th, 1849, and that they had paid bills in relation to the contemplated voyage to San Francisco, and other bills had been incurred and were outstanding against the ship or on account of the voyage, French assigned and transferred to them all his right, title and interest in the ship, "her tackle, apparel and furniture, and in her freight and passage-money and all sums of money due or to become due, for freight or passage-money or otherwise," to the ship, or to French on her account or on account of the voyage, and authorized them to take the entire control and management of her and of the voyage, and to collect and compromise any claims due to French on account thereof, and to settle, and, if they saw fit, to compromise any claims against French or the ship on account thereof, and to sell the ship on such terms and at such time as they might think best, and, if they thought best, to provide a voyage for her return to the United States or elsewhere. The agreement further provided that, from the earnings of the ship, and her proceeds, if sold, Simes & Huffer were to pay themselves the balance due on her and all disbursements made by them on her account or connected therewith, and twenty *per cent.* commission on the receipts and disbursements, as their compensation; that, if there should be a surplus when the affairs were closed, Simes & Huffer should pay it to French; and that Simes & Huffer should appoint an agent in San Francisco, with authority, in case French should there pay the full amount due them or for which they were liable, including commissions, to transfer and give a bill of sale of the ship to French, provided no previous transfer should have been made.

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The answer set up, that the Court had no jurisdiction to enforce Warner's claim against the vessel ; that Warner had no right to arrest the ship or interfere with her voyage ; that the greater part if not the whole of Warner's account, as set forth in the libel, was not a lien on the vessel, either by the laws of New York or under the Admiralty law ; and that Warner's rights were subordinate to those of the claimants.

The other facts necessary to an understanding of the case are stated in the opinion of the Court. After a decree by the District Court in favor of the libellant, the claimants appealed to this Court.

Edward H. Owen, for the libellant.

George C. Goddard, for the claimants.

NELSON, J. The merits in this case are with the libellant, and I think that the decree below is maintainable upon principles of law. I lay out of view the mortgage given upon the vessel, and put the decision upon the original indebtedness.

The per centage which French agreed to allow the libellant for fitting out the vessel and procuring freight and passengers for her voyage to San Francisco, as compensation for the service and responsibility, partakes of the same nature and character as the disbursements made in the course of the service, in furnishing stores, &c., in fitting the vessel out. The reasonableness of the amount is not in question, as French determined that for himself, and it was a matter in which he alone was concerned at the time. For aught that appears, the compensation was the customary rate allowed in fitting up and freighting these California passenger vessels.

As respects other parts of the claim, which, it is conceded, are properly chargeable against the ship, I do not agree with the counsel that each claim must exceed the amount of fifty dollars, in order to bring the lien within the State statute.

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(2 R. S. 493, § 1.) It is sufficient if the amount in the aggregate reaches that sum.

I agree that Simes & Huffer had a prior lien on the vessel for the five thousand dollars and interest, the balance of the purchase-money, at the time they resumed the possession of her, and that they were entitled to its payment out of her proceeds, before any distribution to the libellant. But it must be remembered that, when the vessel passed into their hands, under the arrangement of the 22d of November, French had an interest in her to the amount of \$7,000, he having paid that portion of the purchase-money. This interest passed into their hands on the re-transfer, and was fairly subject to the charges of the libellant. She was ample security for both demands. Beyond this balance of the purchase-money, Simes & Huffer had no prior lien on the vessel over the libellant; and it is apparent, from the transactions between all the parties, that they were fully aware of his claim at the time of the arrangement of the 22d of November. The libellant had been engaged in equipping the ship and procuring freight and passengers, from the 17th of September down to the 26th of October, when Simes & Huffer became jointly concerned with him in the business, and I must hold them chargeable with a knowledge of the service he had already performed in this respect, and of the disbursements made and accounts outstanding at the time they became concerned with him. With a few trifling exceptions, his whole account had then already accrued against the vessel. It is true, some evidence was given tending to show that an account, the balance of which amounted to some \$386, had been rendered by the libellant at this time; but it is altogether too indefinite and uncertain to be relied on for this purpose. The writings that were made at the time make no mention of it, or of the amount of the indebtedness to the libellant. That the amount now claimed existed at the time, is too well established to be doubted.

What strengthens very much the equity and justice of the claim of the libellant, under the circumstances, is

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the nature and character of the arrangement of the 22d of November, between Simes & Huffer and French. It not only assigns all the interest of the latter in the vessel, freight and passenger money, and authorizes them to sell and dispose of her, and requires them, after paying themselves, to pay the surplus, if any, over to French, but provides, also, that, if the vessel is not sold, they shall appoint an agent at San Francisco, with authority, in case French shall pay the full amount due them or for which they may be liable, to make a bill of sale of the vessel to French. By this arrangement, the claims of the libellant are not only entirely disregarded, but the interest of French in the vessel, over and beyond the lien of Simes & Huffer for the balance of the purchase-money, is placed out of the libellant's reach. We have seen that he had the next lien on the vessel, and was entitled to have it enforced before any other of the claims of Simes & Huffer. Besides, it is by no means certain that they did not bind themselves to French, by the arrangement of the 22d of November, to pay the claim of the libellant. Among other stipulations, they agree "to settle, and, if they see fit, to compromise, any claims against the said French or said ship, on account thereof."

It seems to me that the libellant had a valid lien upon the interest of French in the vessel, when it passed into the hands of the claimants on the 22d of November, and that it was sufficient, over and beyond their prior lien for the balance of the purchase-money, to satisfy his claim. They had sold her to French, on the 15th of September previous, for \$12,000, and, on the 23d of November, she appears to have been insured at the value of \$16,000.

The libellant had no interest in the voyage. He had been employed to fit up the ship and procure freight and passengers, and was concerned only in this service, and in securing his compensation for the same and for his disbursements; and I do not see that he was bound to forego these claims rather than break up the voyage. This was a question for those interested or who had become interested in getting

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the vessel to sea and in making the voyage—not for the libellant. I see nothing in the case to restrain him from enforcing his rights, even at the expense of breaking up the voyage. French or those who had taken his place were bound to look to this, and to relieve the vessel from the charge.

In every view I have been able to take of the case, I think that the decree below was right and should be affirmed.

THE *ELVIRA HARBECK*.

Where a passenger accompanies his baggage, the fare charged for his passage includes compensation for its transportation, and the carrier becomes responsible for its safe delivery.

If a passenger does not accompany his baggage, the carrier may claim compensation in advance for its transportation, or may postpone his claim till the delivery and rely on his lien or on the personal responsibility of the owner; in either of which cases, the carrier is responsible for the safe-keeping and delivery of the baggage.

Where a person took passage in a vessel, but his personal baggage did not reach him in season to be put on board of that vessel, and he sailed without it, and it was put on board of another vessel, a receipt or bill of lading being given for it by the mate of the latter vessel, but it was never delivered at its port of destination: *Held*, in an action *in rem* brought against the latter vessel for the value of the baggage, that the case was one of the ordinary shipment of goods on freight, for whose safe delivery the vessel was liable, and that her owner was not to be regarded merely as a gratuitous bailee, responsible only for gross negligence.

Held, also, that the words "personal goods" on the margin of the receipt or bill of lading, were at most but a description of the character of the goods, and did not exempt the owner of the goods from freight, or the vessel from responsibility.

(Before NELSON, J., Southern District of New York, October 7th, 1851.)

THIS was a libel *in rem*, filed by Jeanette Brown, in the District Court, against the bark *Elvira Harbeck*. The libel set forth that the libellant shipped, on board the *Elvira Harbeck*, lying at the port of Antwerp and bound for New

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York, ten packages and one basket of goods—the same being personal baggage and tools—all in good order and condition; that the mate of the vessel, acting on behalf of the master and owners, undertook and agreed to deliver the same, at the port of New York, to the libellant or her order, the dangers of the sea only excepted; that eight of the ten packages contained the tools of the trade of her son, put up in boxes, and two others were trunks secured by lock and key; that the two trunks and the basket contained the personal apparel belonging to the libellant and her family; that the Elvira Harbeck arrived from Antwerp safely, in New York, on the 10th of August, 1849, and eight of the packages were delivered according to the bill of lading executed by the mate; but that the two trunks and basket had not been delivered to the libellant, though the same had been frequently demanded.

The answer denied the allegations in the libel, and averred that all the packages received on board the vessel were delivered to the libellant. It denied all negligence, and charged that, if any of the goods had been lost, they were lost by the negligence and carelessness of the libellant.

The proofs showed that the libellant and her family emigrated from Aix-la-Chapelle to this country; that the goods were packed in eight boxes, two trunks and a basket, which were forwarded to Antwerp by the railroad; that the family had taken their passage to New York in the ship *Roscoe*, then lying at Antwerp; and that, in consequence of this vessel's having left the port, on her voyage, with the family, before the arrival of the boxes of tools and baggage by the cars, it became necessary to send them on another vessel. They were sent, accordingly, by the agent of the libellant, in the *Elvira Harbeck*, and a receipt or bill of lading for the goods was duly executed by the mate, then in charge of the vessel, at the port of Antwerp. The receipt, when put in evidence, had on its margin the words "personal goods," in pencil. When they were put on, did not appear. A witness, the brother of the libellant, saw the goods put on board

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the vessel and stowed away in the hold, the usual place for stowing away merchandise. On the arrival of the vessel at New York, the eight boxes of tools were duly delivered to the order of the libellant; but the two trunks and basket could not be found and had never been delivered. The libel was filed to recover the value of their contents.

The ground of defence relied on was, that the goods were shipped on a passenger ship, as personal baggage belonging to a passenger or passengers; and that, inasmuch as the owner did not take his passage on board the ship and pay the fare, which would include compensation for the usual baggage, no compensation was paid, in this case, for the freight, and the ship was entitled to none; and hence, that the master and owners were to be regarded as gratuitous bailees, and responsible only for gross negligence, to be charged and proved, in the transportation of the property.

The District Court sustained the defence set up and dismissed the libel. The libellant appealed to this Court.

Erastus C. Benedict, for the libellant.

Welcome R. Beebe, for the claimants.

NELSON, J. There is no evidence that the libellant and her family took passage in the *Elvira Harbeck* or ever intended to take passage in her. On the contrary, their passage was taken in the *Roscoe*, on which ship they expected to have carried with them their personal effects; but they were disappointed, in consequence of the non-arrival of the goods in the cars from Aix-la-Chapelle, when the vessel sailed. It was then arranged with their agent to send the goods in some other vessel bound for the same port. But, even assuming that the libellant and her family had engaged their passage in the *Elvira Harbeck*, but changed their minds, and failed to complete the engagement, and took passage in another ship, sending their baggage, however, in the *Elvira Harbeck*, it by no means follows that the vessel is not

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entitled to freight, or that the owners are to be regarded as gratuitous bailees, and to be held responsible only for gross neglect in the transportation of the goods. On the contrary, I cannot doubt that they would be entitled to reasonable freight-money, and to a lien on the goods until it should be paid.

In cases where the passenger accompanies his baggage, the fare charged for his passage includes compensation for its transportation, and the carrier becomes responsible for its safe delivery. If the passenger does not accompany it, the carrier may claim compensation in advance for its transportation, or may postpone his claim till the delivery and rely on his lien or on the personal responsibility of the owner. And I do not see why the rule of responsibility for the safe-keeping and delivery should not be the same in both cases. The actual payment of the freight in the one case, and the actual liability and lien for its payment in the other, constitute the consideration for the undertaking.

But it is sufficient to say, in this case, that the proofs show an independent shipment of the goods in question, unconnected with the owner as a passenger. The case is one, therefore, of the ordinary shipment of goods. The words "personal goods," in pencil-marks, upon the margin of the receipt—when put on, does not appear—cannot alter the nature of the undertaking. They do not exempt the owner of the goods from freight or the ship from responsibility. At most, they are but a description of the character of the goods put on board.

I think that the libellant is entitled to recover, and must, therefore, reverse the decree below, and refer the case to the clerk, to report the value of the property lost.

Godfrey v. Gilmartin—Brown v. Burrows.

JONATHAN GODFREY *vs.* DANIEL GILMARTIN.

Where an action *in personam* is brought in the District Court, in Admiralty, on a money demand amounting to less than \$50, but the libellant's claim, with interest, amounts to more than \$50 at the time the decree is made by the District Court, and he has a decree in that Court for more than \$50, an appeal lies to this Court from such decree.

On such appeal, the action becomes a plenary suit in this Court, and, if the decree is affirmed by this Court with costs, full costs of this Court may be taxed.

(Before NELSON and BETTS, JJ., Southern District of New York, October 15th, 1851.)

THIS was an appeal from the clerk's taxation of costs. The suit was an action *in personam*, brought in Admiralty, in the District Court, on a money demand amounting to less than \$50. The libellant's claim, with interest, amounted to more than \$50 at the time the decree was made by the District Court, and he had a decree in that Court for more than \$50. After this Court had, on appeal, affirmed the decree with costs, the Clerk taxed full costs of this Court against the respondent, from which taxation he appealed.

THE COURT held that the case was one in which an appeal was allowed by law, and that, on the appeal, the action became a plenary suit in this Court and carried full costs of this Court.

JOHN BROWN *vs.* SILAS E. BURROWS.

A surety in a stipulation given on the release from attachment of the property of a respondent in a suit in Admiralty *in personam*, in the District Court, cannot, where the stipulation is in a sum certain, be compelled, as surety, to

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pay more than that sum, although the stipulation is conditioned to pay such sum as shall be awarded to the libellant by the final decree in the suit.

(Before NELSON and BETTS, JJ., Southern District of New York, October 15th, 1851.)

THIS was a motion by a surety in a stipulation to cancel the stipulation. The stipulation was given on a release of the respondent's property from attachment, in a suit in Admiralty *in personam*, commenced in the District Court and appealed to this Court. The stipulation was in the sum of \$900, and was conditioned to pay such sum as should be awarded to the libellant by the final decree in the suit. The final decree was for a sum exceeding \$900. The surety had paid the \$900 to the libellant.

The libellant insisted that, by the 4th rule of the Rules in Admiralty, prescribed by the Supreme Court of the United States, in December Term, 1844, the surety was bound to satisfy the whole amount of the decree.

THE COURT held, that the obligation of the surety was limited to the sum of \$900 named in the stipulation, and that, as surety, he could not be compelled to pay more than that amount.

Motion granted.

ELIAS CROPSEY vs. JOSHUA CRANDALL.

A judgment or decree docketed in a Court of the United States for the Southern District of New York is a lien on the lands of the defendant in whatever county of the District they are situated.

It is not necessary to the creation of such a lien that a transcript of the judgment or decree should be filed in the office of the clerk of any county in the District.

The statutes of New York which limit the *duration* of the lien of the judgments and decrees of the State Courts apply to the judgments and decrees of the Courts of the United States within the State.

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But the New York statute of May 14th, 1840, (*Laws of 1840, chap. 386, § 26,*) prescribing what acts are necessary to be done to create the lien of a State judgment or decree, does not apply to the judgments or decrees of a Court of the United States.

(Before NELSON and BETTS, JJ., Southern District of New York, October 15th, 1851.)

THE libellant obtained a decree in this Court, on appeal from the District Court, in a suit *in personam*, in Admiralty, against the respondent and one Cleaveland, his stipulator. The decree was duly docketed in this Court, and an execution was issued upon it against Cleaveland, on which real estate of his, situated in Williamsburgh, Kings county, was about to be sold. The decree was not docketed in Kings county, nor was any transcript of it filed in that county. Cleaveland now moved to set aside the execution against him, on the ground that, under the 26th section of the Act of the Legislature of New York of May 14th, 1840, (*Laws of 1840, chap. 386,*) no lien could attach to his real estate in Kings county until a transcript of the decree was filed in the office of the clerk of that county.

THE COURT held that a judgment or decree docketed in a Court of the United States for the Southern District of New York was a lien upon the lands of the defendant in whatever county in the District they might be situated; that it was not necessary to the creation of such lien that a transcript of the judgment or decree should be filed in the office of the clerk of any county in the District; that the statutes of New York which limited the *duration* of the lien of the judgments and decrees of the State Courts applied to the judgments and decrees of the Courts of the United States within the State; but that the New York statute of May 14th, 1840, prescribing what acts were necessary to be done to create the lien of a State judgment or decree, did not apply to the judgments or decrees of a Court of the United States.

Motion denied.

HARRY BRADLEY AND OTHERS

vs.

ANDREW J. RICHARDSON AND OTHERS. IN EQUITY.

Where corporate rights and interests are affected in any way wrongfully and injuriously, those rights and interests, generally speaking, and unless some special ground be shown, must be asserted and defended, both at law and in Equity, in the corporate name.

It is not sufficient for a debtor, or for those who are entitled to assert his rights, in order to induce a Court of Equity to relieve against a judgment at law, to show that the debtor was wrongfully deprived of an opportunity of making a defence in the suit at law, unless a defence, apparently, would have been available. To entitle them to an interposition of a Court of Equity in their behalf it must appear that the judgment is unjust and inequitable, and ought not to be enforced.

Where property of a debtor, which is subject to an attachment in a suit pending at law, is sold to one to hold in trust for certain creditors of the debtor, and a judgment is rendered in the suit at law, and the creditors for whose benefit the purchase was made institute proceedings in Equity to be relieved against the judgment so obtained, alleging that it was unduly obtained and for too large an amount, the Court will not inquire merely whether the judgment was just and equitable as between the parties to it, but whether it includes claims or demands not covered by the action, or not due and payable at the commencement of the action, or which, by a proper application of payments or credits, will appear to have been paid and satisfied, and were, therefore, not existing legal claims; and, unless the judgment appears to be wrong in some of these particulars, and consequently to have been rendered for more than the property ought to have been charged with, the plaintiffs will have no ground of complaint, whatever may have been the manner in which the judgment was obtained.

R. B. & Co., a copartnership, acted, by mutual agreement, as the selling agents of the Burlington Mills Co., a manufacturing corporation. The copartnership of R. B. & Co. was dissolved, and a new firm constituted, under the same style and consisting in part of the same members. The new firm assumed and continued the business of the old firm, acting as the selling agents of the corporation under the same agreement which existed with the old firm. The corporation, by its treasurer, requested the new firm to pay and adjust the balance due from the corporation to the old firm and charge it, in their account, to the corporation. They did adjust it accordingly, and the old firm credited the corporation with the amount of the balance, as received of the new firm, and rendered their account to the corporation balanced by the credit in full: *Held*, that it must be inferred that this balance was discharged

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by the payment of money or what was equivalent thereto; that the corporation thereby became debtors to the new firm for the amount; and that it might be recovered by them, in an action for money had and received or for money paid and advanced.

The treasurer, not being merely the keeper of the money of the corporation, but empowered by the directors to borrow money in the name and for the use of the corporation, and having a general authority given him by the by-laws to pay the debts of the corporation: *Held*, that he had sufficient authority to give the assent of the corporation to the transaction by which the balance due to the old firm was thus paid.

Held, also, that it could not be objected against the validity of the transaction that the treasurer was a member both of the old and the new firm, that fact being fully known to the corporation.

An account having been rendered to the corporation, stating the balance, the payment of it and by whom it was paid, and no objection having been made at the time or afterwards, until a suit was commenced against the corporation by the new firm to recover the amount due to them: *Held*, that the transaction must be deemed to have been acquiesced in by the corporation.

The undertaking of a factor is merely to answer for the solvency of the buyer of the goods, or rather to guaranty to the principal the payment of the debt due from the buyer. He becomes liable to pay to the principal the amount of the purchase-money, if the buyer fails to pay it when it becomes due. And his undertaking is not collateral, within the statute of frauds, but is an original and absolute agreement that the price for which the goods are sold, or the debt created by the sale of the goods, shall be paid to the principal when the credit given on the sale shall have expired.

If the factor has agreed that he will advance to a certain amount upon the goods consigned to him, to that extent his advances may be treated as payment in advance of so much towards the goods, and, so far, the one may be set off against the other. But all moneys advanced on account beyond the amount agreed to be advanced upon the goods will constitute a present legal debt, for which he will have a present legal right of action.

If the principal procures and has the benefit of the advances, he is thereby precluded from objecting to them as not answering the agreement, whatever may be the form in which they are made.

If the factor commences a suit at law against the principal, to recover the unpaid balance due to him for his actual advances, having previously made sales of goods upon a credit not yet expired, and being at the same time liable upon acceptances and bills for the principal not yet matured, he is entitled to have the avails of the sales, as they become due, applied in satisfaction of the additional advances which he is compelled to make upon such bills and acceptances as they become due, and cannot be required to apply such avails in satisfaction of his present legal claims existing at the commencement of his suit.

(Before PRENTISS, J., Vermont, November 27th, 1851.)

Bradley v. Richardson.

THIS was a motion for an injunction, predicated upon a bill filed by Bradley and others against Richardson and others, to stay execution of two judgments amounting together to the sum of \$51,992 04, recovered by Richardson and others, at the October Term of this Court in 1851, against the Burlington Mill Company, a corporation established under an Act of the Legislature of Vermont, for the manufacture and sale of woollen goods. The facts will sufficiently appear from the opinion of the Court.

William W. Peck and *D. A. Smalley*, for the plaintiffs.

Lucius B. Peck, for the defendants.

PRENTISS, J. I have taken time to read the bill and papers filed in this case, which are uncommonly voluminous and contain a great variety of statements and facts, because I thought it unfit and was unwilling, whatever might be the inclination of my mind at the hearing, to decide a matter of so much importance to the parties, without first examining carefully every paper connected with it, as well as the authorities referred to by the counsel on the argument.

The bill may be considered in a threefold aspect; as presenting a right in the plaintiffs to relief, first, as *stockholders* in the Burlington Mill Company; secondly, as *creditors* of the Mill Company; and, thirdly, as *cestui que trusts* under the purchase of the property attached in the suits at law, made by Hill as their trustee, subsequent and subject to the attachments, he having deceased, and there being no personal representative competent to sue here in his right.

As stockholders simply, there would be much difficulty, on the statements made in the bill, in the plaintiffs' maintaining it. As such, they are not personally or individually responsible for the judgments recovered against the Mill Company; nor have they, in that character, any interest whatever in the property which was attached and is liable to be taken to satisfy the judgments. Where the corporate rights and inter-

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ests are affected in any way wrongfully and injuriously, those rights and interests, generally speaking, and unless some special ground be shown, must be asserted and defended, both at law and in Equity, in the corporate name. Now, the bill does not state any fraud or collusion with the judgment creditors, on the part of the Mill Company; but, on the contrary, it alleges that the judgments were obtained without the consent and against the will of the Company and were a fraud upon the Company. In this aspect of the case, it would seem that the Company, in its corporate name, would be the proper party to seek relief against the judgments.

On the general ground of being creditors of the Mill Company, without some special interest, it would be equally difficult for the plaintiffs to maintain their claim to relief. What right has one creditor to interfere in a suit, or, indeed, in any transaction, between his debtor and another creditor, unless he has some specific interest in property which is to be affected thereby? In the case of a fraudulent judgment, creating a lien on property, or a fraudulent conveyance of property, the party seeking relief against either must show an interest in the particular property, by levy of execution, purchase or otherwise.

But, whatever rights the plaintiffs may be supposed to possess as stockholders or creditors, it is not sufficient for them, nor would it be for the Mill Company, to show that the latter was wrongfully deprived of an opportunity of making defence in the suits at law, unless, apparently, a defence would have been available. To entitle them to the interposition of a Court of Equity in their behalf, it must appear that the judgments are unjust and inequitable and ought not to be enforced. If the proceedings of the stockholders and directors at Boston, dismissing the attorneys from the suits and consenting to judgments being rendered, were irregular and invalid, as is alleged, on account of the meetings being held out of this State, the attorneys, instead of withdrawing from the suits and suffering judgments to pass *sub silentio*, should

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have objected to the proceedings at the time, and submitted the question as to their validity and binding force to the consideration and decision of the Court.

But the judgments, it is to be observed, were not obtained, certainly not altogether so, without a hearing and without a defence. A hearing had been had upon the merits before a tribunal whose opinion, considering how the tribunal was constituted, ought to command at least as much respect, to say no more, as that of a jury. The actions, by agreement, of the parties and order of Court, had been submitted to the determination of referees mutually chosen by the parties. The referees had heard the parties, made an award and reported the award to the Court, stating the facts and grounds upon which it was made. Exceptions were filed to the report, raising certain questions of law on the facts stated; but no exception was taken or is now taken, on account of partiality or misbehavior in the referees. It was, therefore, only the questions or points of law thus raised, that could be heard or re-examined by the Court. Beyond these questions, no hearing was to be had, nor is it now urged that any could or should have been had. All else was settled; for, of the facts the referees were the exclusive judges.

If the referees decided these questions rightly, and committed no mistake in point of law, the judgments are right, and there surely can be no reason in equity why the plaintiffs, in their general character of stockholders and creditors, and upon that general ground alone, should be allowed to disturb the judgments. In the case of *Nason v. Smalley*, (8 Verm. 118,) the object of which was to enjoin a judgment at law alleged to have been fraudulently obtained, Phelps, J., said: "Although the judgment may have been obtained in such a manner that it ought not, in itself considered, to bind the complainants, yet it would be idle to interfere, if the debt thus in fact established be just and equitable, or if the party must be left at liberty to prosecute anew, and a Court of law would be compelled hereafter to render a like judgment." This is good sense and sound doctrine, well ex-

pressed, and nothing can be added either to its force or significance.

But it is in the third aspect of the case, if in any—as *cestui que trusts* under the purchase made by Hill of the property attached, and as interested in the purchase as creditors, in the manner stated in the bill—that the plaintiffs are entitled to come into a Court of Equity and ask relief against the judgments. This relief they will be entitled to, if the case calls for relief, whether the judgments were rendered with or without the consent of the Mill Company; and, in this view, so far at least as concerns the question of title to relief, the manner in which the judgments were obtained, further than there being in fact no hearing in Court, or the validity or invalidity of the proceedings of the stockholders and directors in Boston in relation thereto, is unimportant. I may observe, however, that whatever fraud is charged upon the directors, either in act or in motive, on account of those proceedings, is positively and fully denied by their affidavits, leaving no ground, if any existed before such denial, for the imputation to them of intentional wrong.

The bill states that the purchase by Hill was made subject to the attachments, and in trust for the plaintiffs and others, creditors of the Mill Company, which is alleged to be insolvent, in order to secure or satisfy them as far as might be, for notes, called three-fifths notes, executed by them to raise money for the use of the Company. It is stated that the *cestui que trusts* were to share in the purchase in proportion to the amount of notes so by them respectively executed; that the whole amount of notes executed was about \$120,000; and that the amount executed by the plaintiffs was about \$23,000, giving them, therefore, an interest in the purchase equal to about one-fifth part. It appears that most of the other *cestui que trusts* have given their assent to the judgments, and are willing that they should be satisfied out of the property. Under such circumstances, the other *cestui que trusts* being content, it would seem that the claim of the plaintiffs to relief, if they have any claim, would be limited, and the

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measure and mode of relief adjusted and regulated by the amount of injury, if any, wrongfully resulting from the judgments to their particular personal interest in the property.

As the purchase by Hill comprehended the whole property attached and the whole interest in it, except what was a legal subsisting charge upon it by virtue of the attachments, the inquiry is, not merely whether the judgments are just and equitable as between the parties to them, but whether they include claims or demands not covered by the actions, not due and payable at the commencement of the actions, or which, by a proper application of payments or credits, will appear to have been paid and satisfied, and were, therefore, not existing legal claims. This opens an examination into the merits of the judgments; and, unless they shall appear to be wrong in some of these particulars, and consequently are for more than the property ought to be charged with, the plaintiffs have no ground of complaint, whatever may have been the manner in which the judgments were obtained.

The actions were commenced the 21st and the attachments made the 22d of May, 1849; and the purchase by Hill, in trust for the plaintiffs and others, was made June 13th, 1850. The actions contained counts on several promissory notes, and counts for money had and received, money laid out and expended and money lent and advanced.

The actions, as we have already seen, and, I may add, nothing but the actions, by mutual consent of the parties and order of Court, were, in proper and regular form, submitted to a reference; and, upon the report made by the referees, stating specially the grounds of their award, or rather the claims and facts in the case, the judgments complained of were rendered. The report is set forth at length in the plaintiffs' bill, and the statement of facts in it is neither denied, impugned nor questioned. Being made a part of the bill, for the purpose of presenting the merits of the controversy between the parties in the suits at law, and being treated by the bill as the basis upon which the objections to the judg-

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ments rest, we must look into the report to see whether the judgments subject the property attached to a greater charge than it was legally and properly liable to under the attachments. The bill, aside from what is alleged as to the manner of obtaining the judgments, which seems not to be essential to the purpose of the bill, beyond showing that they were rendered without any actual hearing or consideration by the Court, puts the case upon this ground, narrowing down the merits to the particular questions arising from the report.

The questions raised as to the binding effect of the promissory notes upon the Mill Company, on account of the form in which they were executed and the purpose for which two of them were made, it is unnecessary to consider; because, all the claims that were allowed, if allowable at all, were admissible under the general counts in the actions.

It appears from the report, that the dealings between the judgment creditors and the Mill Company originated in an arrangement under which the former were to receive and sell, on an allowance of commissions and other charges, the manufactured goods of the latter, guaranteeing the sales of the goods and advancing thereon, in cash and acceptances and notes, as used in the course of dealing, to the amount of three-fourths of their value. It also appears that the agreement on the part of the judgment creditors was at all times fully performed; and that, at the commencement of their actions, they had paid for the avails of all the sales of goods which had matured up to that time, and had also advanced, in cash and the payment of matured notes and acceptances, the sum of \$149,062, over and above all matured sales and moneys received—the unmatured notes and acceptances being to a still much larger amount, and greatly exceeding the unmatured sales, as will be hereafter more fully seen.

Such appears to have been the state of the account between the parties at the commencement of the suits, as reported by the referees. According to their finding, there was a balance then due the judgment creditors, for over-advances, of \$149,062; and, such being the report, that sum must be taken

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to have been legally and properly recoverable by them at that time in the suits, unless it shall appear that claims were allowed which ought not to have been allowed, or payments or credits disallowed which ought to have been allowed.

We are not called upon to go into an examination of all the items in the accounts between the parties, but only of such, as we have before remarked, as raised some question of law which appears to have been presented by the report for the consideration and opinion of the Court. The matters of fact, upon which the questions arise, appear to be fully and distinctly stated; and, from these and other details in the report, I am free to say, that the proceedings of the referees, after a careful and somewhat critical examination of them, appear to me, as far as I can see, to evince no other purpose than that of a just performance of duty.

It appears that items in the account of the judgment creditors, very considerable both in number and amount, being objected to, were disallowed, and that several claims set up by the Mill Company, though objected to, were allowed. The only items of any importance in the account of the judgment creditors which were allowed against objections made to them, except one, which deserves a distinct consideration and will be presently mentioned, were for commissions and charges on goods sold, money paid, for the salary of the Mill Company's Treasurer, and money paid, at the request of the Company, for extra interest in raising money for its use, to enable it to meet and pay its accommodation drafts. These claims, on the facts stated in the report, do not appear to have been improperly allowed; and, as to the amount which ought to have been allowed upon them, that was a matter entirely within the province of the referees, and is not the subject of re-examination, at the instance of the plaintiffs or any one else, unless upon the ground of misconduct or gross partiality.

We come, then, to the item just alluded to, of \$46,912, charged by the judgment creditors who compose the present firm of Richardson, Burrage & Co., for money paid by them

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in discharge of a balance due from the Mill Company to the old firm of Richardson, Burrage & Co. The two firms are distinguished in this way: The old firm consisted of three partners; the new firm consists of four, two of the old partners and two new ones. The old firm was a large stockholder in the Mill Company, owning, it is stated, one-third of the whole stock, and acted, during its existence, under a mutual agreement, as the selling agent of the Mill Company. The new firm assumed and continued the business of the old firm, acting as the selling agent of the Mill Company under the same agreement, in place of, and under the same name and style borne by, the old firm. The facts in relation to the item in question, as stated in the report of the referees, are these: The Mill Company, by its Treasurer, requested the new firm, in other words, the judgment creditors, to pay and adjust the balance due the old firm and charge it, in their account, to the Mill Company. They did adjust it accordingly, and the old firm credited the Mill Company with the amount of the balance as received of the judgment creditors, and rendered their account to the Mill Company balanced by the credit in full.

On the facts thus stated, the transaction had the assent of all the three parties, and by it the Mill Company was discharged from its liability to the old firm, so that the latter had no longer any right of action against it; and, can there be any doubt that the Mill Company became a debtor to the judgment creditors for the amount, or that the amount might be recovered by them in an action for money had and received or money paid and advanced? If the transaction were to be considered rather as a transfer or assignment of the demand than as extinguishing the old debt and creating a new one, and the consideration paid had been something other than money, it would seem to bring the question as to the form of action, the demand being for money advanced, within the principle adopted in *Wilson v. Coupland*, (5 Barn. & Ald. 228,) recognized and confirmed in *Wharton v. Walker*, (4 Barn. & Cress. 163.) But, on the facts stated, it

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must be taken that the original debt was satisfied by actual payment and therefore extinguished ; and, from the acknowledgment of payment in general terms, it must be inferred that it was discharged by the payment of money or of what was equivalent thereto.

It is said that the Treasurer had no authority to give the assent of the Mill Company to any such transaction, or to bind it in any such way. But the Treasurer was not merely and simply the keeper of the moneys of the Company, according to the ordinary definition of such an office. He was its fiscal agent for other purposes. He was empowered by the directors to borrow money in the name and for the use of the Company ; and, was not the transaction in question, in substance and effect, if not in form, a borrowing of money for the use of the Company ? Besides, in addition to other duties, such as purchasing the materials to be used in manufacturing, directing the kinds of goods to be manufactured, and receiving all moneys due from agents and others, he had a general authority, given him by the by-laws, to pay the debts of the Company ; and, could he not pay a debt, or enter into an arrangement for the payment of a debt, in the manner in which this was done ? It appears to me that, in regard to this, no serious doubt can be entertained.

It is also said that the Treasurer was a partner, and therefore interested, both in the old and the new firm. So he was, and was so known to be by the Mill Company, not only when it appointed him Treasurer, and when it afterwards refused to accept his resignation of the office, but also when it made the firms its selling agents. With this knowledge, the Company could not be allowed to object, and, if so, no one else can object, that his connection with the firms disqualified him to perform the proper functions of Treasurer in this or any other matter in which they might have an interest growing out of the agency. If he had not so acted, the agency could not have been executed, but must have been discontinued, and the purpose of the contracting parties have been defeated. But, there was nothing in this particular transaction

that was wrong, in itself considered, or at all prejudicial to the interests of the Mill Company. It was simply a transfer of indebtedness from the old to the new firm, making the latter, instead of the former, whose place and business it had succeeded to in the agency, the creditor of the Company.

But, it is also to be remembered, as a fact not without its effect upon the question, that an account was rendered, stating the balance, the payment of it and by whom the payment was made. The account was rendered the 30th of September, 1848, and, no objection being made to the account as stated and balanced, the transaction may be deemed to have been acquiesced in. This is the rule of law in matters of account of a commercial nature, if not in matters of account in general; and there is no reason why it should not apply to a private corporate body engaged in trade and conducting its affairs through the instrumentality of officers and agents, as well as to individual natural persons carrying on similar business and transacting it either in person or through the agency of others. It may be added, that the equity of the claim is very apparent. The referees examined the account of the old firm, and found the balance which was paid it to have been justly due.

It is further insisted by the plaintiffs, that the judgment creditors had, previous to the commencement of their suits, sold on credit a large amount of goods consigned to them by the Mill Company, and that the amount of these sales, although the credit given upon them had not then expired, should have been allowed in payment or satisfaction of the claims composing the balance found then due.

It appears that sales had been so made to the amount of \$148,695; that the sales matured at different times from the 19th of July, 1849, to the 18th of January, 1850; and that the sales were credited in account, stating the times when due. It also appears that the judgment creditors had, previous to the commencement of their suits, given notes and accepted drafts for the Mill Company, to the amount of \$198,824, payable at different times from the 23d of May to

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the 11th of October, 1849, and that the notes and drafts, although not matured, were charged in account, mentioning, as in the case of the sales, the times of their maturity. It is evident that this mode of keeping the accounts, on the one hand crediting sales before matured, and on the other charging notes and acceptances before due and payable, or before paid, was merely for the sake of convenience and accuracy, and to present the transactions, as they occurred, in an intelligible form, and could not accelerate or in any way alter the legal liability of either party.

The judgment creditors were factors, selling goods for the Mill Company on commission; and it becomes a material question, whether a factor, in the case of a sale by him of goods on a credit, is, as the plaintiffs contend, instantly or immediately liable to the principal for the amount of the sales; or in other words, whether the principal has any legal right of action against the factor until the credit has expired. Whatever doubt may have once existed on the subject, I think the question is now settled, by judicial decisions and the opinions of eminent commentators on the law, both in England and in this country. It is established, that the undertaking of the factor is merely to answer for the *solvency* of the buyers of the goods, or, rather, to guaranty to the principal the payment of the *debts* due from the buyers. He becomes liable to pay to the principal the amount of the purchase-money, if the buyers fail to pay it when it becomes due. This is the effect and whole extent of his engagement. The doctrine is so laid down in all the adjudged cases, with few exceptions, and is recognized as the true doctrine by Chancellor Kent in his Commentaries, and by Judge Story in his Treatise on Agency. And I think it necessarily must be so, if the factor has authority to sell on credit, as he indisputably has, and if the principal may maintain an action against the buyers of the goods, which has been often adjudged and is nowhere denied.

Some confusion has arisen on this subject from the decisions on the question whether the undertaking of a factor is

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a contract within the Statute of Frauds, and so must be in writing. The better opinion is, that it need not be in writing; that, though a guarantee, it is not a *collateral* engagement, but an *original* and *absolute* one, that the prices for which the goods are sold, or the debts created by the sales of the goods, shall be paid to the principal when the credit given on the sales shall have expired. Thus, in a note summing up the law on the subject, in 1 *Amer. Lead. Cas.* 659, 660, it is said, that the contract is an *absolute* engagement by the factor, that the debts for which the goods are sold "shall be paid *at the time they are due*, or, in other words, that they shall be *cash* in the principal's account, *at the time they are due*."

The plaintiffs insist that the *lex loci* must govern the decision of this question; and, to show the law of the place where the contract was made and executed, they cite the case of *Swan v. Nesmith*, (7 *Pick.* 220.) In that case, the question was, whether the undertaking of the factor was within the Statute of Frauds. The Court held the liability to be original, and that a guarantee of that nature need not be in writing. But they expressly admitted that, when the goods are sold upon credit, the liability of the factor is not fixed until the time of payment arrives. The case, therefore, so far as it has any application to the present question, is an authority against rather than for the plaintiffs. But, if it was otherwise, it could not be allowed to prevail against the general and what I conceive to be the established rule of commercial law. In *Swift v. Tyson*, (16 *Pet.* 1,) it is laid down, that the true interpretation and effect of contracts and other instruments of a commercial nature, in suits in the Courts of the United States, are to be sought, not in the decisions of the local tribunals, but in the general principles and doctrines of commercial jurisprudence.

From what has been said, it follows that the judgment creditors, at the time of the commencement of their suits, were not chargeable for the sales of goods made by them before that time, but due and payable at different times after-

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wards, beyond the amount, at any rate, of what they were bound by their agreement to advance upon them. To that extent, the advances might be treated as payment in advance of so much towards the goods, and so far the one might be set off against the other. But all moneys advanced on account, beyond the amount agreed to be advanced upon the goods, would constitute a present legal debt, for which there would be a present legal right of action. We have already seen the extent of the difference existing in favor of the judgment creditors at the commencement of the suits, between the amount of sales then matured and the amount of moneys then actually advanced, and also between the aggregate of unmatured sales and the aggregate of unmatured notes and acceptances. It does not appear what portion of the advances stipulated to be made was to be in ready money, and what portion in notes and acceptances on time; but, it is to be inferred from the report, that the advances were made, both in point of form and time, according to the calls of the Mill Company, and in such manner as suited its wants and wishes. If the Company procured and had the benefit of the advances, it is thereby precluded from objecting to them as not answering the agreement, whatever may have been the form in which they were made. Considering the unmatured notes and acceptances, therefore, as satisfying the agreement as to advances upon the unmatured sales, the judgment creditors had, at the commencement of their suits, arising from over-advances, an actual unpaid and unsatisfied balance due them from the Mill Company of \$149,062, which they then had a legal right to sue for and secure by attachment of the property of the Company. Indeed, upon any adjustment, or any appropriation of the advances to the sales, not directly at variance with the agreement and the practical construction put upon it by the acts of the parties, the balance at that time would greatly exceed what was ultimately recovered in the suits.

But, it is said that, when the sales in question matured, if not before, especially when the money was received upon

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them, they operated as payment of so much of the claims for which the suits were brought, and should be so treated. Whether this be so or not, will be readily seen by recurring to the facts. The money on these sales became due at different times from the 19th of July, 1849, to the 18th of January, 1850. On the credit of these sales, the judgment creditors had, previous to the commencement of their suits, given notes and accepted drafts for the Mill Company, not only amounting to a sum much larger than the amount of the sales, but payable at different times from the 23d of May to the 11th of October, 1849, much earlier than the money on the sales would become due. For these notes and acceptances, the judgment creditors had a lien on the goods, and, of course, on their proceeds. Was it not, therefore, legal, as well as just and equiabtle, that the money arising from the sales should be applied, as it became due, in satisfaction of the advances the judgment creditors were obliged to make in payment of the notes and acceptances as they fell due? The application was so made; and I have no doubt that it was in accordance both with the usage in such cases and with law.

The referees, it appears, allowed all payments made by the Mill Company, arising from sales or otherwise, down to February 15th, 1851, when the accounts between the parties closed, deducting from the sales, advances, commissions, and other proper charges upon them; and it was by the allowance of such payments, and the withdrawal by the judgment creditors of their claim for three-fifths notes, that the balance due them at the commencement of their suits was reduced down to the sum recovered by the judgments. In this way, the balance of the subsequent account between the parties was ascertained and allowed, not to the prejudice but to the benefit of the plaintiffs.

I have thus noticed, in a summary way, all the material facts and points connected with the merits of the case; and, upon consideration of the whole, I am of opinion, that the plaintiffs have no claim in equity to have the property relieved, either wholly or partially, from the lien created by

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the attachments, or from the enforcement of the lien by execution of the judgments, and, consequently, that the injunction moved for ought not to be granted.

Motion denied.

CHARLES SUYDAM AND OTHERS

vs.

WILLIAM P. EWING AND GEORGE W. EWING.

In a common law action, in the Circuit Court for the Southern District of New York, the assignee of a non-negotiable contract has no capacity to sue upon it in his own name; the provision of the State Code of Procedure, requiring every suit to be brought in the name of the real party in interest, not having been adopted by that Court.

And this practice applies not only to an action originally commenced in that Court, but to one removed into that Court from a Court of the State, and to all the proceedings in such action after its removal.

Accordingly, where a debt was contracted with a copartnership, and afterwards the interests of some of the members of the copartnership in the debt were assigned, and then a suit at law was brought thereon in a Court of the State, in the names of the real parties in interest, and was removed into the Circuit Court for the Southern District of New York, and afterwards one of the partners died: *Held*, that the suit must be continued in the Circuit Court in the names of the surviving partners, without any reference to the real parties in interest.

(Before NELSON and BETTS, JJ., Southern District of New York, January 27th, 1852.)

THIS was an application, on behalf of surviving plaintiffs in three suits, for leave to revive and prosecute two of them in the names of Francis P. Sage, Ferdinand Suydam, Jr., and Charles Suydam, or in the names of Charles Suydam, and of Samuel S. Whitney, assignee of Francis P. Sage and Ferdinand Suydam, Jr., and the third in the names of Francis P. Sage, Henry L. Suydam, Ferdinand Suydam, Jr., and Charles Suydam, as surviving partners of the firm of Suydam, Sage & Co., or in the names of Charles Suydam, and of Samuel S. Whitney, assignee of Francis P. Sage and Ferdi-

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nand Suydam, Jr., and of Henry S. Wyckoff and Charles Suydam, executors of the last will and testament of Ferdinand Suydam, deceased. The facts were these: The defendants became indebted to the firm of Suydam, Sage & Co. in the sum sued for in the last-named cause, that firm being at the time composed of Ferdinand Suydam, Francis P. Sage, Henry L. Suydam, Ferdinand Suydam, Jr., and Charles Suydam. The other two actions were brought to recover balances due on debts contracted with the firm of Suydam, Sage & Co. when composed of Francis P. Sage, Ferdinand Suydam, Jr., and Charles Suydam. Prior to August 6th, 1850, Henry L. Suydam, Francis P. Sage and Ferdinand Suydam, Jr., assigned to Ferdinand Suydam all their interest in the said several debts. In November, 1850, the said suits were instituted in the Supreme Court of the State of New York, in the names of the real parties in interest, and attachments were issued therein and served on persons in the State of New York who had in their possession effects and credits of the defendants, in such manner as to bind those effects and credits. Each suit demanded over \$500, exclusive of costs. The plaintiffs were citizens of New York, and the defendants were citizens of another State. In March, 1851, the suits were all of them duly removed by the defendants into this Court, the appearance of the defendants in this Court was perfected, and the suits were pending in this Court. After the removal of the causes into this Court, Ferdinand Suydam died, and Henry S. Wyckoff and Charles Suydam were duly appointed his executors. The other members of the respective firms with which the debts sued for in the several actions were contracted, were still surviving. The Supreme Court of New York appointed Samuel S. Whitney, assignee of Francis P. Sage and Ferdinand Suydam, Jr., in place of Ferdinand Suydam, deceased.

Samuel L. M. Barlow, for the plaintiffs.

Benjamin F. Butler and *Hiram Barney*, for the defendants.

BETTS, J. The practice of the State Courts has been

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changed by a recent Act of the Legislature, so that suits must now be brought in the name of the real party in interest. (*Laws of New York, Sess. 1849, chap. 438, § 111.*) Prior to that statute, the rule of proceeding in that respect was founded upon the practice of the King's Bench in England, and required actions to be brought in the name of the party in whom the legal interest was vested. (1 *Dunlap's Pr.*, 36; *Graham's Pr.*, 59; 1 *Chitty's Pl.*, 16, 17; 1 *Tidd's Pr.*, 7.)

The United States Courts follow the same rule, except where the assignee is authorized to sue in his own name by the custom of merchants or by statute. (*Winchester v. Hackley*, 2 *Cranch*, 342.)

The rules of the United States Supreme Court adopt for the Circuit Courts the practice of the English King's Bench, leaving to those Courts the power to regulate the subject at their discretion. (*Rule 7 of Supreme Court, August, 1791; Acts of September 29th, 1789, and May 8th, 1792, 1 U. S. Stat. at Large, 93, 275.*) The standing rules of this Court adopt the practice and modes of proceeding in force in the Supreme Court of the State of New York in 1838, in cases not regulated by express rule of the Circuit or District Court. (*Circuit Court Rule 102; District Court Rule 240.*)

Under this state of the law governing this Court in common law cases, the assignee of a contract has no capacity to sue upon it in his own name, unless it be negotiable in its nature. The action must be brought in the name of the person with whom the contract was made, or by his legal representatives in case of his decease.

In these causes, there are surviving members of the co-partnerships with which the debts were contracted. The right of action has devolved upon the survivors, and suits for the debts can be maintained only in their names. The change made by the New York Code of Procedure, in respect to the competency of parties to sue in their own names, when they are the ones having the real interest in the matter in controversy, does not apply to the United States Courts, and cannot affect their course of practice until it is recognized

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and adopted by them. (*Wilcox v. Hunt*, 13 *Peters*, 378; *Anonymous*, 1 *Peters' C. U. R.* 1.) In each of these causes, the debt sued for was contracted with a copartnership, members of which are surviving. The well-settled rules of pleading require actions for such demands to be prosecuted in the names of the surviving partners, whoever may be interested in the amounts after their recovery. (1 *Chitty's Pl.*, 12; *Bernard v. Wilcox*, 2 *Johns. Cases*, 374; *Holmes v. D'Camp*, 1 *Johns.* 34.)

The proceedings in this Court, after the transfer of the causes, must be the same as if the suits had been originally commenced here, and, accordingly, the declarations filed here must be in the names of the respective surviving partners, and must conform in structure to our modes of pleading. The plaintiffs are entitled to have orders entered for the continuance of the causes in such names, without prejudice to the attachments levied in the Court below in the causes as there instituted and entitled.

EDWIN C. LITTLE AND OTHERS

vs.

ANTHONY GOULD AND OTHERS. IN EQUITY.

The State Reporter, Mr. Comstock, by whom the third volume of Comstock's Reports of cases argued and determined in the Court of Appeals of the State of New York was prepared, was the author of that volume, within the copyright Act of February 8d, 1831, (4 *U. S. Stat. at Large*, 436.)

Under the Acts of the Legislature of New York of April 11th, 1848, and April 9th, 1850, in relation to the Reports of the decisions of the Court of Appeals, the interest of the Reporter in said third volume, as an author, passed to the Secretary of State, in trust for the benefit of the State, and it was competent for that officer to take out a copyright for the volume under said Act of February 8d, 1831.

The words, "any notes or references," in the Act of April 9th, 1850, embrace the head-notes and marginal notes of the Reporter, together with the arguments of counsel and the cases cited therein.

Where, under said Acts of the Legislature of New York, a contract was entered into by the State officers with A., to publish the volumes which should be

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prepared by the Reporter, and the contract declared that it was intended to operate as an assignment of the copyright: *Held*, that A. was, as assignee of the copyright, entitled to a remedy by injunction for its infringement.

Held, also, that A.'s right was not affected by the provision in the 22d section of the 6th article of the Constitution of New York, that all "judicial decisions shall be free for publication by any person."

(Before NELSON, J., Northern District of New York, April 2d, 1852.)

THIS was a motion, after answer, to dissolve the provisional injunction granted in this case, (*ante*, p. 165.) The facts are sufficiently stated in the opinion of the Court.

NELSON, J. This is a motion to dissolve an injunction heretofore issued against the defendants, restraining them from publishing or selling the third volume of Comstock's Reports of cases argued and determined in the Court of Appeals of the State of New York.

The plaintiffs claim to be the proprietors of the copyright of this work, as assignees of the State, and, as such, to be entitled to the exclusive privilege of printing, publishing and vending the same. The injunction was originally granted on this ground, and the same is now urged against the motion to dissolve it, which is made after the coming in of the answer.

The Act of Congress passed February 3d, 1831, (4 *U. S. Stat. at Large*, 436,) confers the proprietorship of a book upon any citizen of the United States, or resident therein, who shall be its author, and who shall have complied with the requisites of the Act, and upon the executors, administrators or legal assigns of such person. This Act was passed in pursuance of the eighth clause of the eighth section of the first article of the Constitution of the United States, which declares that Congress shall have power "to promote the progress of science and useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." The simple question, therefore, upon this motion is, whether or not the plaintiffs have made out a title to the copyright of the volume in question, as assignees of the same. If they have, the injunction should be retained; otherwise, not.

That Mr. Comstock, the Reporter, is the author of the book, within the meaning of the Act of Congress, is a matter not to be controverted. It was conceded throughout the case of *Wheaton v. Peters*, (8 *Peters*, 591,) that Mr. Wheaton was entitled to the copyright of his Reports, as author; and the only question was, whether he had secured the right by a compliance with the requisites of the statute. A majority of the Court, entertaining doubts upon this question, as the facts appeared before them in the record, remanded the cause, with directions to the Court below to inquire whether or not these pre-requisites, as determined in that case, had been complied with. The only exception to this view was in respect to that part of the work which embraced the written opinions of the Judges. They were regarded as having become the property of the public, and, therefore, as not the subject of a copyright.

The copyright of the work in question was taken out not by Mr. Comstock, the author, but by Christopher Morgan, Secretary of the State, claiming to have become the assignee of the author, in trust for the State. A printed copy of the title was deposited in the office of the clerk of the District Court, on the 20th of November, 1850, in pursuance of the Act of Congress; and, within three months after the publication of the book, copies were deposited with the clerk, with the librarian of the Smithsonian Institution, and with the librarian of the Congress library.

By an Act of the Legislature of the State of New York, passed April 11th, 1848, (*Laws of 1848, chap. 224*), amending a previous Act on the subject, it was provided, among other things, that the Reporter of the decisions of the Court of Appeals should have no pecuniary interest in the Reports, and that the same should be published under his supervision, by contract to be entered into by the Reporter, the Secretary of State and the Comptroller, with the person or persons who, in addition to furnishing the Secretary of State with sixty-four copies of each volume, should agree to publish and sell the same to the public at a price not exceeding three dollars

per volume. This Act also provided (§ 3) that it should not be lawful for the Reporter or any other person within the State to obtain a copyright for the said Reports, notes or references, but that the same might be published by any persons. By an Act passed April 9th, 1850, (*Laws of 1850, chap. 245*), this section was amended so as to read as follows: "It shall not be lawful for the Reporter, or any other person within this State, to secure or obtain any copyright for said Reports of the judicial decisions of the Court of Appeals, but the same may be published by any person;" and the following section was added: "The copyright of any notes or references made by the State Reporter to any of said Reports shall be vested in the Secretary of State, for the benefit of the People of this State." The Reporter was made a State-officer, with an annual salary as a compensation for his services.

On the 20th of April, 1850, the Reporter, the Secretary of State and the Comptroller, in pursuance of the Act of the Legislature, already referred to, entered into a contract with the plaintiffs for the publication of the Reports for the term of five years, and also for the exclusive benefit to them of the copyright of the same to be taken out on behalf of the State, and the said contract was declared to be intended to operate as an assignment and transfer of the copyright.

In pursuance of this agreement, and since the taking out of the copyright of the work by the Secretary of State, the plaintiffs have entered upon the printing and publication of the volume of Reports in question, have published the same, and have put copies of it on sale at a price not exceeding two dollars and fifty cents each.

Upon this state of the case, I am of opinion that the interest of the Reporter in this third volume of his Reports, as an author, passed to the Secretary of State, in trust for the benefit of the State, and that it was competent for that officer to take out the copyright in pursuance of the provisions of the Act of Congress of 1831, securing to the State the exclusive right of proprietorship in the work. The Reporter must be deemed to have accepted the terms and conditions of the Acts of the

Legislature of April 11th, 1848, and April 9th, 1850, the effect of which was to vest the interest in the State, he receiving a compensation for his labors by way of annual salary.

It has been argued, by the counsel for the defendants, that the copyright in this case is void, on the ground that no authority is given by the Act of Congress of 1831 for taking out the copyright in the name of a trustee, for the benefit of another. But, it may be answered, that there is nothing in the Act forbidding it. The party to whom the assignment is made, whether for the benefit of another or not, holds the legal interest in the work, as assignee of the author, and comes, therefore, within the very words of the law entitling him to the copyright. Whether a third person has an equitable interest in the work, derived from the author or from the legal assignment, is a question between those parties, in respect to which I do not see that the public interest or policy is at all concerned. The Courts will take care of those equitable interests. The legal assignee of the author is competent to take out the copyright, and the Secretary of State must be regarded as standing in this position, under the Act of the Legislature of April 9th, 1850.

It has also been argued, that the Act of 1850 did not vest in the Secretary of State the right of the author of the Reports to its fullest extent, but only his interest in any notes and references made by him to the Reports, thereby excluding the Reports themselves, as understood in the ordinary acceptation of that term, with head-notes and arguments of counsel. There is certainly much force in this argument, and, in my judgment, it presents the only real difficulty in the case. But, on looking at the course of the legislation of the State on this subject, (there have been three Acts passed in relation to it,) I have come to the conclusion that the phrase, "any notes or references," in the connection in which it is found, may be fairly construed as embracing the head-notes and marginal notes of the Reporter, together with the arguments of counsel and the cases cited therein.

The third section of the Act of April 11th, 1848, prohibited the Reporter, or any other person within the State, from obtaining a copyright of the Reports, notes or references, and declared that the same might be published by any persons. This provision was absurd enough in connection with the system prescribed in the same Act for the publication of the Reports, which made it the duty of certain public officers to contract for the printing and publishing with the person who, in addition to furnishing the State with sixty-four copies of each volume, would agree to sell the volumes most advantageously to the public, and at a rate not exceeding the price of three dollars per volume. The idea of obtaining such a contract from a person to whom the benefit of a copyright was denied, is at least remarkable, for the third section covered the whole ground. Any person could republish the volume, with all the notes and references, as soon as it came from the hands of the Reporter.

The Act of April 9th, 1850, was designed to correct this oversight. That prohibits a copyright for the Reports of the *judicial decisions* of the Courts of Appeal, and allows the same to be published by any person. But it vests the copyright of any notes or references made by the Reporter to said Reports, in the Secretary of State, for the benefit of the People of the State, thus securing to the State the labors of the Reporter, which he might otherwise have secured to himself under the copyright Act, as the author.

To construe the amendment made by the Act of 1850 as simply securing a copyright for any annotations or foot-notes the Reporter might choose to make, in the course of reporting the decisions, such as are common in the nine volumes of the Reports of the Supreme Court of this State by the late learned and laborious Judge Cowen, and nothing more, would leave the Act of 1850, in respect to the system of reporting, with very little if any advantage over that of 1848. For, whether there would be annotations or foot-notes by the Reporter, accompanying the volumes, or not, would depend not upon any obligation or duty on his part, but upon his mere discretion

or convenience. Besides, these notes are incidental matters, and, although frequently valuable, constitute no part of the Reports of the decisions of the Courts. Hence, securing the copyright of them to the State would have been of trifling importance, by way of enabling the public officers to contract for the printing and publication of the volumes of Reports agreeably to the terms and requirements of the statute.

The Legislature of 1850 saw the error into which that of 1848 fell in attempting to provide for a cheap publication of the Reports, and designed to correct it, and have accomplished their purpose, if the view I have taken of the Act of 1850 is well founded. But, if the counsel for the defendants is right in his construction, they have utterly failed to accomplish it, and have left the system of reporting as impracticable and absurd as they found it. For, according to that construction, the whole amount of the amendment or alteration is to enable the public officers to secure to the publishers the exclusive right to the annotations or foot-notes, if any, made by the Reporter, leaving the volumes of Reports, with the head-notes, arguments of counsel, &c., free to a republication by any person. I do not think that the language used in the Act, although it is obscure and not well chosen to express the intent of the Legislature, necessarily leads to such a construction. If not, such a construction should certainly not be admitted.

I have not deemed it necessary to look particularly into the true construction of the provision of the Constitution of this State to which reference has been made. (*Art. 6, sec. 22.*) The right of the plaintiffs rests exclusively upon the Act of Congress, which confers a copyright upon authors, and also upon their assignees, who have complied with its provisions. The right is derived under this Act, and is not at all dependent upon or affected by the provision of the State Constitution. If the plaintiffs are the assignees of the volume in question, by title derived from the author, they have a right to the protection of this Court, and no provision of the State Constitution can deprive them of it. If they are

not such assignees, then the Act of Congress has no application to this case, and, consequently, this Court has no jurisdiction of this case. For, whatever may be the rights of the respective parties under the Constitution and laws of the State, this Court has nothing to do with them. The questions on which such rights depend belong to the State tribunal and depend upon State laws. This Court does not interfere with them, unless in cases of jurisdiction on account of the citizenship of the parties; and then it administers the laws of the State. I am free to say, however, that, in my judgment, the provision of the State Constitution was not designed to confer upon any person the right to republish the Reports of judicial decisions, whether published under the authority of the State or by individuals, but was designed to secure the right to report and publish the decisions of the Courts, to all persons who might choose to undertake the business, unembarrassed by any exclusive monopoly in consequence of State legislation.

The interest of the plaintiffs in the copyright, as derived under the contract with the State officers, whether regarded as a legal or as an equitable interest in the same, is sufficient to entitle them to the remedy claimed.

There are some other questions raised in the case which would deserve a consideration, if this were an original application for an injunction. As the injunction has already been granted, and this motion is to dissolve it, I have deemed it best to confine my opinion to the legal rights involved in the case.

The motion to dissolve the injunction must, therefore, be denied.

JOHN WOOD, JR., vs. PHILO A. MATTHEWS.

When a cause is removed from the State Court into the Circuit Court of the United States, under the provisions of the 3d section of the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 683,) as having been commenced against an officer of the United States, for an act done under the revenue laws of the United States, or under color thereof, the question whether the property for the taking of which the action was brought was seized by the defendant in the performance of his duty as an officer of the customs under the revenue laws, is a matter of fact involved in the merits of the case, and cannot be raised or determined upon a motion to dismiss the suit.

The Act of Congress gives the jurisdiction and right of removal "in any case" falling within the particular class of cases provided for, without any regard to the amount in controversy in the suit. Hence, no question can be raised in the Circuit Court based upon the trifling value of the property for the taking of which the suit was commenced.

(Before PRENTISS, J., Vermont, May, 1852.)

THIS was an action originally commenced in one of the subordinate Courts of Vermont, held by a Justice of the Peace, and was removed into this Court, at the instance of the defendant, by a writ of *habeas corpus cum causa*, under the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 633, § 3.) It was an action of trespass for taking and detaining a certain horse belonging to the plaintiff. After its removal, the plaintiff appeared and filed a motion to dismiss the case for want of jurisdiction, alleging that the cause of action did not proceed from, nor the action bring in question, any act or thing done by the defendant as an officer under the revenue laws of the United States, and that the damages demanded, being only ten dollars, were too small and inconsiderable to be the subject of adjudication in this Court.

D. A. Smalley, for the plaintiff.

C. W. Prentiss and *L. Underwood*, (*District Attorney*), for the defendant.

PRENTISS, J. The removal of the cause to this Court, and the jurisdiction of this Court over it, are regulated by, and dependent entirely upon, the provisions of the Act of Congress of March 2d, 1833, (4 *U. S. Stat. at Large*, 633, § 3,) passed in pursuance of the clause of the Constitution which declares, that the judicial power of the United States shall extend to all cases in law and Equity arising under the Constitution, laws or treaties of the United States. After giving, in general terms, jurisdiction to the Circuit Courts in all cases arising under the revenue laws, the Act provides that, "in any case where suit or prosecution shall be commenced in a Court of any State, against any officer of the United States, or other person, for or on account of any act done under the revenue laws of the United States, or under color thereof," &c., "such officer or other person may, at any time before trial, remove the cause into the Circuit Court for trial."

The Act prescribes the mode of removal and what shall be necessary to effect the removal. There must be a petition to the Circuit Court, setting forth the nature of the suit; an affidavit, verifying the petition; and a certificate, signed by an attorney or counsellor-at-law, stating that, as counsel for the petitioner, he has examined the proceedings against him, and has carefully inquired into all the matters set forth in the petition, and that he believes the same to be true. The petition, affidavit and certificate being presented and filed, "the cause," as the Act declares, "shall, thereupon, be entered on the docket" of the Circuit Court, "and shall be thereafter proceeded in as a cause originally commenced in that Court."

The Clerk of the Circuit Court is, thereupon, to issue a writ of *certiorari*, or a writ of *habeas corpus cum causa*, as the case may require, which shall be served in the manner prescribed by the Act. And the Act then proceeds to say that, thereupon, it shall be the duty of the State Court to stay all further proceedings in the cause, and that the suit, upon the service of such writ of *certiorari* or *habeas corpus*, shall be deemed and taken to be moved to the Circuit Court,

“and any further proceedings, trial or judgment therein, in the State Court, shall be wholly null and void.”

The action, when thus removed here, is to be proceeded in as a cause originally commenced in the Circuit Court. But any action in this Court, either original or removed, may be dismissed upon motion founded upon proper matter, and showing that the Court has not jurisdiction of the case or that it was irregularly brought here. If the property sued for in the present action was of such a nature as not to be liable to seizure under the revenue laws of the United States under any circumstances, it might, perhaps, be said to be apparent, that the case does not come within the Act of Congress, and, on that assumption, supposing it to be well founded, the cause might properly be dismissed on motion, and be remanded to the State Court. But horses are not only property subject to duty, and liable to seizure on being imported contrary to the provisions of law, but become forfeited when ever employed as the means of transporting or bringing into the country any goods illegally imported; and, whether the horse in question was in truth seized and taken by the defendant in the exercise of his functions and performance of his duty as an officer of the customs under the revenue laws, as set forth in his petition for the removal of the cause, is a matter of fact belonging to and forming a part of the merits of the case. It is involved in the inquiry whether the taking and detention were lawful and justifiable, and must be determined, not in a summary way, on motion and affidavits, contradicting and denying the facts so stated and verified in the requisite form, but on trial of the merits in the usual course of proceeding.

As to the inconsiderable value of the property sued for, or the small amount of damages demanded in the action, it is sufficient to say, that jurisdiction and the right of removal are given “*in any case*” falling within the particular class of cases provided for, without any regard to the amount in controversy in the suit. We can, therefore, make no distinction between a suit involving much and a suit involving lit-

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tle, because the Act makes none. Nor can we, for the same reason, go into any considerations of expense or inconvenience to the parties, as compared with the amount in controversy. These are all matters of legislative rather than of judicial cognizance. It may be observed, however, that, though the property be of small value, the principle or question of authority involved in the case may be important, and such as ought to be decided by the National rather than the State judiciary. It may also be added, that the jurisdiction of Justices of the Peace being, by the State law, final, where the sum demanded in damages does not exceed ten dollars, officers of the customs, unless cases so brought against them before these inferior local tribunals are liable to be removed into this Court for trial, might, if not deterred from the performance of their duties, be made the victims of vexatious suits and unjust judgments.

The proceedings in removing the cause appearing to be in all respects in conformity with the Act of Congress, and the case consequently being regularly and rightly in Court, the motion to dismiss must be overruled, leaving the plaintiff, of course, no alternative but that of prosecuting the action here or becoming non-suited.

HIRAM YOUNG AND EDWARD LEAVITT

vs.

SAMUEL COLT. IN EQUITY.

A defendant in a suit in Equity founded on the infringement of a patent, can not, by a cross-bill which sets up no color of title in himself, demand a discovery from the plaintiff in the original suit as to the source or validity of his title.

It is essential to a bill of discovery that it should set forth a title sufficient to support or defend a suit, and pray a discovery pertinent to that title and nothing beyond.

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And, where it cannot be sustained as a bill for discovery, it cannot be retained for the purpose of relief, unless it makes a case for relief independently of the discovery sought.

(Before BETTS, J., Southern District of New York, May 14th, 1852.)

THIS was a demurrer to a cross-bill. The facts are stated in the opinion of the Court.

Seth P. Staples and *Robert Emmet*, for the plaintiffs.

Edward N. Dickerson, for the defendant.

BETTS, J. The specific points presented for adjudication in this case arise on a demurrer to a cross-bill filed by the plaintiffs, but the discussion has also involved an examination of the original bill and answer, and it has thus become necessary to advert to the case made by the entire pleadings.

The original bill was filed November 19th, 1851, by Colt, as patentee, for an injunction and other relief against Young and Leavitt, for alleged violations of his patent right. It avers that the patentee, before the 25th of February, 1836, invented a new and useful improvement in fire-arms, and that, on that day, Letters Patent were duly issued to him for his invention, and that he was the first and original inventor thereof. On the 28th of October, 1848, he surrendered the patent to the Commissioner of Patents, because of a defective claim or description of his invention in the specification, and a re-issue of the patent was made the same day, for the complement of the original term of fourteen years. Previous to the expiration of that term, the patentee applied for and obtained, on the 10th of March, 1849, from the Commissioner of Patents, an extension of the patent for seven years beyond the period of its expiration, and the order for extension was duly indorsed on the patent. The bill charges that the defendants have infringed and violated the patent right since such extension, and continue to infringe and violate it.

On the 26th of December, 1851, the defendants filed their answer to the bill, denying that the patentee was the first

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and original inventor of the improvement, and that the patent was legally re-issued and extended, and that the patentee has any interest in the patent, and averring that he had sold and assigned his entire title and interest therein to the Massachusetts Arms Company.

On the same day, the defendants in the original bill filed a cross-bill against the patentee, for discovery and relief. That bill seeks from the patentee a discovery of the time and place when and where he made his discovery and first manufactured any fire-arm under the patent, and whether he sued any person, during the first term of his patent, for infringing it, or made any claim against any one therefor. It also demands a discovery of the proceedings had in the Patent Office in obtaining an extension of the patent, and whether the application was submitted to the Secretary of War for his opinion thereon ;* and also a discovery of the proceedings before the Commissioner of Patents subsequently to the Act of May 27th, 1848, and whether notice of application for the extension was published, or was given by the patentee to any person. The bill further prays that, when the discovery shall be made, the Court may decree the order extending the patent to be inoperative and void, and that the patent expired on the 25th of February, 1850, and also grant a perpetual injunction restraining the patentee from commencing any action at law or in Equity for any infringement of the patent since the 25th of February, 1850 ; and that the Court may declare the patent to be void, and may order it to be delivered up to be cancelled. A prayer for general relief is also appended.

The defendant files a general demurrer to this bill.

Upon the averments of the original bill, the plaintiff therein has clearly a *prima-facie* title to the thing patented, and the legal presumption in his favor is, that he had complied with all the requirements of law which are necessary to render his title complete. (*Phillips on Pat.*, 407 ; *Webster's Pat. Cases*, 129 ; *Curtis on Pat.*, §§ 30, 39 ; *Phila. and Trenton Railroad Co. v. Stimpson*, 14 *Peters*, 448.)

The answer of the defendants to the original bill denies that the patentee is the first inventor or has acquired a valid patent. This answer will enable them to disprove any title or right of the plaintiff under the grant, or compel him to support it by evidence *aliunde* the patent. The scope and design of the cross-bill is to make that defence by means of evidence extracted from the patentee, and the demurrer interposed to that bill raises the question, whether the defendants in the original suit have a legal right to demand disclosures from the patentee which might show that he had no valid title to his patent.

It is to be remarked, that the defendants in the original suit do not take their defence in their answer, or file their cross-bill, under any color of title. They neither claim to be prior inventors or to hold by assignment the elder right of any other person. If not naked intruders or trespassers upon the possession of the patentee, they stand upon no higher ground than the allegation that the grant of the Government to him is void, and they present this bill to support that assertion. This is engrafting a novel function upon the office of a cross-bill.

The broad principle upon which a cross-bill is allowed is, that Equity should give suitors a common advantage in its processes. As it compels a defendant to make disclosures and discoveries under oath, to aid an action against him, so should it secure mutuality in this privilege, by allowing a defendant to become a plaintiff and compel his adversary, in particular cases, to make disclosures and discoveries of matters within his knowledge that are serviceable to the defence. The parties, to that end, alternate places, in order that each may have the same use of the powers of the Court for the same object. A cross-bill, as its name imports, goes no further than to give the party filing it the reciprocal right enjoyed by the complainant in the original bill, in respect to their mutual title or interest in the subject-matter of the suit. (*Story's Eq. Pl.*, §§ 389, 390.)

The English and American authorities are clear and nearly

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invariable in respect to the legitimate office of a bill of discovery. It is essential to a valid bill of discovery that it set forth a title in the party which is sufficient to support or defend a suit, and that it pray a discovery pertinent to that title and nothing beyond. (*Story's Eq. Pl.*, §§ 317 to 320; 2 *Story's Eq. Jurisp.*, § 1,490; *Wigram on Discovery*, 15; *Phillips v. Prevost*, 4 *Johns. Ch. R.* 205; *Van Kleeck v. The Reformed Dutch Church*, 6 *Paige*, 600; *S. C.*, in error, 20 *Wend.*, 457.) I find but one case (*Adams v. Porter*, 1 *Cushing*, 170) in which a disposition is indicated to extend to a plaintiff in a cross-bill a wider privilege. That case might seem to authorize such plaintiff to place, in effect, the defendant on the stand, and examine him as to all matters applicable to the defence. But the same Court, in a subsequent case, (*Haskell v. Haskell*, 3 *Cushing*, 540,) concedes that the general principles of Equity law would not favor such a rule, if it is declared in that decision.

Considering the cross-bill in this case as a bill of discovery, the defect is vital to it, that it rests on no title in the parties filing it, either in common with or hostile to the patentee. It is contrary to all principles of Equity pleading, to permit a party who has no right himself to a subject-matter in dispute, to subject the one who shows a *prima-facie* title to it to interrogatories as to the source or validity of that title. Bills framed on that ground are always rejected as fishing, or as attempts to pry into an adversary's title, and as transcending the privilege granted to a suitor to draw from his adversary facts tending to support his own title. It is sufficient to refer to the elementary books, in which this doctrine is stated and amply supported by authority. (*Harrison's Ch. Pr.*, 115; *Mitf. Eq. Pl.*, 189, 190; *Cooper's Eq. Pl.*, 58; *Wigram on Discovery*, 90, 93, 99; *Hare on Discovery*, 196, 197; *Story's Eq. Pl.*, §§ 324, 571; 2 *Story's Eq. Jurisp.*, § 1,490; *McNaughton's Select Cases*, 10, 58 *Law Lib.*, 24.) An article in 13 *London Jurist*, 52, gives a learned and able exposition of the late English cases on the subject.

As the defence which the cross-bill is designed to main-

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tain has relation to the weakness of the plaintiff's title, and not at all to any title set up on the part of the defendants, it cannot be sustained as a bill of discovery. But it is contended that, as the bill prays relief as well as discovery, it will be retained for the purpose of relief, although the discovery be denied. This may undoubtedly be so in cases where the bill makes a case for relief independently of the discovery sought for. But, in the present case, the relief asked is to be a consequence of the discovery. The specific relief prayed for is a perpetual injunction against the patentee and his assigns from bringing any suits in Equity or at law for infringements of the patent, and a decree declaring the patent void and that it be delivered up to be cancelled. An injunction against the patentee is also prayed, restraining him from continuing suits he has already commenced in the District of Columbia, against the defendants, for violating the patent. General relief is also prayed, but the counsel for the defendants admitted on the argument that they could point out no other relief appropriate to their case than what the bill specifies.

Without discussing the question of the competency of the Court to give the description of relief sought for by the bill, in protection of a party who shows a title to the patent right in himself, I think that the principle upon which the first point is decided must also govern these demands in the cross-bill, and that, as the plaintiffs therein do not set up any color of right or title in themselves to the patented invention, and seek to defend themselves against the action of the patentee for infringement of his patent, only by evidence to be extracted from him showing the weakness of his title, they are not entitled to any injunction or interference of the Court in their behalf, the supposed evidence to support that claim being denied them by the Court. Their equity upon their bill is, that the patentee will discover, in his answer to the bill, that he has no valid patent, and that that evidence, when given, will entitle them to be relieved of all suits and prosecutions in his behalf. The Court having denied their

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right to the evidence, the supposed equity to flow from it has no legal existence and affords no cause for upholding the bill.

The other claim, that this Court shall enjoin the patentee from bringing actions against any parties whomsoever, and direct the patent to be cancelled, does not seem to be a ground of equity upon which the plaintiffs in the cross-bill can demand the interposition of the Court. They have no authority to bring the bill for any other matter than what is connected with their individual rights and interests.

The demurrer must be allowed, with costs.

JOSEPH RITTER AND WILLIAM C. KNEELAND

vs.

ALFRED T. SERRELL AND OTHERS. IN EQUITY.

Where W. granted to V. an exclusive right to construct and use and vend to others to construct and use ten *planing, tonguing and grooving* machines under the Woodworth patent within a particular territory, and the grant declared that V. was to enjoy an exclusive use of the patent within the territory, limited to said ten machines: *Held*, that the entire interest in the patent for that territory was thereby vested in V., and that a subsequent grant by W. to R. of the exclusive right under the patent, for the same territory, to make, use and vend *moulding planing machines*, was void.

(Before BERRIS, J., Southern District of New York, May 24th, 1852.)

THIS was a motion for a provisional injunction, founded upon a bill and affidavits. The plaintiffs claimed, under Letters Patent granted to William Woodworth, December 27th, 1828, as re-issued to William W. Woodworth, administrator of William Woodworth, July 8th, 1845, for "a new and useful improvement in machines for planing, tonguing and grooving and dressing boards," &c., and extended, by Act of Congress passed February 26th, 1845, (6 *U. S. Stat. at*

Large, 936,) for seven years from December 27th, 1849, the exclusive right, by conveyance through one James G. Wilson, of making, using and vending moulding machines within the city and county of New York and the county of Kings. The facts are stated in the opinion of the Court.

Charles M. Keller and William Mootry, for the plaintiffs.

Edwin W. Stoughton and George G. Sickles, for the defendants.

BETTS, J. For the purposes of this motion it is to be assumed that the entire right and title to Woodworth's patent was vested in James G. Wilson, subject to such grants and licenses as had been before made by him. On the 18th of December, 1851, he assigned to the plaintiffs, for the unexpired balance of the term of the patent, the full and exclusive right, liberty and privilege under the patent, of making, using and vending *moulding planing machines*, in any and all of the forms covered by the patent, within the city and county of New York and the county of Kings. The bill charges that the defendants have infringed the patent by using and vending three or more *planing machines for the planing or cutting of mouldings* in the city and county of New York and county of Kings, in all material respects the same in principle and mode of operation as Woodworth's patent machine, and prays that they may be decreed to account for and pay over the income thus unlawfully derived from the violation of the rights of the plaintiffs, and be restrained from any further violation of said rights.

In deducing their title, the plaintiffs show an assignment or license from Wilson to one Van Hook, dated April 2d, 1846, granting and giving to the latter the full consent, permission and license of the former "to construct and use and vend to others to construct and use (during the term of said patent) ten planing, tongueing and grooving machines, upon the principles and description of the renewed

patent and amended specification, upon condition that said Van Hook, his heirs and assigns, shall use due diligence in prosecuting to final judgment all persons who may, at any time from the date hereof and until the 27th day of December, 1856, infringe upon said patent;" and Wilson covenanted that no other than such ten machines licensed to Van Hook "shall, in any manner or on any pretence, be licensed or authorized by said Wilson, or the patentee, or other person deriving title under them or either of them, or be constructed, maintained, used or kept for use in that part of the city of New York lying west of Broadway, on a parallel line with it until the line reach the Harlem River." And the instrument declares as follows: "It is the effect of this covenant, that said Van Hook shall enjoy, during said extended term, an *exclusive use to the said patent* within the said territory," limited to said ten machines, reserving to Wilson the right to prosecute for all infringements of the patent within that territory, and all damages recovered therefor; and the said Wilson also stipulating to prosecute, on reasonable notice, at his own expense, all suits and actions for such infringements.

The plaintiffs in this case rest their right upon the assumption, that there remained in Wilson, after the license or assignment to Van Hook, a right under the patent to a *moulding planing machine*, which was separable from and not embraced within the grant of *planing, tongueing and grooving machines* made to Van Hook.

The original patent to William Woodworth, dated December 27th, 1828, was for "a new and useful improvement in *the method of planing, tongueing, grooving and cutting into mouldings*, or either, planks, boards," &c. The claim appended to the specification was, "the improvement and application of cutter or planing-wheels to planing boards, plank, timber or other material; also his *improved method of cutters*, for grooving and tongueing and *cutting mouldings* on wood," &c.

The patent was surrendered and re-issued, on an amended specification, July 8th, 1845. The recital in the amended patent, and the grant in conformity with it, do not correspond

exactly with the original patent, as no mention is made of *cutting mouldings*. But, even though the re-issued patent be considered as operating to the entire extent of the original patent, and as embodying all that is contained in that grant, yet there is no mention, in the specification or claim, of any improvement or invention in respect to machines for *planing or cutting mouldings*. The schedule only assumes to describe "the method of *planing, tonguing and grooving* plank or boards," and the summary or claim makes no mention of *planing or cutting mouldings* as a distinct branch or feature of the discovery. This would seem to import that, if the patent secures that operation to the patentee, it does so because it is included within the description of *planing, grooving, &c.*

The Court is not now called upon to consider the construction of the patent in that respect, and the topic is alluded to only to mark more specifically the reason for the interpretation put upon the assignment or license to Van Hook.

Whether the contract of Wilson with Van Hook is regarded as an assignment technically for a particular territory, or only as a lease or license, its effect is to part with the entire interest of Wilson in the discovery patented and vest it in Van Hook. And this the parties manifestly intended in the stipulation that Van Hook should "enjoy an *exclusive use to the said patent* within the said territory," limited to the prescribed number of machines. Without this full possession of territorial right, or one conjointly with Wilson, Van Hook would have at law no capacity to sue for any infringement of the patent within that district. (*Curtis on Pat.*, §§ 258, 259, 260.)

Whether the reservation by Wilson of a right to prosecute for infringements and to receive all damages recovered therefor, constitutes the grant a joint one for that purpose, or be inoperative and void, is of no moment in the consideration of the extent of right imparted to Van Hook. That is made co-equal with the right of the patentee in respect to the particular district and the number of machines specified, because

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the grantee, assignee or licensee is clothed with authority to construct and use and vend to be used such machines, and also to license their use in that territory. This being the whole power of the patentee in respect to the subject-matter, nothing remained in Wilson, after that grant, which could be conveyed to the present plaintiffs. The *moulding planing machines* licensed or assigned to them, were to be used in the territory assigned to Van Hook, and a prior grant of the same thing being then subsisting, that to the plaintiffs was without authority and void.

I do not pass upon the question whether the patented discovery, if it includes a right to a "*moulding planing machine*," is partible in its nature, so as to enable the patentee to make separate grants of the various particulars included in it, because the plaintiffs, upon their own evidence, show that the right they set up was derived from a party who had no interest in the subject granted.

The plaintiffs, therefore, cannot make title in this case without a conveyance from Van Hook.

Motion denied.

THE UNITED STATES vs. STEPHEN LUTZ AND OTHERS.

Where property is purchased abroad by the United States, and is shipped to this country, to be delivered to the United States on payment of the purchase-money, and is landed under the general permit of a collector and placed in a public store, the legal right of property therein is vested in the United States, subject only to the vendor's lien for the purchase-money.

Such property, being imported for the United States, is not subject to any import duty, and, therefore, the sale of it by a collector, for the non-payment of such duty, is void.

And, if such property be in the actual possession of the United States at the time of such sale, and it be taken from that possession by the purchaser of it on such sale, the United States are entitled to recover its possession by an action of replevin against such purchaser.

(Before NELSON and BETTS, JJ., Southern District of New York, July 1st, 1852.)

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THIS was an action of replevin, to recover an apparatus for a light-house. The apparatus was made by Lepante, of Paris, under an order from the Government of the United States, and was shipped to New York, in October, 1849, consigned, by bill of lading, to Major Bache, of the United States corps of engineers. The bill of lading was transferred by him to Lepante's agent in New York, who held the property under it, to be delivered to the Government on payment of the purchase-price of the apparatus. The apparatus was landed from the ship in which it was imported, under a general permit from the collector, and was deposited in a public store. In March, 1851, it was sold at public auction by the collector of the port of New York, for the non-payment of duties, and was purchased by the defendants, as the highest bidders, for the sum of \$500, which amount was paid by them and received into the Treasury of the United States. They then took possession of the apparatus. At the time of the sale the Government had not paid to Lepante or his agent the amount of the purchase-money, which was over \$10,000. When the facts of the case became known to the public authorities, this action was brought. The jury, on the trial, found a verdict for the plaintiffs, and the defendants now moved for a new trial, on the ground of alleged errors in the charge of the Court.

Benjamin F. Butler and *William Allen Butler*, for the defendants.

J. Prescott Hall, (*District Attorney*), for the plaintiffs.

THE COURT denied the motion for a new trial, and held :

(1.) That, as the apparatus was in the actual possession of the plaintiffs at the time of the sale, and was taken from their possession by the defendants, they were competent to maintain this action.

(2.) That the legal right of property in the apparatus was

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vested in the plaintiffs, subject only to a lien, in favor of the vendor, for the purchase-money.

(3.) That, as the apparatus was the property of the plaintiffs and was imported for their use, it was not subject to an import duty, and that, consequently, the sale of it by the collector, for the non-payment of duties, was without warrant of law and was void.

 THOMAS THOMSON AND OTHERS vs. HUGH MAXWELL.

Under the 16th section of the tariff Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) and the 8th section of the tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) it is the duty of a collector to assess duties upon the appraised value of goods imported by their manufacturer, notwithstanding there is an invoice sworn to by their owner. Those sections are not confined to goods imported by a purchaser.*

Under the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 727,) it is a condition precedent to a right of action against a collector for the return of duties paid under protest, that the claimant shall, in his protest, point out to the collector, by positive and direct notice, every particular of fact and of law which he relies upon as protecting his goods from the duties demanded.

Where a protest was in these words: "We protest against paying additional duty and penalty on" (describing the goods) "they being appraised too high. We claim to have" (naming the amount) "refunded, being amount paid for additional duty and penalty:" *Held*, that the person making such protest could not, in an action against the collector for the return of the amount so paid, raise any objection to the regularity of the appraisal proceedings.

Where a protest is written on an entry, they compose, in effect, one paper, and it is unnecessary to repeat in the protest the description given of the goods in the entry.

* The reverse of this doctrine was held by the Supreme Court of the United States, in *Belcher v. Lawrason*, at the December Term, 1858, the opinion of the Court being delivered by Mr. Justice NELSON. It was there held by that Court, that neither the 16th section of the Act of August 30th, 1842, nor the 8th section of the Act of July 30th, 1846, has any application whatever to any goods obtained otherwise than by purchase, but that such goods, in regard both to the mode of appraisement and the penalty for undervaluation, are embraced within the 17th section of the Act of August 30th, 1842. (See 21 *How.*)

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Where goods were described in the invoice as "plain Indiana squares," "embd. Indiana hdkfs.," "emb. Indiana shawls," "embd. hdkfs." and "plain do.," with no allusion to the material of which they were composed, and were described in the entry as "worsted and cotton shawls," and were reported by the appraisers as "wool and cotton, and worsted and cotton shawls, suitable for wear," and as "worsted shawls, suitable for wear," and the protest under which duties were paid on them described them simply as "cotton and worsted shawls," and they were subjected by the collector to a duty of thirty *per cent.* : *Held*, in an action to recover back the excess of duties paid beyond twenty-five *per cent.*, there being no evidence explaining the character of the articles, that they were properly chargeable with thirty *per cent.*, as being "articles worn by men, women or children," and falling within Schedule C of the Tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 44.)

Where the time of exportation is taken by the appraisers as the time of valuation, and the importer claims that the time of manufacture or production should have been taken, he must make that a ground of protest, and must give evidence to show the incorrectness of the appraisal. Ordinarily, the two periods may properly be treated as the same.

Where goods are, on appraisal, valued at more than ten *per cent.* above the invoice price, they are, nevertheless, not liable to an additional duty of twenty *per cent.* under the 8th section of the Tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) if they were manufactured by the importer, or were procured by him in the country of their production otherwise than by purchase.*

(Before NELSON and BETTS, JJ., Southern District of New York, July 1st, 1852.)

THIS was an action of assumpsit against the defendant, as collector of the port of New York, to recover back certain duties and penalties paid by the plaintiffs on two importations of shawls from Liverpool, consigned to them for sale under guaranty by Whitehill & Co., of Paisley, Scotland, the manufacturers and owners of the shawls. The facts were these : On the 8th of September, 1849, four bales of shawls were shipped by the steamer Cambria. Two of the bales, Nos. 255 and 256, were invoiced as containing each 200 "plain woollen shawls;" one bale, No. 257, as containing 144 "plain-shot woollen shawls;" and one bale, No. 258, as containing 100 "woollen tartan long shawls." On the 22d of Sep-

* See *Belcher v. Lawrason*, to the same effect, decided by the Supreme Court of the United States, December Term, 1858. (21 *How.*)

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tember, 1849, all four of the bales were entered by the plaintiffs at the Custom House in New York as "woollen shawls," at the invoice valuation of £215 8s. 0d. The public appraisers reported their value to be £263 16s., with charges, a difference of £48 8s., or twenty-two *per cent.* The plaintiffs applied to the collector for an appraisal of the goods by merchant appraisers. That appraisal was made on the 14th of October, 1849, at £258 16s., and did not diminish the valuation by the public appraisers to within ten *per cent.* of the invoice valuation. The duties on the appraised value, and a penalty of twenty *per cent.* thereon, were added at the Custom House, and were paid by the plaintiffs under the following protest: "We hereby protest against paying addl. duty and penalty on 255 a 258, being appraised too high. We claim to have \$270 70 refunded, being amount paid for addl. and penalty. Thomson, Quick & McIntosh."

Two bales of the shawls, Nos. 259 and 260, were imported in the steamer Canada, about the 5th of October, 1849, and were valued on the invoice and entry at £112 6s. 9d. The public appraisers appraised them as being worth, at the time and place of exportation, £139 14s., a difference of twenty-four and one quarter *per cent.* The plaintiffs paid the additional duties, and a penalty of twenty *per cent.* imposed in consequence of the appraisement, under the following protest: "We also protest against paying add. duty and penalty, the goods being appraised (259, 260) too high; we claim to have \$174 80 refunded."

The entry of importations by the Cambria, made by the plaintiffs, included three cases, Nos. 252, 253 and 254, described as "worsted and cotton shawls," which were subjected by the collector to a duty of thirty *per cent.*, and also some cases of "worsted and cotton" goods and some cases of "cotton" goods, which were charged with a duty of only twenty-five *per cent.* The plaintiffs wrote on the entry: "We hereby protest against the payment of 30 *per cent.* duty charged on all cotton and worsted shawls contained in this entry, claiming to enter the same at 25 *per cent.* We pay

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the amount exacted, in order to get possession of the goods, claiming to have the difference refunded. Thomson, Quick & McIntosh." By a note on the invoice, the appraisers reported the three cases, Nos. 252, 253 and 254, as "wool and cotton, and worsted and cotton shawls, suitable for wear." The invoice description of these three cases was: "plain Indiana squares," with no allusion to the material of which they were composed.

The entry of importations by the Canada, made by the plaintiffs, included three cases, Nos. 261, 262 and 263, described as "worsted and cotton shawls." These were subjected to a duty of thirty *per cent*. The plaintiffs wrote on the entry a protest, the same in language as that on the entry of cases Nos. 252, 253 and 254 by the Cambria. Case No. 261 was described in the invoice as containing "embd. Indiana hdkfs." and "emb. Indiana shawls;" case No. 262 as containing "plain Indiana squares;" and case No. 263 as containing "embd. handkfs." and "plain do.;" and all three were returned by the appraisers as "worsted shawls, suitable for wear."

The other facts necessary to an understanding of the case are sufficiently stated in the opinion of the Court. At the trial before BERRS, J., and a jury, in October, 1851, a verdict was rendered for the plaintiffs for \$600, subject to the opinion of the Court upon a case to be made, and subject to adjustment at the Custom House.

Elias H. Ely, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BERRS, J. The main proposition urged by the plaintiffs on the question of valuation is, that the invoice, sworn to as required by statute, must be taken as proof of the true value of the goods in the foreign market, until it is disproved by legal evidence produced on the part of the Government. The plaintiffs deny that either the appraisement by the official

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appraisers, or that by the merchant appraisers, amounts to such evidence. We do not deem it necessary to review the reasoning urged in support of this position, as, in our opinion, the point is covered by express enactments in the tariff laws and by the decision of the Supreme Court.

It is enacted by the 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) that in *all* cases where there is or shall be imposed any *ad valorem* rate of duty on any goods, &c., imported into the United States, it shall be the duty of the collector within whose district the same shall be imported or entered, to cause the actual market value or wholesale price thereof, at the time when purchased, in the principal markets of the country from which the same shall have been imported into the United States, &c., to be appraised, estimated and ascertained, &c.; and it shall be the duty of the appraisers, &c., by all reasonable ways and means in their power, to ascertain, estimate and appraise the true and actual market value and wholesale price, any invoice or affidavit thereto to the contrary notwithstanding, &c. The 8th section of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) re-affirms these directions. That this enactment embraces goods imported by their manufacturer, as well as goods imported by a purchaser, is made manifest by the proviso to the 16th section of the Act of 1842, if any doubt might be fairly raised in that respect from the expression, "the time when purchased," used in the enacting clause. But we think that the general and positive language of the Act would not be qualified by that expression, so as to be limited to purchasers. The invoice and the owner's affidavit, accordingly, place no impediment in the way of the collector, to prevent his assessing duties upon the appraised valuation, nor can he be required, in the first instance, to produce extraneous evidence contradicting such affidavit or supporting the appraisement. (*Rankin v. Hoyt*, 4 *How.* 327.)

It is proper to advert to another ground of objection taken to the appraisement, and earnestly insisted on by the plaintiffs' counsel, before stating what, in our judgment, are the

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controlling considerations in this case. That objection is, that the appraisement is nugatory and void: (1.) Because the collector acquired no authority, under the facts in the case, to order it. (2.) Because he in fact did not direct it to be made. (3.) Because he did not designate, as required by law, one out of every twenty packages to be appraised. (4.) Because the official appraisers, in acting in the matter, did not all of them act together. (5.) Because no one of them ever saw the goods which they appraised. (6.) Because neither the official appraisers nor the merchant appraisers were legally qualified, the proper oath not having been administered to them. (7.) Because the appraisal was not made at the proper place. A carefully-prepared argument was presented to the Court in maintenance of these various suggestions against the validity of the appraisement. We do not discuss the correctness of these positions or of the objection itself, because, in our opinion, the plaintiffs have not placed themselves in a situation which entitles them to demand the judgment of the Court upon the correctness of either.

This action is brought against the defendant to recover back moneys received by him in his official character, for the United States, which have been paid into the Treasury. Upon general principles of law, the action would not be maintainable unless notice had been given to the defendant, before such payment over was made by him, that he had no authority to exact the duties and that the plaintiffs would claim their return. (*Elliott v. Swartwout*, 10 *Peters*, 137; *Bend v. Hoyt*, 13 *Peters*, 263; *Aldridge v. Williams*, 3 *How.* 9.)

Congress, by the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 727,) regulated the rights of the merchant and those of the collector in this respect, and, after recognizing the liability of collectors to be sued for duties illegally exacted, after the payment of such duties into the Treasury, enacted as follows: "Nor shall any action be maintained against any collector, to recover the amount of duties so paid

under protest, unless the said protest was made in writing and signed by the claimant at or before the payment of said duties, setting forth distinctly and specifically the grounds of objection to the payment thereof." These provisions are conditioned to a right of action on the part of an importer, a proper protest in the case being the basis of the action and a fundamental pre-requisite to a recovery. The Courts exact a strict compliance with these conditions. Chief Justice Taney says, that the words requiring the claimant to set forth distinctly and specifically the grounds of his objection to the demand of duties, are too emphatic to be regarded as mere surplusage, or to be overlooked in the construction of the law, and that the object of the provision is, to prevent a party from taking advantage of objections when it is too late to correct them. (*Mason v. Kane, Circuit Court, Maryland District, April Term, 1851.*)

We think there is a manifest propriety in adhering closely to the provisions of this law. It is intended by Congress to settle all uncertainty as to the manner in which collectors can be made responsible in actions for duties collected under protest, and the motive to its enactment seems palpably to have been, to take from parties the power of imposing upon collectors damages and costs by personal suits in respect to their official transactions, unless they were plainly and directly apprised, at the time they received the duties, what objections the claimant had to the payment. It is most reasonable that a public officer should be put on his guard against a mistake or error in the exercise of his functions prejudicially to another, who is cognizant of the error and intends to hold him responsible for it, by an explicit notice from such person to him of his error in fact or in law. He might thus at once correct the wrong, without delay or expense to either party. The great number of prosecutions against the collector, with which the dockets of this Court have been crowded of late years, founded upon claims for return duties, admonishes the Court that it is important to the maintenance of uniformity in Custom House transactions, as well as to

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the interests of the importers and of the Government, that the precautions wisely enacted in this law should be rigidly enforced in every instance.

The party who offers his goods for entry has the means of ascertaining at once whether any well-founded objections exist for contesting the legality of the rate of duties demanded at the Custom House, and, if he neglects to lay those objections before the collector, or omits to make the inquiries necessary to his own information on the subject, it is right that the loss resulting from his inattention or remissness should be borne exclusively by himself. We understand the Act of 1845 to be imperative in its character. But, independently of the solicitude of the Court to execute faithfully all the directions of a public law, we are convinced that, on general principles, a peremptory law of that character will prove to be not less salutary and important to the navigation and trade of the country than to the fiscal operations of the Government. We shall persevere in applying the rule adopted in the present case to all others coming before us for judgment, and in holding that the claimant must, in his protest, point out to the collector, by positive and direct notice, every particular of fact and of law which he relies upon as protecting his goods from the payment demanded.

Testing by this rule the protests put in by the claimants in this case, it is obvious that they afford no indication to the collector that he or the other officers of the customs had committed any irregularity in the mode adopted for ascertaining or imposing the duties demanded. We accordingly lay out of view all the allegations made on the argument respecting the regularity of the proceedings at the Custom-House preparatory to an appraisal of the goods, and the competency of the oath administered to the appraisers, and the necessity that all the appraisers should act together in examining the goods, and the sufficiency of the report made by them to the collector, or of his directions to them, or of their memoranda upon the invoices or the entries. The pro-

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tests specify none of these particulars, and the claimants must be held to be debarred of all objections which are not distinctly and specifically pointed out in the protests or made certain by the papers which accompany them. Had the collector been notified that an improper oath had been administered to the appraisers, or that they had been guilty of irregularities in making the appraisement, or of any lack of form or substance in the proceedings in the Custom House, it would have been in his power, and we are to presume it would have been his desire, to rectify them at once, and thus save all the delay and expense of a judicial investigation into the matter. We are persuaded the purpose of the law cannot be sustained without holding to this interpretation and application of its provisions. We accordingly hold that this branch of the case, which was most strenuously urged upon the argument, cannot be made a ground of contestation on the pleadings and proofs as they are presented. The points and objections taken in this behalf are, therefore, overruled.

The protests in this case are written upon the entries, and, the two papers being thus before the collector, the plaintiffs are entitled to avail themselves of the descriptions given of the goods in the entries, the same as if those descriptions were repeated in the protests—the protest and the entry composing, in effect, in respect to the notice to the collector, one paper. This point has been repeatedly before this Court, and has been uniformly ruled in this way.

No evidence was given on the trial in respect to the character of the “worsted and cotton shawls” imported by the Cambria, nor any reason shown why they should be subject to thirty *per cent.* duty rather than twenty-five *per cent.*, other than the note or report of the appraisers on the invoice; and the Court has nothing to guide its judgment, except to compare the description of the goods with the provisions of the tariff Act, and thus ascertain whether the statute determines the question.

Articles liable to a duty of thirty *per cent.* are enumerated

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under Schedule C., in the 11th section of the Act of July 30th, 1846. In this schedule are classed: "Articles worn by men, women or children, of whatever material composed, made up, or made wholly or in part by hand;" "manufactures of cotton" "or worsted, if embroidered or tamboured, in the loom or otherwise, by machinery or with the needle or other process." Articles subject to a duty of twenty-five *per cent.* are classed under Schedule D.; in which list are enumerated "cotton laces, cotton insertings, cotton trimming laces, cotton laces and braids, manufactures composed wholly of cotton, not otherwise provided for." The "worsted and cotton shawls," imported by the Cambria, do not, by the name of "plain Indiana squares," fall under any specific denomination embraced within either Schedule C. or Schedule D. The entry of them as "worsted and cotton shawls" restrains the plaintiffs from claiming that they should be classed with any of the descriptions of cotton manufactures enumerated under Schedule D. If they were "embroidered" or "tamboured," they are specifically provided for in Schedule C.; and they may very fairly be denominated "articles worn by men, women or children," and thus be placed under the thirty *per cent.* rate of duty.

Acting upon the protest, invoice and entry, without any evidence explaining particularly the character of these articles, we must regard the classification of them made at the Custom House as correct, and must hold that a duty of thirty *per cent.* was properly imposed on them.

The "worsted and cotton shawls" imported by the Canada have been entered by the plaintiffs under that designation, and, as they furnish no evidence that the articles are not those "worn by men, women, or children," or that any specification in Schedule D. applies to them, we think the collector properly subjected them to a duty of thirty *per cent.*

We are, accordingly, of opinion, that the plaintiffs have shown no ground for a recovery against the defendant for any excess of duties exacted from them beyond what the law authorized.

As to the woollen shawls, the appraisers took the period of their exportation as that of the valuation, and no evidence is adduced showing an over-appreciation of them on that basis. The plaintiffs insisted, on the argument, that the time when and the place where the goods were manufactured or produced must be adopted as governing their prices. But, admitting the law to be so, the plaintiffs have not made that a ground of protest, and they fail to prove that Paisley was the chief place or market of the country of exportation, or what was the real time of manufacture or production, or whether there was any difference of prices between the time of manufacture or production and the time of exportation. In ordinary usage, the two nearly coincide, or approximate so closely as to be properly treated as the same. It has already been shown that the invoices themselves do not countervail the appraisements, and the plaintiffs give no evidence that the invoices were dated or made up prior to the times of exportation, so as to be entitled to appeal to the invoices as indicating that the goods were purchased or otherwise procured at earlier dates. Therefore, no foundation is laid for questioning the justness of the appraisals, and they must stand as fixing the dutiable value of the woollen shawls.

We think the collector had no authority in law to impose an additional duty of twenty *per cent.* on the prices as so raised. The goods were owned and imported by the manufacturer, and were not obtained at the place of exportation, or in a foreign country, by purchase. In the case of *Greely v. Thompson*, (10 *How.* 225,) this point was directly determined by the Supreme Court, and it was settled by that case, that, under the provisions of the 8th section of the tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) the importer is not liable to the additional duty of twenty *per cent.* when the goods were manufactured by him, or were procured by him in the country of their production otherwise than by purchase, although on appraisement their prices be advanced more than ten *per cent.* above the invoice prices. Accordingly, the plaintiffs are entitled to recover \$196 60, the

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penalty paid on the invoice by the Cambria, with interest from October 6th, 1849, and \$135 20, the penalty paid on the invoice by the Canada, with interest from October 13th, 1849 ; and the defendant is discharged from all the demands of the plaintiffs for the repayment of duties on the appraised valuations.

Judgment accordingly.

FRANCIS DURAND AND OTHERS vs. CORNELIUS W. LAWRENCE.

In an action to recover back duties as having been illegally exacted, no ground of objection to the payment of the duties can be taken, which was not specifically and distinctly stated in a protest made at the time of paying the duties.

Where the protest merely protested against the payment of the duty, but stated no ground of objection : *Held* that, on the trial of an action to recover back the duty paid, the plaintiff could not question the validity or accuracy of the appraisement on which the duties were paid.

Where the invoice valuation of goods imported by their manufacturer is increased on appraisement by more than ten *per cent.*, the collector has no authority to impose the penalty prescribed by the 8th section of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43.) *

(Before NELSON and BETTS, JJ., Southern District of New York, July 1st, 1852.)

THIS was an action against the late collector of the port of New York, to recover back duties paid on an entry of wines, and also the amount of a penalty which had been imposed at the Custom House. On the trial in November, 1850, a verdict was taken by consent for the plaintiffs for \$4,803 48, subject to the opinion of the Court upon a case to be made, "with liberty to either party to turn the same into a bill of exceptions or special verdict, and also subject to adjustment."

* See *Belcher v. Laurason*, to the same effect, decided by the Supreme Court of the United States, December Term, 1858. (21 *How.*)

There was no stipulation that the Court might adjudge the facts of the case.

The plaintiffs took the owners' oath to the invoice in France, and consigned the wines to Messrs. Aymar, of New York, who entered them, as consignees, for the plaintiffs. The oath did not state that the plaintiffs were the manufacturers of the wines. It only stated that the wines were invoiced at their fair market value in Perpignan at the time the same were manufactured, and the oath of their agent there, (Richards,) appended to the invoice, stated that the wines were purchased for account of the plaintiffs.

Three separate warehouse entries were made by the consignees on the 16th of October, 1848, and, the invoice prices of the wines having been raised by appraisement more than *ten per cent.*, duties were laid on the increased valuation, and a penalty of 20 *per cent.* thereon was imposed. A protest was made, in writing, on each of the entries, by the consignees. On one, the protest was this: "The additional duty and penalty we claim to be paid under protest against the justice of the demand, and hold you responsible." On another, it was this: "We protest against the additional duty and penalty hereon, and shall pay the same from time to time as required, under this our protest." On the third, it was this: "We protest against the additional duty and penalty charged hereon, and shall pay any amount from time to time under protest." Ten withdrawal entries were afterwards made, as the wines were taken from the warehouses, and on each one a protest in some one of the following forms was written by the consignees: "We hereby protest against the payment of the additional duty and penalty charged on this entry, and shall hold you responsible for the same;" "We protest against the payment of the amount charged in this entry for additional duty and penalty, and hold you responsible for the same."

Robert J. Dillon, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

Durand v. Lawrence.

BETTS, J. The same points discussed in the case of *Thomson v. Maxwell*, (*ante*, p. 385,) were raised in this case. The counsel on both sides regarded the wines as having been manufactured by the owners and importers, the evidence being that the raw wines were purchased from the producers and then brought to a state for exportation by some process of preparation or manufacture on the part of the owners.

But, whether the wines were procured by the plaintiffs as purchasers or as manufacturers, the Court is not informed by the case, nor whether the invoice or the appraisement represents their true value in the foreign market. This question should have been submitted to the jury, and although, in reviewing the testimony on that point, we may have no doubt as to what the finding of the jury ought to have been, we are not authorized to decide the fact ourselves. If the object of the plaintiffs was to try the question of fact as to the market value of the wines in the foreign market, they could have proposed giving evidence in regard to it, and, if the defendant objected to the proof on the ground of the insufficiency of the protests to that end, the Court could have been properly applied to, to determine the scope and effect of the protests in that respect.

The cause was tried, on both sides, obviously with the intent to ascertain the validity of the appraisement and proceedings under the revenue laws, and not to settle, as between the report of the appraisers and the judgment and knowledge of witnesses, the true value of the wines in France. If such an inquiry be an open one, (*Rankin v. Hoyt*, 4 *How.* 327,) it is one exclusively for the jury to determine.

But, if it were competent for the Court to pass upon that point, the plaintiffs have not stated, in any of their protests, specifically or distinctly, the ground of objection now urged. Whether the payment of the additional duty is objected to for this cause, or for other causes of a different character, is not specified in the protests. If the protests authorize this inquiry, they would clearly also permit the regularity of the proceedings of the appraisers and the collector, both in the

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steps preliminary to an appraisement and in the conduct of the appraisement, to be examined and determined. We considered this latter question in the case of *Thomson v. Maxwell*, before cited,) and decided that the protest must point out specifically the particulars constituting the invalidity of the appraisement, and that the importer will not be permitted to raise that question under a general protest.

Both parties submit this case to the Court as one coming within the facts and principles involved in that of *Thomson v. Maxwell*, except only as to the tenor of the protests. Assuming, therefore, that the importation was made by the manufacturer of the wines, we decide in this case, as we did in the one referred to, that the plaintiffs are not entitled, under their protests, to contest the validity or accuracy of the appraisement, and also that the collector had no authority to impose a penalty, because of undervaluation in the invoices, on goods imported by the manufacturer and not by a purchaser.

It is important to merchants and to the Government that it be understood that this Court will hold the merchant, in his objections to the payment of duties, to strict proof that his protest apprised the collector of the exact nature of his objections.

Judgment must be entered for the plaintiffs for the amount of the penalty exacted from them, with interest from the time of its payment, and for the defendant on the claim for the repayment of additional duties imposed.

PHILOS B. TYLER AND WILLIAM S. PENDLETON

vs.

EDWARD F. HYDE AND OTHERS.

The sufficiency, in point of substance, of a plea which is regular in form, cannot be inquired into on motion.

(Before NELSON and BETTS, JJ., Southern District of New York, July 1st, 1852.)

Tyler v. Hyde.

AFTER the decision in this case (*ante*, p. 308,) on the demurrer to the plea *puis darrein continuance*, the defendants, under the leave then given them to plead over, put in a special plea, which the plaintiffs now moved to strike out, on the ground that it was, in effect, a repetition of the plea *puis darrein continuance* which was adjudged bad. The defendants opposed the motion, and insisted that the plea was regular and valid because it pleaded the judgment and decision of the Circuit Court of the United States for the Eastern District of Louisiana, as it now stands upon the records of that Court.

Edwin W. Stoughton, for the plaintiffs.

George R. J. Bowdoin, for the defendants.

BETTS, J. The Court will not, on this motion, enter into a consideration of the sufficiency of the plea in point of substance, or inquire whether it is founded upon the rightful decree of the Circuit Court in Louisiana. It may, possibly, become necessary for this Court to determine, when the proofs are presented, which decree of that Court is the valid one governing the case, should two be certified from it which are in conflict in particulars affecting the merits.

The privilege accorded to the defendants to plead over, was subject to no restrictions, and they are entitled under it to interpose any plea which would have been good if put in independently of that leave. The defendants plead at their peril, and their plea, being regular in form, cannot be displaced by motion. The plaintiffs must demur to it or take issue on the facts it sets up.

Motion denied.

MORITZ LOEWENSTEIN AND CARL LOEWENSTEIN

vs.

HUGH MAXWELL.

Under the 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) appraisers must, in valuing importations, adopt the real market value of the goods abroad in cash, and not their value in a depreciated paper currency.

Goods purchased in Austria were invoiced and entered here in florins at their specie value. The appraisers here valued the goods according to the nominal value of the florin in paper currency, which was eleven *per cent.* less than its specie value: *Held*, that the appraisalment was erroneous, and should have been made in florins at their specie value.

In such a case, a protest against the additional valuation found on such appraisalment, and a claim to enter the goods according to the invoice and actual cost, is a sufficient protest, without a specification as to how the appraisalment was made to exceed the true value of the goods.

Such an erroneous appraisalment is not conclusive on the importer as to the dutiable value of the goods.

(Before NELSON and BETTS, JJ., Southern District of New York, July 1st, 1852.)

THIS was an action to recover back duties and a penalty, paid under protest. It was tried before BETTS, J., in December, 1851. A verdict was rendered in favor of the plaintiffs for \$2,000, subject to the opinion of the Court upon a case to be made, and subject to adjustment at the Custom House. The facts were these: The plaintiffs imported 150 bales of rags from Trieste to New York. The invoice was dated Vienna, April 3d, 1849. The valuation of the goods at Agram was taken as the invoice price, and was made in florins at their specie value, namely, forty-eight and a half cents, in United States currency, per florin. The actual legal currency of Austria, at the time, was the paper florin, which was then depreciated eleven *per cent.* below the specie value of the florin. The total invoice value was 7,169.9 florins. The Government appraisers raised the valuation to 9,064.47 florins, *paper currency*, and, on appeal by the importers to mer-

chant appraisers, they raised the value to 10,339.02 florins, *paper currency*.

The appraised value exceeding the invoice price more than ten *per cent.*, an additional duty, amounting to \$83 15, and a penalty of \$1,028, were imposed by the collector, and were both of them paid by the plaintiffs, under the following protest: "We herewith protest against the additional valuation of the U. S. appraisers and merchant appraisers, and twenty *per cent.* penalty charged on the within 150 bales rags, claiming to enter the same according to the invoice and actual cost, but pay the same to get in possession of the goods."

Elias H. Ely, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. There seems to be no just exception to the sufficiency of the protest in this case. The claim of the importers was, that the invoice expressed the true value of the goods in specie and the amount paid for them in cash, and that the appraisers should, in valuing the goods here, be governed by the real market value abroad in cash. The Custom House officers adopted a different rule, and proceeded upon the idea that the invoice was made up in the nominal currency of Austria, and that the entry was also in paper florins, and not according to the specie value of the goods. In that view, the public appraisers and the merchant appraisers would properly rate a higher valuation to the entry than the one given by the importers; but the testimony shows that both classes of appraisers well understood at the time that the paper denomination of the florin in Austria was higher than its actual value, and that a buyer disbursed no more in market, on the purchase of goods, than specie prices. For this reason, we think the appraisements erroneous.

The 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) directs the *actual market value* or *whole-*

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sale price in the principal markets of the country from which goods are imported, to be adopted as fixing their import value (with certain additions not affecting this case). The collector cannot substitute for *the actual market value* a fictitious value, expressed in a spurious currency. In the United States, during the suspension of specie payments, commodities were bought and sold under the nominal denomination of currency; but the paper dollar was not a measure of *actual value* or *true price*, and had to be rectified by the specie standard before it could be employed for that purpose. So in respect to the Austrian florin. Congress requires duties to be paid in specie, and, if foreign invoices are made up in a base currency, unless, on appraisement, the importations are rated at their specie value, prices will be fixed above the actual market value or cost price abroad, and more than the *ad valorem* duty authorized by law will be exacted of the importer.

The evidence clearly proves, in the present case, that the paper florin of Austria was, at the time of the purchase of these goods, at a discount of eleven *per cent*. Goods invoiced and entered at 10,000 florins would, if valued in the paper currency, be necessarily subject to duty on 1,100 florins beyond their foreign cost and market value, and thus the express provisions of the Act of Congress would be contravened.

We think that the protest sufficiently apprises the collector of the grounds of objection to the appraisals. It asserts that the valuation is beyond the *actual cost*; and it is plain, upon the proofs, that the appraisers made the valuation on the assumption that the invoice was made up in paper florins and did not exhibit the cash prices paid for the goods. We do not think that, under these circumstances, it is necessary for the importer to specify in what particular manner the appraisement was made to exceed the true value of the goods. Whether the error arose from ignorance of the state of the foreign market, or from a mistake in computing, or from a misapprehension of the value of the currency in which the

prices were expressed, the collector would be apprised by the notice that the sum reported by the appraisers did not truly represent the actual market value or wholesale price of the articles in Austria, and the importer would have complied with the requirements of the statute.

Nor is it made a question on the part of the United States, that the protest did not fully notify the collector that the goods were only liable to duty on their cash value, and that he had improperly imposed it on a paper valuation of them.

The defence is placed upon other and higher grounds : (1.) That there is not sufficient proof of any depreciation of the florin ; and (2.) That the appraisement is conclusive against the importers as to the dutiable value of the goods.

The Court is, by the terms of the case, made to render the same judgment upon the facts, as ought, upon the evidence, to have been given by the jury ; and, in our opinion, the proofs are clear and satisfactory that the florin, at the time the goods were purchased in Austria, was depreciated eleven *per cent.* As, on all the evidence, the valuation was made by the appraisers on the assumption that the importers invoiced the goods in the paper currency, and that they must be appraised at their nominal value in that currency, the appraisement does not become conclusive against the plaintiffs, it resting wholly on an arithmetical calculation which did not justify the basis of duties adopted by the defendant.

Moreover, according to our understanding of it, the agreement, in the case made, on which the verdict was rendered, submitted it to the Court to have the adjustment made at the Custom House now, as it ought to have been made at the time of the entry and appraisement.

Whether judgment is to be rendered for the plaintiffs for any sum, must depend upon such re-adjustment. The invoice and entry must, on such re-adjustment, be regarded as having been made up in the specie value of the florin, and either the invoice must be raised to the paper value of the florin, or the appraisal must be reduced to its specie value. If, on

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such adjustment, it is found that the entry was not below the actual value, (with the addition of the charges directed by the statute,) judgment must be entered for the plaintiffs for the increased duties imposed because of the difference in value, and also for the amount of the penalty, together with interest from August 5th, 1849, the time when the same were paid, and for costs. But, if it shall appear that duty was not imposed on an amount beyond the value expressed in the entry, (together with the legal charges,) judgment must be entered for the defendant as to that part of the demand. And, if it further appears that the difference in value between the entry and the appraisal so corrected exceeds ten *per cent.*, then judgment must further be entered in full for the defendant, with costs.

THE MANHATTAN GAS-LIGHT COMPANY

vs.

HUGH MAXWELL.

A quantity of coal was invoiced and entered at a certain weight and price per ton. On appraisement, the price per ton was reported to be correct, but the quantity was reported as so much greater as to make the entire valuation greater by 10 *per cent.* than the entry valuation. The collector exacted a penalty of 20 *per cent.*, under § 8 of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43 :) *Held*, that this was illegal.

Held, also, that the importer was not liable, in such case, under § 4 of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) to pay the fees of the weigher and measurer.

(Before NELSON and BETTS, JJ., Southern District of New York, July 1st, 1852.)

THIS suit was commenced in the Supreme Court of New York, and removed by *certiorari*, on the petition of the defendant, into this Court, under the provisions of the 3d section of the Act of Congress of March 2d, 1833, (4 *U. S. Stat. at Large*, 633.)

The plaintiffs imported from Liverpool a quantity of canal coal, invoiced and entered as of the weight of 150 tons. It was measured by the Custom House measurers, who returned the quantity to be 167 tons. No appeal was taken by the plaintiffs from that return, and duty was accordingly imposed on 167 tons, and was paid by the importers. The value of the increased quantity of the coal was greater, by more than ten *per cent.*, than the entry valuation, and a penalty of 20 *per cent.*, amounting to \$99 60, was imposed by the collector because of such undervaluation. The measurers' fees, \$49 50, were also charged to the plaintiffs. Payment of the two last-mentioned sums was exacted by the collector, and was made by the plaintiffs under protest. To recover these amounts, \$149 10, with interest, this action was brought. The plaintiffs indorsed on the entry a protest in writing "against the payment of the within named penalty of \$99 60, and of \$49 50 for measuring, as being both illegal and contrary to the former practice in this collection district."

The case was tried in November, 1851, before BERRS, J., and the jury rendered a verdict for the plaintiffs for \$150, subject to the opinion of the Court on a case to be made and to adjustment or correction at the Custom House.

John S. McCulloh, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BERRS, J. The defendant takes no exception to the sufficiency of the protest in this case, and the decision must turn on the points whether the undervaluation reported by the appraisers in respect to the coal subjects it to the penalty of 20 *per cent.* imposed, and whether the importers were liable to pay the measurers' fees charged against them.

The price per ton of the coal, as stated in the invoice, was reported to be correct. The difference between the valuation in the entry and that reported by the appraisers arose from the greater weight returned by the Custom House weighers.

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Cannel coal is sold in England by actual weight, the weight being taken with great care. In the United States, it is delivered from the ship, and sold by the chaldron, and the Custom House method of determining the weight of a cargo is to reduce the measured chaldron to tons and pounds, by taking the average weight of two or three tubs full, and multiplying that average by the number of tubs composing a chaldron. The evidence in this case proves that this mode of weighing, or rather measuring, leads to inaccuracy and error, and generally gives, as a result, a nominal weight beyond the real weight of the coal. The official weight must, however, be taken in this case to be the true dutiable weight.

The claim to the penalty exacted is not placed upon any culpable conduct in the importers, nor does their innocence of blame exonerate them from liability to pay the penalty, if the collector brings the case within the provisions of the Act. The authority invoked for imposing the penalty is given by the last proviso to the 17th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 564,) which is in these words: "*Provided, also*, That in all cases where the actual value to be appraised, estimated and ascertained, as hereinbefore stated, of any goods, wares and merchandise imported into the United States, and subject to any *ad valorem* duty, or whenever the duty is regulated by or directed to be imposed or levied on the value of the square yard, or other parcel or quantity thereof, shall exceed, by ten *per centum* or more, the invoice value, then, in addition to the duty imposed by law on the same, there shall be levied and collected on the same goods, wares and merchandise fifty *per centum* of the duty imposed on the same when fairly invoiced;" and by the eighth section of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) which alters the penalty to twenty *per cent. ad valorem* on the appraised value, in case the goods have been actually purchased, and their invoice value has been raised by the importer to what he deems to be their market value in the country from which they were exported.

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The argument for the United States is, that quantity is a component part of the value of this importation, and that, as the amount of the entry or the invoice lies in the quantity and price, a misstatement of *quantity* on the invoice and the entry, exhibiting the gross amount (consisting of price and weight) at ten *per cent.* below the appraisement, becomes necessarily a reason for imposing the penalty, because the dutiable sum is thus entered at more than ten *per cent.* less than the sum on which the United States are entitled to charge duties.

Two considerations, in our judgment, countervail this argument. The language of the statute makes the *value* of the goods entered the subject of comparison with the appraisement, and the term *value* is used in the revenue laws to express the *price* of the dutiable goods—that is, their cost price or market price abroad, increased by the addition of specified charges. (5 *U. S. Stat. at Large*, 563, 564, §§ 16, 17.) The Custom House officers can, therefore, only look at the relative valuations of the commodity upon the invoice and the appraisal, in determining whether the latter exceeds the former by more than ten *per cent.* The *ad valorem* to which the tariff Acts have reference, is the price or market worth of a dutiable article and its charges, in whatever way it is the subject of purchase and sale, whether the price is estimated on the square yard or other parcel or quantity. An aggregation of parcels (tons, in this instance) does not affect the value or price of a particular ton. It is only a repetition of that price as many times as the parcel or quantity is named. The general summation, therefore, being no more than the footing up of the specific values reiterated, cannot be regarded as the valuation which is called for by the statute, and which is the subject of appraisement and of penal duties.

That this interpretation of the revenue laws is correct, is manifest from the powers conferred on appraisers and the duties they are required to perform in determining the dutiable value of imported goods. An examination of the duty

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Acts from 1799 to 1846, shows that appraisers are called upon solely to fix the price or value of the imported commodity by *gauge, yard, weight or measure*, by the denomination or description usually applied to it on purchase and sale. Officers other than appraisers ascertain what is the measure or weight of goods entered. Their report furnishes the multiple by which the particular valuation of the appraisers may be brought to the dutiable amount of the importation.

Upon this view of the subject, it is manifest that Congress has not imposed the increased duty of twenty or fifty *per cent.* upon a misstatement in the invoice of the quantity of articles imported, but upon an undervaluation of prices. Because, such increase or penalty depends upon and follows the judgment of the appraisers, and their office is limited to fixing the wholesale price or market value, and in no way extends to ascertaining the amount, in weight, gauge or measure, of imported goods.

We think that the defendant committed an error, after the appraisers had reported the invoice price of the coal to be correct, in imposing twenty *per cent.* additional duty because the weighers or measurers returned a greater quantity than was invoiced. The appraisement must be restricted to determining the price or value of the parcel or quantity by which the purchase and sale of the article are made, and has rightfully no reference to the totality of the purchase. (*Marriott v. Brune*, 9 How. 619.)

The remaining question is as to whether the importers, in this case, are chargeable with the fees of the weighers and measurers. The directions of the Acts of Congress prior to 1846 are not explicit as to the cases in which it shall be the duty of the collector to have imported goods weighed or measured, unless when they are stored for want of an invoice or entry, or have been detained for inspection under circumstances of suspicion. The matter appears to have been left to his discretion. The weighers and gaugers were paid for their services by the collector, out of moneys in the

Custom House, and the payment was charged to the Treasury, (*Act of March 2d, 1799, § 2, 1 U. S. Stat. at Large, 707,*) the amount of the compensation being limited by various acts. These officers were not directed, in the forms of returns prescribed by statute, to make any return of fees. (*Act of March 2d, 1799, 1 U. S. Stat. at Large, 678, § 72.*)

We have not deemed it important to search through the tariff Acts, to ascertain whether any authority was given to the collector, prior to 1846, to charge fees for weighing and measuring, against the importer or the goods, or whether they were estimated and collected as duties, because we consider the whole subject to be definitively regulated by the 4th section of the Act of July 30th, 1846, (*9 U. S. Stat. at Large, 43,*) which enacts, "that in all cases in which the invoice or entry *shall not contain* the weight or quantity or measure of goods, wares or merchandise now weighed or measured or gauged, the same shall be weighed, gauged or measured at the expense of the owner, agent or consignee."

In the present case, the invoice did contain a specific statement of the weight of the coal, and, admitting that coal was before subject to weight or measure at the Custom House, this Act necessarily imports that the owner, in a case like this, shall not be subject to the cost of re-weighing it. The right to weigh at the expense of the owner depends upon the omission to give the weight in the invoice, and that omission affords the only justification for exacting costs and fees from the owner for weighing it.

We do not take into consideration the interpretation put upon this section of the Act by the Secretary of the Treasury, in his Circular of December 31st, 1849, nor decide whether the cases enumerated by him are those which justify the exaction of fees from importers, because no one of them contemplates or is based upon the state of facts presented by this case.

In our opinion, the plaintiffs are entitled to judgment, the amount of which is to be adjusted in the manner named in the verdict.

THOMAS BLANCHARD

vs.

PHILO S. BEERS AND ALBERT GOODYEAR.

The claim in Thomas Blanchard's patent of January 20th, 1820, for "a machine for turning and cutting irregular forms," construed and defined.

A person who uses the combination claimed by Blanchard, though in a machine which will make only wagon-spokes, infringes the patent.

The proper tests for determining the identity of one machine with another, on the question of infringement, defined.

(Before NELSON, J., Connecticut, September 24th, 1852.)

THIS was an action tried before NELSON, J., for the infringement of Letters Patent granted to Thomas Blanchard, January 20th, 1820, for "a machine for turning and cutting irregular forms." The history of the patent and a copy of its specification are set forth in 1 *Blatchford's C. C. R.* 258, 259, 261 to 269.

This action was brought upon an extension of the patent granted by Congress by special Act, passed February 15th, 1847, (9 *U. S. Stat. at Large, Private Acts*, 36,) for fourteen years from January 20th, 1848.

NELSON, J., in charging the jury, remarked as follows:

As regards the several renewals of Mr. Blanchard's patent by Acts of Congress, some reflections have been indulged in by the learned counsel for the defendants, by way of prejudice to the patentee's claim, on account of the length of time for which his invention has been secured to him. It is, therefore, proper to say that, so far as the Court and jury are concerned, those Acts must be regarded as having been properly passed. Independently of the discretion that Congress may exercise in respect to any particular patent, the statute provides, and such is the practice of the Patent Office under it, that if a patentee, near the expiration of the term of his patent, can satisfy the Commissioner of Patents that he has not been remunerated by the profits of his invention, over

and above the losses and expenses incurred and the time bestowed upon the subject, it is the duty of that officer to extend the term, so as to enable the inventor to derive, from the sale of his invention, a reasonable compensation for his genius and his labor ; and it is very probable that, in view of these considerations, founded upon the case presented by Mr. Blanchard, Congress became satisfied that it was fit and proper that his patent should be continued. Very likely the great litigation to which the patent has been subjected, and the enormous expenses necessarily attending suits of the description of the one now before you, satisfied that body that Mr. Blanchard had not been reasonably compensated for the great benefit his invention had conferred upon the country, and they therefore deemed it their duty to prolong the term.

The patent is for an improvement in a machine for cutting, out of wood or other materials, irregular forms, such as gun-stocks, axe-handles, shoe-lasts and other articles requiring irregular forms in their construction and use. The first thing to inquire into and ascertain and settle in your minds is, the thing invented, so as to enable you to determine, when examining the machine of the defendants, whether or not that machine is an infringement, or, in other words, embodies the same ideas in its arrangement. You must first comprehend the discovery made by Blanchard, for, until you comprehend that, you will not be able, upon examining the machine of the defendants, to determine whether or not that machine is substantially the same invention, embodying the same principle which was discovered by Blanchard and embodied in his machine.

I do not intend to take up much of your time in going over the description given by Blanchard in his specification. The subject is not new in this Court, as the patent has unfortunately been one of much litigation. The first part of the specification is devoted to a description of the various parts which constitute the organized machine, so as to enable a mechanic of ordinary skill and intelligence to construct a

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machine. Under the second head in his specification, the patentee explains the principle embodied in his machine, in other words, the novel characteristics or inventive elements of the machine, by which he claims it to be distinguished from all previous machines then in existence; and, in the conclusion of that head, it is stated that, as to the mechanical powers by which the movements of his machine are obtained, he claims nothing new. These movements, he says, may be effected by the application of various powers which would be furnished by a skilful mechanic when called upon for that purpose. Neither does he claim as new the cutter-wheel, or the friction-wheel, or the guide-wheel, or the model, separately or in the abstract. All these are common property, and anybody may use them. But he claims, as his invention, the method or mode of operation in the abstract, as explained in the second article, whereby an infinite variety of irregular forms may be cut or produced.

The principle or inventive element to be found in this machine is this: It is the cutting or turning of any given article of an irregular form longitudinally and transversely, by one joint operation. This is the novel idea struck out by Blanchard in 1820, and which he embodied in a practical working machine, which, as it has been shown, produces almost every variety of irregular form in the way mentioned. It has been suggested that this was no very great discovery after the existing state of the arts in that branch of knowledge. Yet it is historically true that, although we were in the beginning of the nineteenth century, no person had discovered that idea; or, if it had been discovered, no person, down to that time, had embodied it in a practical machine. There had been machines for cutting irregular figures or forms transversely alone, and there had also been machines for cutting irregular forms laterally or lengthwise. All these had already been discovered and had already been produced; but the idea of cutting such forms both longitudinally and transversely, by a joint operation, had never been discovered. That is the idea which occurred to Blanchard, and which has

produced the extraordinary results that have been disclosed in the course of this trial. It is not surprising, therefore, that the Government and the country should have been kind to one of whom it may well be proud ; because, the very first application of this discovery, the fruits of his genius, was for the benefit of that Government, namely, in manufacturing the gun-stock, which, down to that time, had been made by hand, and which has since been made by his machine.

It will be found, on looking at the description of this invention, contained in the patent, as well as by an examination of the organized machine, that this idea, which first occurred to Blanchard, has been embodied in a practical machine, which he has perfected by experiment and practice. The invention consists in the combination of four instruments in the mode pointed out in the patent, by which the machine cuts irregular forms longitudinally or lengthwise, and transversely or crosswise, by a joint operation. The gun-stock, as a product of the machine, strikingly exemplifies this combination. So do the shoe-last, the wagon-spoke and the axe-handle, though the last two do not in so marked and distinct a manner, because the irregularities, either longitudinally or transversely, in the wagon-spoke and in the axe-handle, are slight compared with those in the others, as is obvious upon a slight examination of the different instruments.

I had intended to call your attention somewhat particularly to the two old machines produced on the part of the defendants, as it was supposed that the originality of Blanchard's discovery was intended to be contested. I was aware that, upon some previous trials, these machines had been used and relied on with that view by the defendants ; but, inasmuch as it has been stated that they have not been introduced for the purpose of contesting the originality of Blanchard's invention, I shall not take up your time with them, but shall assume that he is the inventor of this combination, and is entitled not only to the merit of it, but to be protected in the enjoyment of its exclusive use, so long as his patent continues.

The only material question, therefore, involved in the case,

for the consideration of either the Court or the jury, is, whether or not the machine of the defendants is an infringement of the plaintiff's patent—that is, whether it is substantially the same or substantially different. This question is often one of great difficulty, and is usually the most embarrassing question involved in the trial of these patent cases. It calls, therefore, for patient and attentive examination and great care on the part of the jury, in looking into the evidence in the case, and into the several machines furnished by the parties for our information.

The machine of Blanchard embraces, in its scope and operation, the cutting of almost every species of irregular form, embracing any given extent of irregularity of form, as you have already seen, such as gun-stocks, lasts, &c., by means of the application of the combination or principle which he has discovered; and it is claimed, on the part of the plaintiff, that the defendants have appropriated this combination or principle, in order to obtain the benefit of one of the uses of his machine, namely, for making wagon-spokes. This raises the particular question in the case for your consideration.

As I have already stated, the invention of Blanchard consists in the combination of four instruments, the model, the rough material, the tracer or friction-wheel, and the rotary cutter, in the mode he has particularly described, by means of which the machine cuts irregularities, longitudinally and transversely, by one joint operation. This combination thus formed may be and is applied successfully to the turning of wagon-spokes; and it is insisted by the plaintiff, that the defendants have embodied this combination in their machine, and are, by means of it, enabled to do the same work. If this be so, they have infringed upon the rights of Blanchard, although their machine has been so constructed as to perform but one of the functions of Blanchard's. For, if they can appropriate the plaintiff's combination for one of the uses or functions of his machine, because it is performed separately, another person may appropriate another function, and so on, until there is nothing embodied in his machine left unappro-

priated. The question then comes to this: Have or have not the defendants incorporated in their machine, in substance, the combination or principle of Blanchard? If they have, they are guilty of an infringement. If they have not, they are not guilty.

In examining a machine, with the view to ascertain whether or not it is an infringement of a previous one, the similarity or dissimilarity of the mechanical construction is not necessarily conclusive or controlling. Its structure may be apparently very similar in form, and yet its principle and operation and result may be very different. So, on the other hand, its structure and appearance may be very different to the eye and in point of fact, and yet it may, in reality and in principle, be the same as the previous machine. The mere mechanical construction and form of a machine are not, therefore, always a test of its identity or want of identity, and it would be unsafe for a Court or a jury to act upon the idea that, because two machines are different in their mechanical structure, either in appearance or reality, they are not substantially the same. The principle embodied in a machine, and which gives to it all of its utility, may be put in successful practical operation by different mechanical contrivances, depending more upon the skill of the mechanic than the genius of the inventor. Hence, it is unsafe to rely upon the mere difference in the mechanical construction. The sure test, and the one the jury should be guided by in all cases of this kind is, whether or not the defendant's machine, (whatever may be its form or mechanical construction,) has incorporated within it the principle or the combination or the novel ideas which constitute the improvement to be found in the plaintiff's machine. If it does, then, no matter what may be its mechanical construction or its form, it is an infringement—an appropriation of the ideas of another, simply in a different form. You will, therefore, in view of this consideration, examine these machines, and the evidence that has been produced in the course of the trial, as well as the opinions of the experts, given to aid you in determining the

character of the machines, and ascertain whether or not the combination or principle which I have stated to you as constituting the invention of Blanchard is found incorporated substantially in the machine of the defendants,—whether you there find substantially the model, the rough material, the tracer and the cutter, by the means and combination of which a wagon-spoke of irregular form, longitudinally or transversely, is produced by one joint operation. The plaintiff claims that this combination—this new idea—is incorporated in the defendants' machine and gives to it its useful effect in manufacturing wagon-spokes.

Coming down more closely to the point in controversy between the parties, it will be seen that the question is even more narrow than the one I have already stated. It is, whether or not the defendants' machine embraces the combination or principle by which the irregular form of the spoke is cut longitudinally and transversely by one joint operation. They insist that they do not use the same means as Blanchard, either formally or substantially, for the purpose of producing this irregular form longitudinally; and they deny that there is any such operation as a longitudinal cut upon their spoke, in the operation of the machine. You have before you the products of both machines. That this irregular form lengthwise is impressed upon the spokes which the defendants manufacture, is certain; and the question is, whether or not this form is produced by substantially the same principle or the same combination as that used by Blanchard. The defendants claim that they do not use the same combination, that they do not use a model, and that they have discovered new and different means for accomplishing this purpose, namely, an arrangement of cutters, and the use of cams and a tracer on the rail upon which the vibratory lathe containing the rough material is moved from one stage of cutting to the other, so that the rough material may approach to or recede from the cutters from one end to the other. This combination is claimed to be substantially different from the combination used by the plaintiff.

It is material, at this stage of the case, to recall your attention to a principle already stated, namely, that whether or not the one machine is an infringement of the other does not necessarily depend upon whether their mechanical structures are different. But the question is, whether (whatever may be the mechanical construction) the later machine contains the means or combination found in the previous machine—whether, taking the structure as you find it, you see the new idea embodied in it. If the combination of Blanchard is found substantially incorporated in the defendants' machine, then its mechanical construction, whatever it may be, is, as matter of law, but an equivalent for the mechanical construction of Blanchard's machine. No man can appropriate the benefit of the new ideas which another has originated and put into practical use, because he may have been enabled, by superior mechanical skill, to embody them in a form different in appearance or different in reality. For, although he may not have preserved the exterior appearance of the previous machine, he may have appropriated the ideas which give to it all its value.

Undoubtedly, in the construction of a machine for the purpose of producing one of the functions or results of the plaintiff's machine, there may be very great departures from it, and still the new machine may contain his principle of operation. His machine is constructed to cut almost every variety of irregular forms, and hence, from necessity, there must be a single and narrow knife or cutter, to enable him to cut the minuter sinuosities of the article required, such, for instance, as the shoe-last or the human face. A tool used in Blanchard's machine for the purpose of cutting the last or the human face, or any other exceedingly irregular surface or form, must be small, and, when it is used for all purposes, as it is in the original machine of Blanchard, of course, in cutting irregular forms where the irregularities are small and few, the cutting must be comparatively slow. But, when the principle of Blanchard's is embodied in a machine constructed for and applied to one of the purposes of his, such

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as making spokes or axe-handles, it requires no great observation to see that in the case of a Blanchard machine so made, to accomplish but one of its purposes, and where the irregularity is simple and the lines diverge longitudinally but little, it would not be necessary to use the narrow knife that would be necessary to cut the form of the human face or any other very irregular body, but that a wider one might be used, by which the work could be done more readily. Take, for instance, the case in hand—the idea of constructing a machine to be devoted exclusively to the cutting of wagon-spokes. It is clear that the knife might be made broad enough to cut the principal part of the spoke by one operation, because the irregularity is small and the lines are nearly straight; and then a smaller knife might be used for the purpose of finishing the remainder of the article.

I call your attention to this consideration because it is unfair, I think, to take Blanchard's machine constructed for the purpose of cutting any irregular form, however great the irregularity may be, and contrast it with one that has been made for the purpose of performing only one of the functions which is performed by Blanchard's. The machine and the tools to be used, when the object is to cut any irregular form, must be constructed with regard to the minute sinuosities of some of the articles that it may be necessary to make. It is, therefore, unfair, when the question is between Blanchard's machine thus organized and a machine organized for one particular purpose, and to produce one particular result of Blanchard's machine, such as the wagon-spoke, to hold that, because the machine organized for that specific purpose is differently constructed, and dissimilar in appearance, and can produce the particular thing more rapidly, it therefore necessarily fails to embody the same idea or combination. We know that any machine constructed to accomplish a particular object or purpose may be often materially changed from the original construction, and yet do the work very well. There are mechanical equivalents, by the use of which the whole features may be changed and a great departure made from

the apparent principle and combination of the machine, and yet it may operate well. In view of this consideration, it should be particularly noticed in this case, that the defendants' machine has been constructed for one object—for the purpose of turning wagon-spokes of slight irregularity of form, and, therefore, as is obvious, may admit of very material changes from the original machine.

It will be proper, therefore, for you to look into these two machines, and see whether or not the change in the organization of the defendants' machine from the plaintiff's might not have been the production of the skill of a mechanic examining and studying the Blanchard machine, with a view to re-organize it and adapt it to the performance of one of its functions, namely, producing an axe-handle or a wagon-spoke. Because, whenever a defendant sets up that he has substantially departed from the existing machine, so as to avoid the consequence of an infringement, it is necessary that he should satisfy the Court and jury that his departure has been such as involves invention and not mere mechanical skill, in order to entitle him to a patent for the discovery. There must be mind and inventive genius involved in it, and not the mere skill of the workman.

It must be admitted, that the machine of the defendants does cut the article in an irregular form longitudinally and transversely, by one joint operation. There is an irregularity both lengthwise and crosswise, as it respects the two first sections of the spoke, and the question is, whether or not the defendants have used, in thus cutting the spoke, substantially the means and combination of ideas used by Blanchard in his machine in producing the same article.

These views present all that I mean to trouble you with upon the main question in the case. As to the fact that the defendants' machine can cut a greater number of spokes in a given time than the plaintiff's, the law is as stated by the counsel on both sides. That fact may be taken into consideration in examining into the question whether or not the principle or combination of the two machines is substantially

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the same. If it is, then, without regard to the result, and although a greater number of spokes can be made by the defendants' machine in a given time, that machine would still be an infringement. This superiority is sometimes produced by a superior construction of the machine; or, it may in this case be the result of making one adapted exclusively to the accomplishment of one of the purposes of Blanchard's; or, it may be the result of an improvement on his; but this will not entitle its author to use the principle or combination of Blanchard's.

There has been very little evidence, in the course of the trial, on the question of damages, and I presume that the counsel on both sides regard the main question in the case as the important one.

Charles M. Keller, for the plaintiff.

Roger S. Baldwin, for the defendants.

WILLIAM T. VAN ZANDT vs. HUGH MAXWELL.

A collector who withholds from an informer the proceeds of goods condemned as forfeited for a breach of the revenue laws, can, when sued for such proceeds, by such informer, in a State Court, remove the action by *certiorari* into a Circuit Court of the United States, under § 3 of the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 633.)

Whether, when such an action is improperly removed, the plaintiff can, upon a motion, have it remitted to the State Court, *quere*.

(Before NELSON and BETTS, JJ., Southern District of New York, September 1852.)

THE plaintiff brought an action in the Superior Court of the city of New York, to recover the sum of \$1,750, part of the proceeds of merchandise imported from a foreign country into the port of New York, and condemned as forfeited to the United States for a breach of the revenue laws, and

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which sum the plaintiff claimed as due to him because he was the informer on whose information the goods were seized and condemned. The defendant, being at the time collector of the port, brought a *certiorari*, pursuant to the provisions of the third section of the Act of Congress of March 2d, 1833, (4 *U. S. Stat. at Large*, 633,) upon which the cause and proceedings were removed into this Court.

The plaintiff now moved for a remittitur of the cause to the State Court, for want of jurisdiction in this Court over the subject-matter, insisting that the action was against the defendant in his private capacity, for withholding money due to the plaintiff, and was not founded on any act of the defendant in his official character as collector of the port.

Benjamin F. Butler, for the plaintiff.

J. Prescott Hall, (*District Attorney*), and *William M. Evarts*, for the defendant.

BETTS, J. The defence to this motion is, that the suit is brought against the defendant for acts done by him as collector, and is, by the Act of Congress, made subject to the jurisdiction of this Court. An objection is also raised, on the part of the defendant, that the proceedings by the plaintiff are irregular, and that he cannot by motion apply to have the case remitted to the State Court. We do not consider the point of practice raised by this latter objection, our opinion upon the merits being in favor of the position taken by the defendant.

The provisions of the third section of the Act of March 2d, 1833, which is applicable to the question before us, are, "that in any case where suit or prosecution shall be commenced in a Court of any State, against any officer of the United States or other person, for or on account of any act done under the revenue laws of the United States or under color thereof, or for or on account of any right, authority or title set up or claimed by such officer or other person under any

such law of the United States, it shall be lawful for the defendant in such suit or prosecution, at any time before trial, upon a petition to the Circuit Court," to have certain measures taken for removing the case to that Court, and that then the said suit or prosecution "shall be deemed and taken to be moved to the said Circuit Court," &c.

We think that the act of the defendant which is the foundation of this suit was either an official one done by him in the character of collector, under the revenue laws, by deciding that the plaintiff was not a party entitled to share in the forfeiture claimed by him, or was, under the alternative in the statute, a right, authority or title set up by the defendant, under the revenue laws, to withhold from the plaintiff the distribution of the forfeiture and to dispose of it otherwise. The 90th section of the revenue Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 696,) directs the amounts of sales (deducting charges) of all ships or vessels, goods, wares or merchandise condemned by virtue of that Act, to be paid to the collector of the District in which the seizure or forfeiture has taken place. The 91st section (*Id.* 697) directs the disposition of forfeitures, fines and penalties by the collector, to be one-half to the use of the United States, to be paid into the Treasury, the other moiety to be divided in equal proportions between the collector, the naval officer and the surveyor of the port, provided that when fines, penalties or forfeitures shall be recovered in pursuance of information given to the collector by any person other than the naval officer or surveyor of the District, the one-half of such moiety shall be given to such informer, and the remainder thereof shall be disposed of between the collector, naval officer and surveyor, in manner aforesaid.

It is obvious, upon the face of the statute, that the collector takes into his possession the moneys derived from forfeitures, and holds and disposes of them, in his official character alone. He acts under the law, or assumes to act under it, in determining the amount receivable by himself, the naval officer and the surveyor, and in making distribution thereof

according to such determination, no less than in receiving the money from the clerk of the Court, or depositing a moiety of it in the Treasury to the credit of the United States. Neither the United States, nor the naval officer, nor the surveyor would be legally concluded by the decision or act of the collector in respect to the division and disposition of forfeitures, and may hold him responsible for any misappropriation or any neglect of the requirements of the law. Still, his proceeding under the Act of 1799 will have been official, and must be reviewed or tried according to the provisions of law applicable to official acts. The Act of March 2d, 1833, goes still further, for it gives the character of official acts not only to things actually done by an officer of the United States under color of the revenue laws, but also to those done under a claim by him of a right or authority derived from those laws.

We think it a mistaken view of the position of the collector, to regard his official relation to the proceeds of a forfeiture as ended when they are placed in his hands. The statute imposes the further duty on him to make disposition of those proceeds in a particular manner, and, in executing that duty in one way or another, he acts under the authority of the revenue law, whether he adopts a right or a wrong interpretation of it. If he decides that an informer or an officer of a revenue cutter is entitled to share in the distribution, the naval officer or the surveyor prejudiced by that decision cannot assert that the collector has proceeded in his individual capacity only, and can claim no protection for the act as an official one. The law has placed the fund under his control in his official character, and has required him to act as collector in the disposal of it. Most palpably he would, in such a case, be deemed to have acted under the revenue laws or under color thereof; or would be held to set up or claim a right or authority under those laws to have so acted. No less must he be regarded as acting upon his authority or right as collector, in determining whether the plaintiff was an informer and entitled to demand a share of the forfeiture

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received by the collector, within the meaning of the revenue laws.

Nor do we accede to the argument of the plaintiff's counsel, that the defendant cannot transfer this cause to this Court for the reason that he is sought to be charged in it as a wrong-doer, in withholding moneys to which the plaintiff has a legal title. That doctrine would nullify the provisions of the Act of 1833, because, in every case of prosecution against a collector or other revenue officer, the action seeks to charge such officer with a personal liability for acts asserted to have been done wrongfully and without authority of law. Especially is that so in respect to the collector, when he is sued to recover from him duties levied and exacted on the importation of goods; for, he is then always charged as a wrong-doer for having obtained and withheld moneys belonging to the plaintiff, and which he had no right to demand or detain.

The purpose of the Act of 1833 was to place the jurisdiction over those questions between individuals and revenue officers, in the Circuit Courts of the United States, to the exclusion of State Courts, and we think the present case is one which falls directly within the purview of that statute.

The motion is, accordingly, denied.

GEORGE B. ENGLISH

vs.

THE OCEAN STEAM NAVIGATION COMPANY.

Where goods in cases are shipped by sea, and, on being opened, after delivery, are found to be injured, it will, in an action by the owner of the goods against the carrier, to recover damages for the injury, be presumed that they were properly packed, in a fit state for transportation, by the manufacturer or shipper, unless there is something in their appearance or condition to afford ground for a contrary inference, or unless some evidence to that effect is given.

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And this will be the presumption, although the bill of lading contains the clause, "weight, contents and value unknown."

(Before NELSON, J., Southern District of New York, October 1st, 1852.)

GEORGE B. ENGLISH filed a libel *in personam*, in the District Court, against the Ocean Steam Navigation Company, to recover for damage done to gloves, ribbons, &c., in cases, shipped by one of their steamers, on a voyage from Havre to New York. The principal question in the case, both in the Court below and here, was one of fact—whether the injury to the goods was caused by dampness and heat in the hold of the vessel, occasioned by rough weather and severe storms in the course of the voyage, and was thus within the exception, "accidents of the seas," in the bill of lading, or whether it was caused by the excessive heat of the boiler, and want of sufficient ventilation of portions of the lower part of the vessel occupied by the cargo. The bill of lading contained a memorandum at the foot, "weight, contents and value unknown." The District Court decreed in favor of the libellant, and the respondents appealed to this Court.

Daniel Lord, for the libellant.

Thomas W. Tucker, for the respondents.

NELSON, J. It is insisted, on the part of the respondents, that, as the bill of lading contains the usual clause, "weight, contents and value unknown," the burden lies upon the libellant to show, in the first instance, that the goods were put up in the cases, by the manufacturer or shipper, in good order and condition; and that, in the absence of such proof, the Court are bound to presume that the injury to the goods arose from defects existing when they were packed for shipment, or which occurred previous to the shipment. The law is otherwise. Unless there is something in the appearance or condition of the goods, on their being opened after delivery, affording ground for reasonable inference that they

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were improperly packed, or packed in an unfit state for transportation, or unless some evidence to that effect is given, the contrary will be presumed. (*Cowen & Hill's Notes to Phill. Ev.*, 1439; *Price v. Powell*, 3 Comst. 322; *Barrett v. Rogers*, 7 Mass. 297; *Clark v. Barnwell*, 12 How. 272.)

The main question in the case is one of fact, namely, whether or not the damage was occasioned in the course of the voyage, by one of the perils of the navigation within the bill of lading; and I am quite satisfied with the conclusion arrived at upon the proofs by the Court below.

Decree affirmed.

THE GLOBE.

The extension of Admiralty jurisdiction to the lakes, by the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 726,) did not take away the concurrent remedy which existed at common law, and which is to be sought in the jurisprudence of the States, and usually in the State Courts.

As a general if not universal rule, in order to bind a defendant, or to confer any rights upon a plaintiff, by force of a judgment in a *personal* action, the former must be served with notice of the institution of the suit, so that he may have an opportunity to appear and defend.

But a proceeding *in rem* forms an exception to the general rule, and binds the *res* in the absence of any personal notice to the party interested.

A *foreign* vessel was attached by a proceeding *in rem*, under a law of Ohio, in a Court of that State, for repairs made and supplies furnished, and sold upon a judgment duly recovered in pursuance of such attachment: *Held*, that the judgment was conclusive upon the transfer and disposition of the vessel, in whatever place she might be found, and upon the title to her, by whomsoever it might be questioned, and whether involved directly or collaterally.

Held, also, that this was especially so where the owner of the vessel at the time appeared in the suit in the Ohio Court, and contested the proceedings throughout.

The case of the *Barque Chusan*, (2 *Story*, 455,) commented on and explained.

The rule in respect to maritime liens against vessels for supplies and materials furnished to her master at a foreign port is, that the party first instituting legal proceedings for the purpose of enforcing his claim against the vessel, is entitled to satisfaction out of the proceeds of her sale.

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The true meaning of a maritime lien is, that it renders the property liable to the claim without a previous judgment or decree of the Court sequestering or condemning it or establishing the demand, as at common law, and the action *in rem* carries it into effect.

The appropriation of the property to that end becomes absolute and exclusive on suit brought, unless superseded by some pledge or lien of paramount order.

The first action by which the property is seized is entitled to hold it as against all other claims of no higher character.

The *lien*, so termed, is, in reality, only a privilege to arrest the vessel for the demand, which, of itself, constitutes no incumbrance on the vessel, and becomes such only by virtue of an actual attachment of the same.

G. filed a libel *in rem* in the Admiralty in New York, under the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 726,) against a vessel, to recover for supplies and materials furnished to her in New York, as a foreign vessel, owned in Michigan. Before the filing of the libel, she had been sold in Ohio upon a judgment recovered in a State Court in Ohio, for supplies and materials furnished to her by C. subsequently to the time when G. furnished his supplies and materials. The Ohio judgment was recovered in a proceeding *in rem* against the vessel by attachment under a law of Ohio, she being then also a foreign vessel, owned in Michigan: *Held*, that the priority of time in the furnishing of the supplies and materials by G. gave him no paramount lien on the vessel over the lien of C.

(Before NELSON, J., Northern District of New York, October, 1852.)

WILLIAM H. GLENNY filed a libel *in rem*, in the District Court, against the steamboat *Globe*, to recover the sum of \$445 49, for supplies and materials furnished to said steamboat at the request of her master, at the port of Buffalo Creek, in the Northern District of New York, between the 13th day of June, 1848, and the 10th day of September, 1849. The libel was filed on the 11th of May, 1850, under the Act of Congress of February 26th, 1845, (5 *U. S. Stat. at Large*, 726,) extending the Admiralty jurisdiction in certain cases to the lakes, and navigable waters connecting the same. The *Globe* was a foreign vessel, owned and registered at Detroit, in the State of Michigan, from before the 13th of June, 1848, until after the 31st of December, 1849.

The claimant, in his answer, set up a title to the steamboat, derived under a sale of it by execution upon certain judgments recovered in February, 1850, in the Superior Court of Cleveland, in the State of Ohio, which sale took place on the

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9th of March, 1850. It was claimed that this sale extinguished any lien which the libellant might otherwise have had upon the vessel.

The Ohio judgments were recovered by virtue of a statute of that State, passed February 26th, 1840, entitled "An Act providing for the collection of claims against steamboats and other water-craft, and authorizing proceedings against the same by name," and of an Act explanatory thereof, passed February 24th, 1848. These Acts provided, that steamboats and other water-craft navigating the waters within or bordering upon the State, should be liable for debts contracted on account thereof by the master, owner, steward, consignee or other agent, for materials, supplies or labor in the building, repairing, furnishing or equipping the same; that any person having such demand might proceed against the owner or owners, or master of such craft, or against the craft itself; that, when suit should be commenced against the craft, the plaintiff should file his *precipe* to that effect, naming the craft or giving a substantial description of her, and with it a bill of the particulars of his demand, verified by affidavit; that, thereupon, the clerk should issue a warrant, returnable as other writs, directing the seizure of the craft and the detention of the same until discharged by due course of law; that the master, owner, steward, consignee, or other agent of the craft, might discharge her on giving security that she should be forthcoming to answer the judgment under the seizure; that, on the return of the writ, proceedings should be had as in other cases of process served and returned; that, after judgment, the vessel might be sold upon execution to satisfy the judgment, and the overplus, if any, should be paid over to the owner, master or agent, as in other cases of execution; and that an appeal, as in other cases, might be taken from any judgment rendered against the vessel.

The Globe was seized and sold in Ohio, in the due course of proceedings against her under these statutes, for debts contracted on her account for repairs made and materials, supplies, &c., furnished to her between the 20th of Septem-

ber, 1849, and the 31st of December, 1849. She was purchased at the sale by one Elisha T. Sterling, the highest bidder, for the sum of \$14,000, on the 9th of March, 1850, and, on the 26th of April, 1850, the claimant purchased her from Sterling for the sum of \$17,000.

The above facts, with such others as are stated in the opinion of this Court, are all that are necessary to an understanding of the case, in the view taken of it by the Court.

The District Court pronounced for the libellant, and the defendant appealed to this Court.

Isaiah T. Williams, for the libellant.

William H. Greene and *Solomon G. Haven*, for the claimant.

NELSON, J. The extension of Admiralty jurisdiction to the lakes by the Act of Congress of February 26th, 1845, (5 *U. S. Stat. at Large*, 726,) did not take away the concurrent remedy that existed at common law. Indeed, that Act saves, in express terms, this concurrent remedy, where it is competent, and also any concurrent remedy which may be given by the State laws. It was also saved by the general Act of 1789, conferring exclusive Admiralty jurisdiction upon the District Courts of the United States. (1 *U. S. Stat. at Large*, 76, 77, § 9; *New Jersey Steam Navigation Co. v. Merchants' Bank*, 6 *How.* 344, 389, 390.)

The remedy at common law is to be sought in the jurisprudence of the States, and usually in the Courts of the States. It may be administered in the Federal Courts in cases where the citizenship or residence of the parties enables those Courts to entertain the jurisdiction. (*Act of September 24th*, 1789, 1 *U. S. Stat. at Large*, 78, 79, § 11.) The modes of proceeding in pursuing this remedy are different in the different States, as it respects both the commencement of the suit and the steps taken in conducting it. Undoubtedly, as a general if not universal rule, in order to bind the defendant,

or to confer any rights upon the plaintiff, by force of the judgment, in any personal action, the former must be served with notice of the institution of the suit, so that he may have an opportunity to appear and defend. But a proceeding *in rem* forms an exception to the general rule, and binds the *res* in the absence of any personal notice to the party interested. (*Story's Conf. of Laws*, ch. 14, § 549, and cases cited, and ch. 15, §§ 592, 593; *Boswell's Lessees v. Otis*, 9 How. 336.)

There can be no doubt, therefore, that the judgments in this case, acting *in rem*, must be held conclusive upon the transfer and disposition of the vessel in question, in whatever place she may be found, and upon the title to her, by whomsoever it may be questioned, and whether involved directly or collaterally.

The case of *The Barque Chusan*, (2 Story, 455,) which was referred to upon the argument, contains nothing in conflict with these views. That was the case of a libel in Massachusetts, for materials furnished in the port of New York to a foreign vessel; and one of the grounds of defence was, that the statute of New York respecting the lien of a material-man, provided that the lien should cease when the vessel left the State. This ground of defence was overruled by Mr. Justice Story, for the reason that, in the case of a foreign vessel, the lien attached by force of the maritime law, which entitled the party to come into a Court of Admiralty to enforce it, and that the jurisdiction of the Admiralty, thus acquired, could not be taken away or controlled by the State law. This is very clear. As it respects foreign vessels, the jurisdiction of the Admiralty is not dependent upon the State law, but upon the law of the seas. No matter what may be the regulations of the State on the subject, as regards the jurisdiction of her own Courts, they cannot affect that of the Admiralty; and any State law which should attempt to control the Admiralty jurisdiction would be unconstitutional and void.

The question, what would be the effect of any concurrent

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remedy given by the State law, when it should be enforced against the vessel by a Court of the State, was not involved in the case of *The Barque Chusan*, nor was it examined by Judge Story. The only remark made by him in that case, from which an inference could be drawn in conflict with the views I have expressed in this case, is, that the statute of New York would be unconstitutional if applied to foreign vessels. But that remark was made in answer to the argument that the statute controlled the jurisdiction of the Admiralty; and, in that view, the statute would have been unconstitutional.

It may be remarked, however, that it is unnecessary to place the decision of this branch of the case upon the ground that the Ohio judgments, acting *in rem*, would be conclusive in the absence of any personal notice to the party interested, because Robinson, the owner of the vessel at the time, appeared in the suits in the Court in Ohio, and contested the proceedings throughout.

These views dispose of the case, so far as the claims of the libellant upon the vessel are concerned, unless the fact that his supplies and materials were furnished to her prior to the time when the repairs were made and the materials furnished to her by the Ohio creditors, gives him a lien which, in judgment of law, overreaches the proceedings and judgments in the Ohio Court, and which he is entitled to enforce in the Admiralty.

It has been argued, that this maritime lien against a vessel, for supplies and materials furnished to her master at a foreign port, is an abiding lien, and adheres to the vessel, and may be enforced over all claims of a like nature subsequently accruing in the course of her employment. I cannot assent to this position. On the contrary, I am satisfied that the true rule upon the subject is that, in respect to maritime liens of this description, the party first instituting legal proceedings, for the purpose of enforcing his claim against the vessel, is entitled to satisfaction out of the proceeds of her sale. Upon any other view, the vessel would

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afford no reasonable security to the merchant in making advances or furnishing the necessary supplies; as, for aught he could know, the existing claims against her might exceed her value. It is apparent that, to give to this maritime lien the efficacy claimed, would greatly embarrass and obstruct the commerce and navigation of the country. It would deprive the master, in distant ports, of the means of meeting the exigencies of the service, because the vessel would furnish no adequate security for the necessary supplies or repairs.

The question has been the subject of examination by the learned District Judge for the Southern District of New York. In a case which came before him in 1841, he held that the true meaning of a maritime lien was, that it rendered the property liable to the claim without a previous judgment, or decree of the Court, sequestering or condemning it, or establishing the demand, as at common law, and that the action *in rem* carried it into effect; that the appropriation of the property to that end became absolute and exclusive on suit brought, unless superseded by some pledge or lien of paramount order; that it resulted from the nature of the right and the proceedings to enforce it, that the first action by which the property was seized was entitled to hold it as against all other claims of no higher character; that the lien, so termed, was, in reality, only a privilege to arrest the vessel for the demand, which, of itself, constituted no incumbrance on the vessel, and became such only by virtue of an actual attachment of the same.*

* The case referred to is that of *The Triumph*, in the District Court for the Southern District of New York, July 27th, 1841. The vessel having been sold under a decree and the proceeds paid into Court, a question arose as to the proper distribution of the proceeds, they being insufficient to satisfy all the demands preferred against them. Various libels had been filed against the vessel, and thirteen attachments had been issued and served upon her or her proceeds, and petitions were also brought in by other parties setting up claims to the fund in Court. Suits were brought by different seamen on the same voyage, by seamen on different voyages, by the assignees of wages of seamen, and by

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I concur fully in this view, and, therefore, hold, in this case, that the priority of time in the furnishing of the sup-

material-men for labor, supplies, materials, &c. The actions by the material-men were not brought in the order of time in which their debts accrued.

After passing upon the rights of the respective suitors to a remedy in the Court, and in the form of procedure adopted by them, *BATTS*, District Judge, proceeded as follows:

"The remaining inquiry relates to the order in which the different demands are to be satisfied when of like rank. Are they to be paid *pro rata*, or does the prosecuting creditor who first obtains service of process upon the property, acquire a right to the first satisfaction? And, if any of the demands stand in a common rank, are the costs attending their prosecution entitled to preference in payment?

"An action *in rem* stands on a distinct footing from a suit at common law or in Chancery. The thing arrested is in sequestration to satisfy the specific demand thus fastened upon it. Whether the *res*, in kind, remains in Court, in the custody of the law, to the termination of the suit, or is delivered up on stipulation, itself or its substitute remains subject to the particular claim, and is detained on that alone. The moment the attaching demand is satisfied, the thing attached is surrendered by the Court, and nothing short of another attaching process will justify its longer detention. If other suits are instituted after the property is delivered on bail, (that bail, according to our practice, responding only to the particular suit,) most manifestly the after-demands could not be attached to the fund so raised. And, if the property is not yet delivered out of Court, subsequent arrests of it, while there in custody, would no more inure to place the subsequent actions on an equality with the one holding it under seizure, than they would when it stood released on bond or stipulation.

"The meaning and efficacy of a maritime lien is, that it renders the property liable to the claim without a previous judgment or decree of the Court, sequestering or condemning it, or establishing the demand, as at common law, and the action *in rem* carries it into effect. (*Ingraham v. Phillips*, 1 Day, 117; *Barber v. Minturn*, *Id.* 136.) Thus, the appropriation of the *res* to that end becomes absolute and exclusive on suit brought, unless superseded by some pledge or lien of paramount order; and it accordingly results, from the nature of the right and the proceedings to enforce it, that the first action which seizes the property is entitled to hold it, as against all other claims of no higher character. (*Clerke's Praxis*, tit. 44, *Hill's Adm. Pr.*, 89; *The People v. Judges of New York*, 1 Wend. 39.)

"The lien, so termed, is, in reality, only a privilege to arrest the vessel for the debt, which, of itself, constitutes no incumbrance on the vessel, and becomes such only by virtue of an actual attachment. (*Hall's Adm. Pr.*, tit. 44; *Abbott on Shipping*, part 2, ch. 3, 142; 3 *Kent's Comm.*, 169, 170; *The People v. Judges of New York*, 1 Wend. 39.)

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plies and materials by the libellant gave him no paramount lien on the vessel over the liens of the creditors in the Ohio suits.

The error of the learned Judge below consisted, I think, in holding: 1. That the proceedings and judgments in the Ohio Courts were void on account of the absence of notice to the party interested; and, 2. That the lien of the libellant for the supplies and materials furnished by him to the vessel was paramount and overreached the judgments and sale under the laws of Ohio.

The decree of the District Court must, therefore, be reversed, and a decree be entered dismissing the libel, with costs.

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The Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 88, § 29,) the Act of May 18th, 1800, (2 *Id.* 82,) and the Act of July 20th, 1840, (5 *Id.* 394,) adopt the State regulations respecting the procurement of grand and petit jurors to serve in the Federal Courts, and apply to those Courts the State regulations respecting the *qualifications* and the exemptions of grand and petit jurors.

A challenge to a grand juror for favor, on the ground that he is the prosecutor or complainant upon a charge, or that he is a witness on the part of the prosecution, and has been subpoenaed or been bound in a recognizance as such, goes to the *qualifications* of the juror.

A challenge to the array of the grand jury in a given case, on the ground that they have been selected, summoned and returned by a person unfit to summon an indifferent jury in the case, touches the *qualifications* of the panel.

Therefore, State regulations respecting such challenges are applicable in the Federal Courts.

“Applying these principles to the case before the Court, the prosecuting creditors, (except seamen suing for wages,) are to be satisfied in the order in which the warrants of arrest were served upon the property, whether the vessel in kind, or her proceeds in Court. Each action, with its appropriate costs, comes upon the fund according to the period of its commencement.”

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But *peremptory* challenges in criminal cases in the Federal Courts are regulated by the common law.

The absence of a *venire* for the summoning of a grand jury, in a case where it is required, is a ground of challenge to the array.

Challenges to the array of grand jurors are abolished by the laws of New York, and are consequently also abolished in the Federal Courts in New York.

But still, where there has been any improper conduct on the part of the officers employed in designating, summoning and returning the grand jury, an accused person who is prejudiced thereby has his remedy by motion to the Court for relief.

All objections, however, to the proceedings in the selection and summoning of grand jurors, over and beyond the right of challenge, are presented to the Court for the exercise of its sound discretion, and, although there may be technical irregularities, it will not interpose, unless satisfied that the accused party is prejudiced by them.

Under the Act of August 8th, 1846, (9 U. S. Stat. at Large, 73, § 3,) providing that no grand jury shall be summoned in the Federal Courts except upon an order for a *venire*, to be made by a Judge, a *venire* should be issued by the clerk of the Court, in pursuance of the order.

A verbal order given by a Judge to the clerk in such case is sufficient, though no order be filed or entered of record.

The omission to issue a *venire* in such case, if a ground of challenge to the array, and if taken advantage of at the proper time, is fatal to the panel.

But, if not a ground of challenge, or if the time for making the challenge be passed, it is only a ground for a motion to set aside the panel for cause.

The mere omission, however, to issue the *venire*, is not such cause, where the application is addressed to the sound discretion of the Court.

By the law of New York, (2 R. S. 724, §§ 27, 28,) persons "held to answer," that is, arrested and held to bail to appear at the term of the Court at which the grand jury attends, to answer such complaints as may be presented against them, are the only persons who can challenge either the array of grand jurors, or the individual grand jurors for favor.

Where a party appeals to the sound discretion of the Court to set aside an indictment for irregularities in drawing or summoning the grand jury, he must implicate the good faith of the officers concerned in discharging those duties.

Those officers, in New York, are bound to use the State boxes and the State ballots in drawing grand jurors, as the same are furnished to them by the State officers, and have no right to change or alter either.

It is the uniform practice, in the Federal and State Courts, for the clerk and assistant of the District Attorney to attend the grand jury and assist in investigating the accusations presented before them. That practice must be regarded as settled; but any abuse or improper conduct on the part of any person admitted to the grand jury, will be investigated by the Court.

The Court has no power to inquire into the mode in which the examination of witnesses was conducted before the grand jury, for the purpose of invalidating an indictment.^s

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It will inquire, however, into the manner of swearing the witnesses, when they are sworn in open Court, and into the competency of the evidence, whether oral or documentary, and into the manner of authenticating the latter species of evidence.

Where witnesses before a grand jury are testifying in regard to facts about which they have previously made *ex parte* affidavits, it is not improper for them to consult those affidavits, to refresh their recollection; nor is there any objection to their swearing that certain facts, of which they have previously made statements on paper, are true.

Evidence before a grand jury must be competent legal evidence, such as is legitimate and proper before a petit jury.

On a criminal charge against several persons, for a participation in the rescue of a person from the hands of a public officer who held him in custody, the witnesses who were to testify before the grand jury were sworn in open Court in the following manner: The clerk of the Court was furnished with a general description of the persons accused—*The United States v. M. S. and others*—and then administered to the witnesses this oath: "You, and each of you, do severally solemnly swear, that the evidence you shall give to the grand inquest touching charges against M. S., and others, concerning which you shall be interrogated, shall be the truth, the whole truth, and nothing but the truth. So help you God." Upon the testimony given under this oath, twenty-four bills of indictment were found against twenty-four different persons, one against each. No indictment was found against "M. S. and others," nor was any indictment found against any two persons jointly. On a motion by E. R., the defendant in one of the indictments, to quash it, on the ground that the oath was void as to him: *Held*, that the oath was free from objection.

A general oath to give evidence touching criminal charges to be laid before the grand jury, without reference to any particular person, is unobjectionable.

If the oath embraces one or more persons by name, whose cases are about to be laid before the grand jury, and in respect to which the oath is administered, and nothing more, evidence cannot be given under it in support of any accusation against others.

The Court has no power to revise the judgment of a grand jury upon the evidence, for the purpose of determining whether or not the finding was founded upon sufficient proof, or whether there was a deficiency in respect to any part of the complaint.

When, under § 6 of the Act of September 18th, 1850, (9 *U. S. Stat. at Large*, 463,) known as the *Fugitive Slave Act*, a warrant is issued by competent authority, that is sufficient to justify the arrest and detention of the fugitive until he is discharged by due course of law, and any person concerned in rescuing or attempting to rescue such fugitive out of the custody of the law, subjects himself to the penalties of the Act.

(Before NELSON and HALL, JJ., Northern District of New York, October, 1852.)

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THIS was a motion to quash an indictment found in the District Court at Buffalo, in November, 1851, and transmitted to this Court. The indictment was founded upon the 7th section of the Act of Congress of September 18th, 1850, (9 *U. S. Stat. at Large*, 464,) commonly called the *Fugitive Slave Act*, and the alleged offence consisted in rescuing from the custody of the United States marshal, at Syracuse, Jerry, a person lawfully in his custody under that Act, as a fugitive from service or labor. The indictment contained two classes of counts—one averring that the person rescued was held to service or labor in the State of Missouri, and was a fugitive from such service, and, as such, in the lawful custody of the marshal when the rescue took place—and the other averring that the person rescued was an alleged fugitive from service or labor, and was, at the time of the rescue, in the custody of the marshal, under a warrant duly issued by a United States Commissioner under said Act, he having jurisdiction of the case, and proceedings being in progress before him under said warrant, to determine whether the person rescued was such fugitive or not.

The motion was founded upon affidavits, and affidavits were read in opposition. The defendant had not pleaded, but was now brought into Court for the first time, and arraigned, nor had he been arrested, or held to answer in any way, before the indictment was found.

David D. Hillis, for the defendant, stated two general grounds for the motion: I. Irregularities in obtaining the grand jury by which the indictment was found. II. Irregularities in the proceedings by and before the grand jury, after they were impanelled. Under the first point he was proceeding to urge: 1st. That there were irregularities on the part of the deputy marshal at Buffalo, in drawing the grand jury; 2d. That one of the grand jurors was a volunteer, not having been summoned by the deputy marshal; 3d. That no order was made by the District Judge for a *venire* to summon the grand jury, as required by the 3d section of

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the Act of Congress of August 8th, 1846, (9 *U. S. Stat. at Large*, 73;) 4th. That no *venire* or precept was issued by the clerk of the Court to the marshal, authorizing him to summon the grand jury.

NELSON, J. A preliminary question suggests itself in this case, whether the provisions of the Revised Statutes of New York, (2 *R. S.* 724, §§ 27, 28,) prescribing the objections that may be taken to the organization of grand juries, are not binding on this Court, and whether, under those provisions, we are not precluded from looking into the objections which are raised. The Act of Congress of July 20th, 1840, (5 *U. S. Stat. at Large*, 394,) is the Act now in force regulating the drawing and impanelling of grand and petit juries in the Federal Courts. That Act adopts the State regulations, not only those existing when the Act was passed, but any changes that might be thereafter made by the State in the mode of selecting and impanelling juries. That Act also authorizes the Federal Courts to adopt the State regulations by rule, so far as it may be practicable to do so. And a rule (46) has been made by the District Court for this District, under that Act, adopting the regulations of the Revised Statutes, as respects the organization of grand and petit juries. The State law regulates the length of notice required for drawing grand jurors, the notice necessary in summoning them, their qualifications, and the numbers necessary to constitute a quorum for business, and to find a bill. For regulations as to these matters in the Federal Courts, we must look into the Revised Statutes. There, also, we find that the Legislature has limited the objections that may be taken to grand jurors, either to the array, or to any particular member. We desire the counsel to turn his attention to the point suggested, because, if we take the Revised Statutes as a guide in determining what objections may be looked into, the necessity of examining those now raised may be superseded. It is, therefore, proper to inquire whether we can go behind the indictment, and entertain objections to

the organization of the grand jury beyond those which are prescribed by the State regulations.

Hillis read the sections of the Revised Statutes referred to, (2 R. S. 724, §§ 27, 28.)

“§ 27. A person held to answer to any criminal charge may object to the competency of any one summoned to serve as a grand juror, before he is sworn, on the ground that he is the prosecutor or complainant upon any charge against such person, or that he is a witness on the part of the prosecution, and has been subpoenaed or been bound in a recognizance as such; and, if such objection be established, the person so summoned shall be set aside.

“§ 28. No challenge to the array of grand jurors, or to any person summoned to serve as a grand juror, shall be allowed in any other cases than such as are specified in the last section.”

By the law of New York, certain preliminary notices are necessary in getting together a grand jury. Can these notices be entirely dispensed with, and a mere voluntary body come together as a grand jury, and yet no objection be afterwards made by a party indicted by such body? Suppose the case of a grand jury not drawn at all, but admitted to have been packed. Can a man indicted by it be cut off, by the provisions of the Revised Statutes, from raising the objection?

In the present case, a man served on the grand jury who was not summoned, and there was no order made by the District Judge for a *venire*, and no *venire* issued to the marshal to summon the jury. The defendant had no notice of these irregularities before he was indicted. He was not bound over before indictment, and he now appears in Court for the first time, and is arraigned. Is it a sufficient answer to his objections to say, that he might have objected to any individual grand juror on the ground that he was a witness or prosecutor, and that, not having been present to challenge for those prescribed causes, he cannot now object for any others? If we are bound by the statute, a jury might be

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packed, because that is no ground of challenge under the statute; or half of the jury might be volunteers, instead of the jury being, as Ch. J. Marshall, in Burr's case, said it must be, the jury summoned; or less than the legal number of jurors might be impanelled. [NELSON, J. How far the Revised Statutes go upon the point of precluding objections other than those specified in the statute itself, is a question we desire to hear discussed. Are we tied down to the irregularities specified, or can we go into others?] A grand jury may have been drawn by a constable, or it may be confessedly corrupt. Are all these objections cut off by the statute of New York?

No case can be found in which a Court has refused to look into the conduct of its own officers in drawing, summoning and impanelling a grand jury. (*The People v. Hulbut*, 4 Denio, 133, 136; 6 Carr. & P. 90; *The People v. Jewett*, 3 Wend. 314; and 6 Wend. 386; *United States v. Coolidge*, 2 Gallison, 364; *The People v. McKay*, 18 Johns. 212.) The cases cited are authorities to show that a Court will thus inquire when irregularities are brought to its notice.

The language of the Revised Statutes does not confine the party to the objections specified. It would be absurd for it to do so, where gross irregularities are perpetrated, and when, as here, a citizen applies for redress at the first opportunity.

It was decided by Ch. J. Marshall, in *The United States v. Hill*, (1 Brock. 156,) in 1809, that neither the 29th section of the Judiciary Act of 1789, (1 U. S. Stat. at Large, 88,) nor the Act of May 13th, 1800, (2 U. S. Stat. at Large, 82,) applied to grand juries in the Federal Courts. These Acts prescribed the mode of procuring juries in all cases. They were amended by the Act of July 20th, 1840, referred to, which speaks of "jurors to serve," &c. The language in all three of the Acts is equally general, and, as the first two were held not to apply to grand juries, the last does not.

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James W. Nye, on the same side. The objections raised here ought not to be confounded with challenges or a right to challenge. Such right existed at common law. The statute has only pointed out what shall be causes of challenge in particular cases. The 27th and 28th sections referred to, limit the right of challenge to a person who is "*held to answer*," one recognized to appear at a given time and place, to answer any charge that may be preferred against him by a grand jury then and there to sit. If, in this case, the defendant had appeared at Buffalo, and objected to any grand juror for any cause specified in the statute, he would have been told that he had no right to be heard because he was not *held to answer* there.

But, the want of a *venire* was not ever the ground for a challenge. [NELSON, J. It was a ground of challenge to the array.] Then, no one could take advantage of it, unless "*held to answer*." And the statute leaves it still the duty of the Court, as it ever was, to see that all the steps taken in impanelling the grand jury were regular.

Our objection lies back of the grounds of challenge specified in the Revised Statutes. The proceedings of the grand jury were void for the want of a *venire*. The body which found the indictment was no grand jury, but a tribunal unknown to our laws.

James R. Lawrence, (*District Attorney*), and *Joshua A. Spencer*, for the United States. The objections to the proceedings in impanelling the grand jury are merely a challenge to the array. If the statute of New York regulates the challenge to the array in the Federal Courts, then all the objections fall to the ground. Because, if the challenge could not now be made directly, it cannot be made in an indirect way by a motion to quash.

Congress had power to say that these proceedings should be regulated by the State law, and the State had power to make the regulations it has made. The object of the law as to challenges was, that the proceedings should not be al-

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ways open for a party to object to every little irregularity. And this is no hardship, because the trial before the traverse jury will always sufficiently protect the rights of a defendant.

It is said that the 27th section of the Revised Statutes referred to, only applies to persons brought into Court on recognizance. But the 28th section applies to every person. "No challenge," that is, by any person, "shall be allowed," but for the two causes mentioned in the 27th section.

This regulation is, under the Acts of Congress and the rules of Court made in pursuance thereof, applicable to the Federal Courts. (*Rule 46, District Court, Conk. Tr., 2d ed., 541; Rule 3, Circuit Court, Id. 52 8.*)

The objections made here to the mode of designating the grand jurors, that one of them was a volunteer, that there was no order for a *venire*, and that there was no *venire* or precept, all come under the head of a challenge to the array, and are covered by the 28th section of the Revised Statutes.

Charles B. Sedgwick, in reply. 1. The Act of Congress of 1840 does not include regulations made by the State statute in regard to challenges, nor does the 46th rule of the District Court apply to grand juries. 2. Admitting the 27th and 28th sections of the Revised Statutes to be applicable to the Federal Courts, they do not embrace the objections raised in this case.

Challenges both to the array and to the polls are to be taken before the swearing of the jury. A challenge to the array is made on account of favor, bias or relationship on the part of the officer who summons the jury, but never on account of any irregularity or want of process.

There is a distinction between a challenge and a motion to set aside an indictment for irregularity. A challenge is to be brought before the Court at a given point in the course of the proceedings, and to be then entirely disposed of. A

want of process always appears by the record. A challenge does not. A want of process may be taken advantage of by error or *certiorari*; what is a ground of challenge cannot be. The want of a *venire* is not a ground of challenge to the array. (1 *Chitty's Crim. Law*, 533; *The People v. McKay*, 18 *Johns.* 212; *Nichols v. The State*, 2 *Southard*, 539; *Chase v. The State*, 1 *Spencer*, 218; *The State v. Williams*, 1 *Richardson*, 188.)

The State statute limits the right of challenge to narrow bounds, and if, in consequence, all irregularities which occur before the grand jury are actually sworn are cut off, there is no way of reaching some of the worst evils. It is no answer to say that the rights of a party will be protected because he will have his trial before the petit jury. This view strikes at the provision of the Constitution which requires a due presentment by a grand jury before trial. Every safeguard of the liberty of the citizen should be maintained, but, according to the construction of the prosecuting attorney, no forms are of any importance, if only the defendant be fairly tried by the petit jury.

If a *venire* is required, it is the foundation on which the grand jury stands. If it be wanting, there is no ground for challenge, but the grand jurors have no right to act, and their proceedings are a nullity.

Under the 27th section of the Revised Statutes, a person previously held by recognizance is the only one who can make the challenges specified. If it be held that that section embraces other persons, then those others would be cut off without an opportunity of making even the objections specified. It is said that the 28th section enlarges the exclusion. But, the two sections are to be construed together. If a person not held to answer cannot challenge or obtain relief by motion, but is shut out forever, then the provision of the Constitution that a person charged with crime must be regularly presented by a grand jury, is entirely brushed away.

If, however, the Court should be against us on these objections to matters occurring before the impanelling of the

grand jury, we still have some objections to discuss in regard to matters which arose after the impanelling of the grand jury.

NELSON, J. We have looked into the question which we suggested to the counsel yesterday, and to which we desired them to turn their attention, and are prepared to express our opinion upon it. The question is, perhaps, somewhat a new one, in the aspect in which it has been presented. But the general principle, that is, the adoption of the State regulations in designating, summoning and returning grand jurors, is, so far as it is involved, not new, but has always prevailed in the Federal Courts since their organization. The Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 88, § 29,) the Act of May 13th, 1800, (2 *U. S. Stat. at Large*, 82,) and the Act of July 20th, 1840, (5 *U. S. Stat. at Large*, 394,) adopt the State regulations in respect to the procurement of grand and petit jurors to serve in the Federal Courts, and each of those Acts, especially the Act of 1840, applies to the Federal Courts, in express terms, the State regulations respecting the qualifications and the exemptions of grand and petit jurors.

The question in the present case is, whether or not the provisions of the State Act, (2 *R. S.* 724, §§ 27, 28,) which regulate the rights of a prisoner in the challenging of grand jurors, are applicable to the organization of grand juries in the Federal Courts. Those provisions are as follows :

“§ 27. A person held to answer to any criminal charge, may object to the competency of any one summoned to serve as a grand juror, before he is sworn, on the ground that he is the prosecutor or complainant upon any charge against such person, or that he is a witness on the part of the prosecution, and has been subpoenaed or been bound in a recognizance as such ; and, if such objection be established, the person so summoned shall be set aside.

“§ 28. No challenge to the array of grand jurors, or to any person summoned to serve as a grand juror, shall be al-

lowed in any other cases than such as are specified in the last section."

We entertain no doubt that these two sections bear upon the question of the qualifications of grand jurors and their competency to serve as such. If this be so, it follows that the regulations prescribed by these sections come directly within the Act of 1840, which, in express terms, adopts the State Acts in regard to the qualifications and exemptions of grand jurors.

A challenge to an individual grand juror may be made on behalf of a prisoner, on the grounds that he has not the requisite freehold qualification, or that he is not of competent age, or that he has formed a fixed opinion of the guilt of the accused, or that he is his enemy, and various others which it is not necessary to enumerate. It is too obvious to require any argument that the challenges to an individual grand juror for favor, which are prescribed in the two sections in question, go directly to the qualifications of the juror as a fit and competent person to serve in that capacity.

The challenge to the array, at common law, or according to the English understanding and definition of that term, is founded on the allegation that the sheriff who summoned the grand jury was an improper and unfit person to discharge that duty, as by reason of his being related to one of the parties—his relationship to the prisoner being a ground of challenge on the part of the King—and it being a ground of challenge by the accused that the sheriff is his enemy, or that the relations between them are such that, in view of a proper administration of justice, the sheriff is not a proper person to summon the grand jury who are to be the triers of the accused. It being thus a ground of a challenge to the array, in a given case, that the jury have been selected, summoned and returned by a person unfit to summon an indifferent jury to sit and judge in the case, and it being the presumption that such a person would summon a jury not indifferent, but prejudiced, as respects the case to be heard, the challenge to the array, so authorized, necessarily, though

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perhaps more remotely, touches and reaches the proper qualifications of the panel to sit and act in the particular case.

So that, in point of law, as well as in truth, both the challenge to the favor and the challenge to the array, directly or indirectly, in each case, go to the determination of the proper qualifications of grand jurors, either as individuals or as a panel. And, if we are right in our premises, it follows that the two sections in question are directly within the Act of Congress of 1840, and are applicable in regulating the selection, summoning, returning and organization of grand juries in the Federal Courts.*

Whether the fact that a *venire* or a precept has not been issued by the proper authority in cases where it is required by law for the purpose of summoning and returning a grand jury, is a ground of challenge to the array, may be, perhaps, an open question, or one admitting of some observation and doubt. We are inclined to think, however, that if an objec-

* The principles here laid down are not applicable to *peremptory* challenges in criminal cases in the Courts of the United States. Such challenges in those Courts are regulated by the common law. (*United States v. Marchant*, 12 Wheat. 480; *United States v. Wilson*, 1 Baldwin, 78.) The Acts of Congress on the subject of jurors do not regulate *peremptory* challenges to jurors in criminal cases. The 29th section of the Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 88,) enacts that "jurors in all cases to serve in the Courts of the United States," "shall have the same *qualifications* as are requisite for jurors by the laws of the State of which they are citizens, to serve in the highest Courts of law of such State;" and the Act of July 20th, 1840, (5 *U. S. Stat. at Large*, 394,) provides that "jurors to serve in the Courts of the United States, in each State respectively, shall have the like *qualifications* and be entitled to the like *exemptions* as jurors of the highest Court of law of such State now have and are entitled to." A *peremptory* challenge not being made for any assigned cause, and having no reference to the *qualification* or *exemption* of the juror, the Acts of Congress above referred to do not cover it. And the 34th section of the Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 92,) which provides that "the laws of the several States, except where the Constitution, treaties or statutes of the United States shall otherwise require or provide, shall be regarded as rules of decision in *trials at common law* in the Courts of the United States, in cases where they apply," does not apply to *criminal* cases. (*United States v. Reid*, 12 *Howard*, 361. See *The United States v. Douglass*, (*ante*, p. 207.)

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tion were made on that ground, at the proper time, it might be made as a challenge to the array. Because, in judgment of law, if a grand jury has been summoned and returned by a person who is not authorized to designate, summon and return the panel, the array of the jury thus summoned and returned would seem to be objectionable as a panel, and therefore objectionable under a challenge to the array or to the panel. If, then, the absence of a *venire* or of a precept, in a case where the law requires one, is a ground of challenge to the array, which we are inclined, upon principle, to think it is, the challenge is abolished by the 28th section of the statute referred to, and it is, consequently, also abolished in the Federal Courts.

It is very probable that the Legislature of New York were induced to abolish the challenge to the array on account of the change from the English mode in the system adopted for the purpose of designating and summoning grand jurors. In England, (and so it was in the Federal Courts until the Act of Congress was passed adopting the State regulations,) the sheriff, on receiving the *venire*, makes a selection of the jurors from the body of the county, at his discretion. Hence the importance that is there given to the proper qualifications of the sheriff, in respect to the parties concerned, to summon the jury; because, if he is disposed to summon one to accomplish a particular object, it is entirely within his power to do so. But, according to the system prevalent in the State of New York, the law provides for the selection of the members of the grand jury with great care and particularity. In the first place, they are selected from the body of the county by the Board of Supervisors, and separate ballots containing their names are placed in a box kept by the clerk of the county, from which the requisite number are drawn by lot to form the jury, and the names so drawn are the persons to be summoned and returned. If, therefore, the law is complied with in the selection and summoning of grand jurors, none of the officers employed in the discharge of that duty can exercise any discretion whatever, and hence, no doubt, the Legis-

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lature came the more readily to the conclusion that the right of challenge to the array was not of the same importance under our system as under the system that prevails in England.

We are quite free to say, however, that although the challenge to the individual members of the grand jury for favor is abolished, except in the two cases specified in sections 27 and 28 of the statute referred to, and although the challenge to the array is wholly abolished, it by no means follows that the accused has no remedy in a case where there has been any improper conduct on the part of the public officers employed in the designating, summoning and returning of the grand jury. If there has been any improper conduct on the part of those officers in performing that service, or if any fraud has been committed, through their instrumentality, in the drawing, summoning or organization of the grand jury, of course, the accused who may be prejudiced thereby has his remedy, by motion to the Court for relief in consequence of such irregularity or fraud. Because, the selecting, summoning and returning of grand jurors are proceedings which are always under the general supervision and control of the Court, and the Court will guard them, and will see to it that no one shall be prejudiced thereby.* The Court has general power to preserve the pure administration of justice, and its sound discretion will always be exercised freely for the purpose of securing that end.

These objections, however, to the proceedings in the selection and summoning of grand jurors, over and beyond the right of challenge, are presented to the Court for the exercise of its sound discretion. It will, therefore, look into the facts presented, on which a charge is made against the regularity of the proceedings in the selection and summoning of grand jurors in a given case, and will hear the explanations on the other side, and its judgment will be determined accordingly. If it sees that there has been improper conduct in the public officers, which has resulted prejudicially to the party accused, it is bound to set aside all the proceedings.

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On the contrary, although there may be technical objections to the proceedings in point of strict regularity, yet, unless the Court is satisfied that they have resulted or may result to the prejudice of the party accused, it will not set them aside, because its interposition in the case will not be required on the ground of justice either to the accused or to the public.

We are inclined to think that the question, whether or not the absence of a *venire*, where it is required by law, forms a ground of challenge to the array, is of no practical consequence in this case; because, even if it were a ground of challenge to the array, and the party had not made the challenge, not having had notice of the facts on which it could be grounded, yet, if it could be shown that corruption or fraud had entered into the selection, summoning or returning of the grand jury, the Court would hear an application for relief founded upon its power and duty to control and regulate the proceedings so as to prevent injury and oppression. The only difference between the two cases is, that where a challenge to the array is made, it is, if maintained, fatal to the panel, and the panel becomes invalid by operation of law; but, where the party is obliged to make a motion to set aside the panel on the ground of improper conduct on the part of public officers, there is then no inflexible rule of law applicable to the case, but it rests in the sound discretion of the Court to see that no injury results from the impropriety. The Court will look, therefore, into the facts, to see whether there is anything to satisfy their minds that the jury thus summoned is not a fit body to exercise the powers conferred upon it.

If the absence of a *venire* is not a ground of challenge to the array, the result is still the same. The conduct of public officers in summoning the jury, if improper, is not thereby protected, and the injured party has his remedy by motion. In either case, the appeal is to the discretion of the Court.

The Act of Congress of 1840, in connection with the 46th rule of the District Court for this District, provides for the

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designation, summoning and returning of grand jurors without any *venire* or precept of any kind. Such has been the practice in this District ever since the adoption of the 46th rule, no doubt on a sound construction of the Act of 1840. That Act conferred full authority on the District Court to adopt the 46th rule, which simply requires a notice by the clerk, within a proper time, to the marshal, to summon the jurors. The marshal then draws and summons them according to the State regulations as far as practicable, and makes a return on the jury list, which is filed, and which furnishes all the authority necessary for impanelling the jury.

Were it not for the Act of August 8th, 1846, (9 *U. S. Stat. at Large*, 73, § 3,) no question would arise as to a *venire*. The Act of 1846 changed the law as it then existed, but the obvious extent of that change, as designed by Congress, and as appears from the face of the law, was to remove the necessity that previously existed of summoning a grand jury at every term of the Circuit and District Courts, with a view to diminish expenses. Therefore, the Act provides that no grand jury shall be summoned for any term of a Circuit or District Court, unless the Judge, in the exercise of his discretion, or on the application of the District Attorney, shall order a *venire* to be issued to summon a grand jury. Now, although the purpose of that Act was to get rid of the necessity for the regular attendance of a grand jury at every term, and it, therefore, devolves power on the Judge to order a grand jury when necessary, yet it does provide in terms that a grand jury shall be summoned by an order for a *venire*, to be made by the Judge. And, undoubtedly, in compliance with the terms of that Act, a *venire* should be issued by the clerk of the Court in pursuance of the order of the Judge. For, although the Act only says that there shall be an order for a *venire*, yet it implies that a *venire* shall issue in pursuance of the order.

In this case, a verbal order for a *venire* was given to the clerk. If he had fulfilled his duty he would have entered

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it on the records of the Court. What the clerk does by the authority of the Judge is done by the Judge himself. It is not necessary that the Judge should put an order on file, but an order, if entered by the clerk, is of the same effect as if it were entered by the Judge with his own hand. Here, an order was made by the Judge, and the only point of objection in the case is the omission by the clerk to issue a *venire*. If the omission of the *venire* were a ground of challenge, and the party had availed himself of it at the proper time, it would have been fatal. But, if not a ground of challenge, or if the time for making the challenge be passed, then it is only a ground for a motion to the Court to set aside the panel for cause shown. But, the mere technical omission on the part of the clerk to issue a *venire* is, of itself, no cause for the action of the Court, where the appeal is not to the application of an unbending principle of law, but to the sound discretion of the Court. The general principle is, that the omission of an officer to do his duty will not be allowed to operate to the prejudice either of an individual or of the public, unless it is shown to have operated to the prejudice of the party who complains of the omission.

It has been urged by the counsel for the prisoner, that the 27th and 28th sections of the statute referred to apply only to persons who have been arrested and held to bail to appear at the term of the Court at which the grand jury attends, to answer such complaints as may be presented against them. That is true, and they are the only persons who can challenge either the array or the individual jurors for favor; because, these challenges must be made at the time the grand jurors are called and impanelled, and only those persons who are bound over to appear have the right or the opportunity to make either of these challenges. At common law, persons not bound over never had the right or the opportunity to challenge either the individual grand jurors or the array. Hence those persons could never avail themselves of any improper conduct in summoning or returning the grand jury,

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except by way of motion, addressed to the sound discretion of the Court, to prevent any prejudice to the rights or interests of the accused.

From these views it results, that the question at this stage does not stand upon the doctrines applicable to challenges, but upon the allegation on the one side and the denial on the other, that the grand jury has been drawn, summoned and returned improperly or through fraud, and in a way that has resulted to the prejudice of the accused, and that the Court is, therefore, bound, in the exercise of its sound discretion, to look into the proceedings. The question will turn on the aspect of the case as presented by the affidavits on the part of the accused and those upon the other side; and we shall be obliged to determine it upon our view, not of the technical irregularities and objections, but of the case generally, as respects justice between the individual and the public. If we shall be satisfied that there was nothing in these proceedings, although they may have been irregular, which could work to the prejudice of the accused, we cannot, in the exercise of a sound discretion, set them aside. If, however, we shall be satisfied that they have worked injustice, we shall be bound to interpose.

There are two or three questions presented by the counsel for the prisoner, which are not embraced in the view we have taken, that the proceedings in question must be regulated by the provisions of the Revised Statutes of New York in respect to challenges. Those questions are founded on matters arising after the impanelling of the jury, and are open for observation, without regard to the application of any one of those provisions. Upon those questions we are, of course, disposed to hear any observations that counsel may desire to present, as we are also ready to hear any views they may desire to present in regard to any prejudice or injustice that has been suffered through the manner in which the jury has been designated, summoned and impanelled.

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Hillis then proceeded to argue that the defendant might have been and was prejudiced by the mode of designating the grand jurors. [NELSON, J. The right of challenge in this case being cut off, the remedy of the party is narrowed to an appeal to the sound discretion of the Court, in case any irregularities have occurred in drawing or summoning the grand jury, which may have operated to his prejudice. But the good faith of the officers concerned in discharging the duties of drawing and summoning must be implicated.] We insist that, if an officer puts himself in motion to summon a grand jury without a *venire*, the question of his good faith in doing so is involved. [NELSON, J. We have held that the question as to the *venire* is not open. The counsel, in order to avail himself of the ground left open, must present a case in which he implicates the good faith of the officers concerned in selecting, summoning and returning the grand jury.]

The box from which the ballots in this case were drawn, instead of having a small hole in its top for that purpose, had a sliding cover, and, when that was drawn out, the ballots were in full view of the person drawing. Nor were the ballots folded so as to render the names invisible, as required by the statute. (2 R. S. 721, § 6.) These were irregularities which would almost surely work to the prejudice of the defendant, in a case where the officer drawing had any feeling in the matter. [NELSON, J. How can the officer be held responsible for the construction of the box and the formation of the ballots? He has no control over them. He is to take the box furnished by the State officers. He has no right to fold the ballots, or interfere with them, in any way, except to draw them. He must take the State ballots. The Act of Congress having adopted the State box and the State ballots, and made it the duty of the officer to draw, we do not see how it can be objected that the ballots were drawn from that box and from among those ballots.]

I pass now to irregularities in the proceedings after the grand jury was sworn and impanelled.

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A son of the District Attorney, not sworn in any manner, was permitted to mix with the grand jury while it was in session, and to participate in the proceedings before it. Such a practice destroys the secrecy of the institution of the grand jury, which is its most important feature. No person should be permitted to be present at its sessions except the witnesses and the sworn officers of the Court. [NELSON, J. The only point that can arise on this branch of the case is, whether the person admitted to the grand jury was guilty of any improper conduct while there, which operated unduly on the minds of the jurors. It is the uniform practice, in the Federal and State Courts, for the clerk and assistant of the District Attorney to attend the grand jury, and assist in investigating the accusations presented before it. That has been the practice, to my knowledge, without question, ever since I have had any connection with the administration of criminal justice. In England, even the prosecutor may appear before the grand jury and aid the representative of the Crown in respect to the evidence and the management of the case. We cannot, at this late day, overturn a uniform practice that has been settled for so long a time. You must assume that the attendance of the clerk of the District Attorney before the grand jury, to aid in bringing out the testimony, is admissible. But, if any abuse has been committed by him, or by any other person, it is a proper subject for investigation by the Court.] We charge no abuse, except the mere fact of his being present.

The next point is, as to the oath administered in open Court to the witnesses who testified before the grand jury. They were sworn in this manner: "You, and each of you, do severally solemnly swear, that the evidence you shall give to the grand inquest, touching charges against Moses Summers and others, concerning which you shall be interrogated, shall be the truth, the whole truth, and nothing but the truth. So help you God." Upon the testimony given under this oath twenty-four bills of indictment were found against twenty-four different persons, one against each. No indictment was

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found against "Moses Summers and others," nor was any indictment found against any two persons jointly. Could any person who swore falsely against the defendant be indicted for perjury on this oath? The witnesses were not sworn at all so far as the defendant was concerned, and the indictment against him was found on testimony not on oath. (*Swith v. Clark*, 12 *Howard*, 21; 1 *Chitty's Crim. Law*, 322; *United States v. Coolidge*, 2 *Gallison*, 364.) The oath here was not a general oath, naming no person, and swearing the witnesses as to any matters they might be inquired of before the grand jury. But it was a particular oath, confined to a particular cause. And an indictment will be quashed unless the witnesses are regularly sworn. (6 *Carr. & P.* 90; *State v. Roberts*, 2 *Dev. & Batt.* 540; *Wharton's Crim. Law*, 124; *State v. Cain*, 1 *Hawks*, 252; *State v. Fellows*, 2 *Hayward*, 340; *The People v. Hulbut*, 4 *Denio*, 133.)

Another objection we have to urge is, that *ex parte* affidavits were used before the grand jury instead of oral testimony. Those affidavits were made originally for the purpose of issuing warrants against the parties accused. On the examination of the parties after arrest, the same affidavits were again used. And they were used a third time before the grand jury, where they were read and the witnesses asked if the statements in them were correct. This was an irregularity. In an *ex parte* investigation as to a person not present, the witnesses should have been interrogated as to what they remembered concerning the transaction. [NELSON, J. Have you any authorities that go to permit an inquiry into the mode of proceeding before the grand jury in the taking of testimony, or into the weight or sufficiency of the testimony, for the purpose of invalidating an indictment? As regards the manner of swearing the witnesses, when they are sworn in open Court, and the competency of the evidence, whether oral or documentary, and the manner of the authentication of the latter species of evidence, we can inquire. But, so far as regards the mode of conducting the examination of witnesses who are properly before the grand jury, we are aware

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of no principle which authorizes us to revise the proceedings of the grand jury. Now, the affidavits in question here were, as we understand it, used before the grand jury in the course of the examination of the witnesses themselves who made the affidavits. The witnesses were called to testify in regard to facts about which they had previously made affidavits. The affidavits were used to refresh their recollections and to save time. The witnesses, being present before the grand jury, were to be examined according to the discretion of that body, over which we have no control. It is no new practice for witnesses to consult, for the purpose of refreshing their recollections, statements which they have previously made, although they cannot swear from the statements. There is no objection, however, to the witnesses swearing that certain facts, of which they have previously made statements on paper, are true.]

Again. An *ex parte* affidavit, purporting to have been taken in Missouri, and to have been made by the alleged owner of Jerry, was the only evidence before the grand jury that Jerry was a slave, that he owed his alleged owner service, that he escaped from Missouri to New York, and that the person rescued was the identical Jerry who escaped. [NELSON, J. Evidence before a grand jury must be competent legal evidence, such as is legitimate and proper before a petit jury. *Lawrence*.] The affidavit of the owner referred to was annexed to the warrant, and was the same affidavit that was used before the United States Commissioner, and on which he issued his warrant in the case. It was produced before the grand jury by the Commissioner himself, who was sworn as to the issuing of the warrant upon it, and the only object for which it was used before the grand jury was to show what the Commissioner who issued the warrant had before him, with a view of showing that he had jurisdiction to issue it, and that it was valid in the hands of the officer, and that the rescue was in violation of the Act. [NELSON, J. Can a motion to quash an indictment be made on the ground that the grand jury found it on insufficient evidence, or even

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without any evidence as to any particular point? Can you produce any authority for setting aside an indictment on that ground?] In *Low's Case*, (4 *Greenleaf*, 439,) the affidavit of a grand juror was received to show that an indictment was found by less than twelve of the jury. In *United States v. Coolidge*, (2 *Gallison*, 364,) an indictment was set aside on the ground that it was found on the evidence of witnesses who had not been sworn at all. [NELSON, J. In this last case, the inquiry was in regard to a fact that transpired, not before the grand jury, but in open Court. HALL, J. The affidavit of the party here, as to the alleged defect in the evidence before the grand jury, is merely on information and belief. If objection be made by the defendant, no affidavit of a grand juror, or of the District Attorney, or of any person who was present before the grand jury, can be used to rebut it. If, in such a case, an affidavit on information and belief be held sufficient, every indictment must be quashed. I am aware of no case where any Court has ever re-examined the evidence before a grand jury, to see whether it was sufficient. The result of such a practice would be, that in every case the Court would be obliged to try a party on affidavits, on a motion to quash the indictment.] Affidavits of grand jurors are always admitted to sustain an indictment. Besides, in this case, the affidavits on the other side admit our allegation, as to the defect of evidence, to be true, by not denying it. [HALL, J. Can you show, by authority, that the affidavit of a grand juror is competent for the purpose of showing that sufficient evidence was given to find the indictment? The position that your allegation is admitted because it is not denied, begs the question, which is, whether your affidavit is sufficient to call for either an admission or denial. You can have no legal information as to the fact that there was no evidence before the grand jury. The indictment itself is evidence that it was founded upon sufficient testimony, while you are speaking, upon information and belief and mere hearsay, on a subject as to which you can have legally no information. And this, you maintain, shall control an indictment presented

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by a grand jury upon oath.] The doctrine suggested would go so far, if carried out, as to allow no remedy, even if it appeared that there was no proof at all before the grand jury on which to find an indictment.

Spencer, for the United States. All the questions raised by the defendant have been disposed of except three. 1. As to the oath administered to the witnesses. 2. As to the affidavits used before the grand jury. 3. As to the want of sufficient evidence on which to find the indictment.

1. As to the oath, the argument for the defendant has proceeded on the assumption that a suit was pending between the Government and the defendant, at the time the oath was administered. This is a mistake. The proceedings were merely initiatory. It was wholly unknown who would be implicated in the transaction.

The oath was equivalent to a general oath, which is sufficient. (*Ward v. The State*, 2 *Missouri*, 120.) It required the witness to speak the truth as to any matter about which he should be interrogated before the grand jury. The oath related to the matter, and it was not necessary it should be limited to any particular individual.

It is objected that separate bills were found against the several parties implicated. The transaction was a misdemeanor, in which all were principals, and all jointly and severally liable for everything that was done while they were acting in concert. Whether the indictments would be joint or several was unknown, and was a matter within the election of the District Attorney, and could make no difference in the deliberations of the grand jury.

The investigation was as to one entire transaction, a simple proceeding, and the oath was, to give evidence as to any matter about which the witness should be interrogated, in relation to that transaction, respecting Moses Summers and all others who might have been engaged in it.

It is said that perjury could not be predicated on this oath. This is not so. It would sustain a count that false evidence

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was given against the party who complains. The witnesses were bound to speak the truth in regard to each and all of the persons concerning whom they should be interrogated.

The oath administered was the only one which could have met the exigency of the case. It cannot be that the grand jury are to suspend their proceedings, and that a witness is to stop in his testimony, every time a new name is introduced, in order that the witness may be sworn as to that particular individual.

2. As to the use of affidavits before the grand jury. Each affidavit became common law evidence the moment the witness said that the statement to which his name was signed was true. The affidavit was not read to the grand jury as an affidavit. But it was read to the witness, and, when he said it was true, the evidence was the same, in legal effect, as if given orally. It was only a brief way of examining the witness.

3. The last point is not open for inquiry. The question whether there was sufficient evidence before the grand jury on which to find the bill, is a field into which the Court will not enter. It is a startling proposition, that a Court is to be allowed in every case to inquire whether, on the whole, the grand jury were warranted in finding a bill.

The question here is not whether the bill was found without any evidence, but whether it was found on sufficient evidence. The indictment, presented on oath, and a matter of record, is conclusive evidence that it was found on sufficient testimony. It is only before the traverse jury that the evidence can be gone into again. When the grand jury admits improper evidence and abuses its trust, the Court sometimes interferes. But the door is not open to inquire whether there was sufficient evidence on which to find the bill.

In *Low's Case*, (4 *Greenleaf*, 439,) where the bill was found by less than twelve of the grand jury, it had no jurisdiction, and consequently the indictment was no indictment.

But, the allegation that the evidence was not sufficient is made only on information and belief. Can the Court inquire

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into the matter on the mere suggestion of the party? What, in such case, becomes of the presumption that every public officer discharges his duty? We are under no obligation to speak in answer to such an allegation. The law does not presume that we have the means of speaking.

But the indictment contains two sets of counts—one set founded on the allegation that Jerry was a fugitive—the other on the allegation that he was an alleged fugitive, and that proceedings were in progress to determine the fact. There is no pretence that the evidence was not sufficient to support the latter class. (*Roscoe's Crim. Ev.* 233; *Wharton's Crim. Law*, 133; *Resp. v. Cleaver*, 4 *Yeates*, 69; *State v. Baldwin*, 1 *Dev. & Batt.* 198; *State v. Mathis*, 3 *Pike*, 84.)

Sedgwick, in reply. There is a distinction between the oath here and a general oath. In an indictment for perjury, the oath must be stated exactly as it was administered; and, under the oath here, if an attempt were made to prove that the witness swore falsely in a proceeding against the defendant, the variance would be fatal.

There was here no joint indictment, and the oath was taken in a case in which no indictment was found, and no oath was taken in the case against the defendant. The oath was not equivalent to a general oath.

As to the admission of incompetent evidence. The accused has no access to the grand jury room, to obtain proof. He cannot compel, nor will the Court permit, the grand jurors to disclose what took place before them. Nor can he compel the District Attorney or his clerk to give their affidavits as to what transpired in the grand jury room. The only way, then, that a party can know of an irregularity is by information and belief, and all that is left to him is to make a suggestion to the Court. If, then, incompetent testimony vitiates an indictment, and if the only mode of reaching the question is by a motion to quash, and if the affidavit of the party on information and belief is the only foundation that can be had

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for the motion, then, such an affidavit requires an answer from the District Attorney, who can call on the grand jurors to give evidence in reply, and can give it himself.

No witness was produced before the grand jury as to the ownership or escape of the slave. The only evidence on those points was by affidavit. The case was not one of insufficient evidence, but of a want of evidence as to vital points.

NELSON, J. Several of the questions raised on this motion on behalf of the defendant to quash the indictment, having been already disposed of in the course of the argument, we shall only refer to those remaining, and which are deemed worthy of notice.

The first is in respect to the oath administered to the witnesses who were sent before the grand jury. They were sworn in open Court, on a criminal charge against several persons for a participation in the rescue of a person from the hands of a public officer who held him in custody, and in the following manner: The clerk of the Court was furnished with a general description of the persons accused,—“*The United States v. Moses Summers and others*,”—and then administered to the witnesses, in due form, an oath, as follows: “You, and each of you, do severally solemnly swear, that the evidence you shall give to the grand inquest, touching charges against Moses Summers and others, concerning which you shall be interrogated, shall be the truth, the whole truth, and nothing but the truth. So help you God.” The argument is, that this oath was void, as it respected all persons accused before the grand jury, or, at least, as it respected all except the one particularly named; and that the evidence, therefore, given before that body, and upon which the indictment was founded, was not delivered under the sanction of an oath.

It was admitted on the argument, and we suppose there can be no doubt as to the correctness of the position, that a general oath to give evidence touching criminal charges to be laid before the grand jury, without reference to any par-

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ticular person, would be unobjectionable. This seems to be the practice adopted in some of the State Courts. But it is supposed that the description attempted to be given of the persons accused, in the instance before us, and to which the oath refers, vitiates it.

It is true, if this description had embraced one or more persons by name, whose cases were about to be laid before the grand jury, and in respect to which the oath was administered, and nothing more, the objection would have been well founded, so far as concerned evidence given in support of any accusation against others. It must then have been confined to complaints against the persons specified. But, in the case before us, the oath was not restricted to any specified number of persons mentioned, or to the single person named. The witnesses were sworn to give evidence touching charges against him and any other persons concerning whom they should be interrogated by the grand jury. And, if a general oath to give evidence touching charges against any and all persons concerning whom they might be thus interrogated, would be unexceptionable, of which we think there can be no doubt, it would seem difficult to maintain the objection made to the oath in this instance. It is no more general and unrestricted, as it respects the persons against whom complaints may be made before the grand inquest, in the one case than in the other, but applies to every complaint presented for examination.

There are no authorities to be found in the English books upon this question; as the mode of proceeding before the grand jury in England, in finding bills of indictment, differs from the practice usually adopted in this country. There, the indictment is drawn by the proper officers before the case is presented for examination, and the witnesses are sworn in the particular case. Here, the initiation of the proceedings is by swearing the witnesses and sending them before the grand jury, and the bill is drawn after they have agreed upon it. There is no cause pending in Court, or even before the grand jury, in the legal sense of the term, at the

time the witnesses are sworn, and, in consequence, no title to the proceedings can properly be given, or be necessary to the validity of the oath. If the person to be accused before the grand jury is named, it is simply for the purpose of giving application to the oath, or to the evidence under it; and, as we have seen, this application has been regarded as sufficiently direct and explicit when the oath is administered generally, and as relating to all persons concerning whom charges are to be made before that body.

Indeed, if the description of the case given to the clerk could be properly regarded as a title to the proceedings, in a technical sense, there might be some difficulty in maintaining the validity of the oath to these witnesses, as no such proceeding was then pending, in contemplation of law. An affidavit taken in a suit in which the title is given, is invalid if no such suit is pending. But, we do not regard the memorandum given to the clerk, as already referred to, in this case or in any other, even where the accused are all specially named when the oath is administered, as a title, within the technical meaning of that term, but, as used simply for the purpose of giving application to the oath and to the evidence to be given thereafter under it. And, as the oath may be general as it respects all persons who may be accused, it would seem to follow, necessarily, that the form in which it was administered in this case is not liable to any well-founded objection.

Another ground taken in support of the motion to quash the indictment is, that there was no evidence laid before the grand jury tending to prove that Jerry was a person held to service in the State of Missouri, or that he was a fugitive from such service, at the time of his arrest and detention by the officer, or when the rescue took place, and that for this cause the indictment is founded on insufficient evidence, and, as it respects this fact, in the absence of evidence.

The indictment contains two classes of counts, one embracing an averment of these facts, and the other omitting

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this averment, and resting the counts upon a statement of facts showing that the magistrate had jurisdiction of the case, the issuing of the warrant, the arrest, &c.

The affidavit upon which this ground for sustaining the motion is founded, charges the absence of this evidence before the grand jury upon information and belief only—a charge, as is obvious, that may be readily made by the accused in any case where an indictment has been found, and which, if maintainable on such an allegation, might devolve upon the public prosecutor and the Courts, in all cases, the necessity of going into the evidence before the grand jury, for the purpose of re-examining and revising the adjudication of that body; and this, without any authentic record of the evidence produced before them, or any means of arriving at that evidence. They are not bound to keep a record of the evidence taken before them, and are prohibited from disclosing their proceedings, and so, also, are all other persons who have access to or are permitted to participate in those proceedings. They are allowed by statute, in some of the States, to testify whether the evidence of a witness examined before them is consistent with or different from the evidence given by him before the Court, and also upon a complaint for perjury, or upon a trial for that offence, to disclose the testimony given by any such witness; and, perhaps, evidence in these cases might be given by them at common law and without the aid of the statute. It is even doubtful whether they will be allowed to disclose the fact that a bill of indictment was found by a less number than twelve of their body, the authorities being contradictory. (*The King v. Marsh*, 6 Ad. & Ell. 236; *Low's Case*, 4 Greenl. 439; *Roscoe's Crim. Ev.*, 192; *The People v. Hulbut*, 4 Denio, 133; *Regina v. Cooke*, 8 Carr. & P. 582; *The People v. Jewett*, 3 Wend. 314; *Wharton's Crim. Law*, 129.) The rule is founded upon public policy, to guard against abuses that might arise from a disclosure of their proceedings to the accused, and to protect witnesses who may have given evidence before them, from being exposed to the ill-will and

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resentment of parties indicted. The permission to disclose in the case of a complaint for perjury, or for the purpose of contradicting a witness, seems to remove every well-grounded objection to the rule.

No case has been cited, nor have we been able to find any, furnishing an authority for looking into and revising the judgment of the grand jury upon the evidence, for the purpose of determining whether or not the finding was founded upon sufficient proof, or whether there was a deficiency in respect to any part of the complaint; and the grounds and reasons which we have briefly alluded to, account sufficiently for the absence of any such precedent.

The unfitness and inconvenience of an inquiry into the evidence before the grand jury, in this *ex parte* and informal manner, afford, also, strong grounds of objection to any such practice. The re-examination and revision of the evidence before them, attempted to be established by *ex parte* statements, and upon the allegation of information and belief by interested parties, would necessarily lead to abuses in the administration of criminal justice, besides involving it in endless and profitless litigation. It presupposes improper, if not dishonest conduct, in the members constituting the body, and seeks to establish the fact in this loose and imperfect mode of arriving at the truth, and under circumstances in which the jurors themselves are precluded from vindicating their proceedings. For, it was well remarked by the learned Judge who delivered the opinion of the Court in the case of *The People v. Hulbut*, (4 Denio, 133,) upon this subject, that "the evidence which the defendant proposed to give could amount to nothing less than an impeachment of the grand jurors. They had found a bill charging the defendant with five different offences, and the substance of the offer was to show that only one offence had been proved before them." "It cannot be proper," he further observed, "to allow the jurors to be thus assailed. To permit the question to be tried over again in another place, whether

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the indicting jurors had sufficient evidence or any evidence to warrant their finding, would be plainly contrary to the policy of the law, which, in everything that may affect the jurors themselves, has placed the seal of secrecy upon their proceedings." These remarks were made in a case where the evidence to impeach the proceedings was offered on the trial, a mode much less exceptionable in arriving at the truth, than upon *ex parte* affidavits.

In the administration of criminal justice, confidence must be reposed somewhere; and it must be admitted that there are few bodies concerned in it that may be more safely trusted than the grand inquest of the county. They are selected for their intelligence, probity and character, from the whole body of the county. In the county of Erie, whence this jury were drawn, the list out of which it was selected is limited to the number of three hundred, in a population of some one hundred thousand; a fact that more strongly illustrates the high character and qualifications of the grand inquest of the county for the discharge of the important duties devolved upon them, than any remarks we could make.

But, assuming that we may be mistaken in these views, there is another, which it is proper to notice, equally decisive of this motion. We have already stated that this indictment contains two classes of counts, and that one of them rests upon a statement of facts showing that the magistrate had jurisdiction of the case to issue the warrant, the issuing of the same, the arrest, &c. If this class of counts is well founded, and of which we entertain no doubt, then the indictment must be sustained, even conceding the absence of the evidence as alleged by the affidavits upon which the motion is founded.

By section 6 of the Act of September 18th, 1850, (9 *U. S. Stat. at Large*, 463,) it is provided, that when a person held to service, &c., shall escape, &c., the person to whom such service is due, &c., may pursue and reclaim such fugitive, either by procuring a warrant from some one of the Courts,

Judges or Commissioners, for the apprehension of such fugitive, &c., or by seizing and arresting such fugitive where the same can be done without process, and by taking or causing him to be taken forthwith before such Court, Judge or Commissioner, whose duty it shall be to hear and determine the case of such claimant, &c. If the facts, as presented before the Commissioner, brought the case within his jurisdiction, and authorized the issuing of the warrant for the arrest, then the ministerial officer had full authority to make the arrest, and was bound to make it; and any person who knowingly rescued or attempted to rescue the fugitive from the custody of such officer, or aided, abetted or assisted in such rescue, was guilty of the offence charged in the indictment. The person thus arrested under the warrant is in the custody of the law, and any one engaged in the attempt to take him forcibly out of such custody, subjects himself to its penalties. When the warrant is issued by the authority of the law, it is made the duty of the marshal and deputy marshal, under heavy penalties, (section 5,) to obey and execute it; and it would be absurd to hold, that such officer could not be protected in the execution of the process, when the proof before the magistrate was sufficient, under the statute, to confer jurisdiction to issue it. In this, as in every other case of legal proceedings of an analogous description, it is sufficient to justify the arrest of the person, and his detention in custody until he is discharged by due course of law, that the warrant was issued by competent authority. The officer must be protected in its due execution, if the law of the land is to prevail; and any person concerned in the endeavor to obstruct it, or to take the person arrested forcibly out of his hands, becomes a public offender, and liable to the punishment the law annexes to the offence.

The question, whether the person is a fugitive from service or not, or whether such service is due to the claimant or not, is a question the authority to determine which, at the final hearing, is conferred by law upon the magistrate issuing

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the warrant—not upon the marshal, the ministerial officer, whose duty it is made to execute it. If these facts are sufficiently established before the magistrate to authorize the process, the marshal is authorized to arrest and detain the person until the hearing has taken place according to the provisions of the statute, and until the truth or falsity of the facts is established by the evidence. The question is one exclusively for the magistrate to determine, and, until that determination, the person arrested is in the custody of the law.

These principles are too common and familiar to require illustration or authority; and, in our judgment, upon any sound construction of the provisions of the Act of Congress on this subject, must govern the case. We have examined these provisions with some care, and the above are the deliberate conclusions at which we have arrived.

There is a remaining question in the case, which it is proper to notice—namely, the charge impeaching the conduct of Mr. Gates, the deputy marshal, whose duty it was made to draw the grand jury from the box of jurors for the county of Erie, and also to summon them for the term of the District Court held at Buffalo, when this indictment was found. This charge is founded upon the affidavit, on information and belief, of one of the parties indicted. We have the affidavit of the deputy marshal, of the clerk of the county, and of a third person, who were present at the drawing and witnessed it, and they show that the charge is utterly unfounded, and most unjust as it respects this officer. The drawing took place in the usual way, and in strict conformity to the law. There is not the slightest ground for the imputation against the fairness and good faith of the deputy in the discharge of his duty, either in the drawing or the summoning of the jury, and it never should have been made.

For the reasons above given, the motion to quash the indictment must be denied.

THE UNITED STATES vs. GEORGE COTTINGHAM.

Peremptory challenges to jurors are not allowed in the Courts of the United States in any other than capital cases, even though they are allowed in other cases by the State law.

A decoy-letter, containing money, mailed for the purpose of entrapping a clerk in a Post-Office, who opens it and takes the money, is within the 21st section of the Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 107.)

(Before NELSON, J., Northern District of New York, October 20th, 1852.)

THIS was an indictment against a clerk in the Post-Office at Albany, New York, under the 21st section of the Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 107,) for opening a letter and stealing money therefrom. The punishment fixed by law for the offence was imprisonment for not less than ten nor more than twenty-one years.

On the trial, the counsel for the prisoner claimed the right to challenge peremptorily twenty of the jurors, under the provisions of the 2d section of the State statute, (2 *R. S.* 734, § 9,) which is as follows: "Every person arraigned and put on trial for any offence punishable with death, or with imprisonment in a State prison ten years or any longer time, shall be entitled to challenge peremptorily twenty of the persons drawn as jurors for such trial, and no more."

The letter containing money, which it was proved the prisoner had opened, and from which he had taken the money, was a decoy-letter, prepared and mailed by an officer of the Government for the purpose of entrapping the prisoner. The counsel for the prisoner raised the objection that such a letter was not within the Act.

James R. Lawrence, (*District Attorney*), for the United States.

Deodatus Wright, for the prisoner.

THE COURT decided that the prisoner had no right to

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any of the peremptory challenges claimed, because such challenges were not allowed at common law in any other than capital cases.*

It also charged the jury that the purpose for which the letter from which the money was taken was mailed, was not a question under the Act.

SAMUEL COLT vs. HIRAM YOUNG AND EDWARD LEAVITT.

Where an application for the extension of a patent under § 18 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 124,) was pending at the time of the passage of the Act of May 27th, 1848, (9 *Id.* 231,) which conferred upon the Commissioner of Patents alone the same authority to extend patents which had previously been confided to the Board created by the Act of 1836: *Held*, that it was not necessary to renew the application, but that the Commissioner was authorized to go on with the proceedings, as having been properly instituted, and complete them by granting the extension.

Where the Commissioner of Patents has jurisdiction over an application for the extension of a patent, his decision is conclusive as to the regularity of the proceedings on the extension.

The only exception to the conclusiveness of his decision is, perhaps, the case of fraud.

The defendant was enjoined, before final hearing, from infringing two of the claims of a patent, although it was not held that another claim in the same patent, the novelty of which was disputed, was valid.

(Before NELSON and BETTS, JJ., Southern District of New York, November 8th, 1852.)

THIS was a motion for a provisional injunction, to restrain the defendants from infringing the first, second and third claims of Letters Patent granted to the plaintiff, February 25th, 1836, for an "improvement in fire-arms," as re-issued to him, on an amended specification, October 24th, 1848, and extended by the Commissioner of Patents on the 10th of March, 1849, for seven years from the 25th of February,

* See note to *The United States v. Reed*, (*ante*, p. 447.)

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1850. There were five claims in the amended specification. The bill set out a recovery by the plaintiff in a suit at law on the patent, in the Circuit Court for the Massachusetts District, which was strongly defended, and in which the jury found specially the novelty of the plaintiff's patented combination, and the infringement of the first three claims of his patent.

In opposition to the motion, the defendants set up want of novelty in the plaintiff's patent, illegality in its extension, and non-infringement. The affidavits were principally directed to the point of showing a want of novelty in the first claim.

Edward N. Dickerson and Charles M. Keller, for the plaintiff.

Seth P. Staples, Francis B. Cutting and Robert Emmet, for the defendants.

NELSON, J., (after holding that the evidence produced on the part of the defendants in no manner affected the plaintiff's second and third claims, and that the defendants had infringed those claims.) The next question in the case is as to the validity of the extension made by the Commissioner on the 10th of March, 1849. By the 18th section of the Patent Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 124,) the power to hear and determine applications for the extension of patents was conferred upon a Board composed of the Secretary of State, the Commissioner of Patents and the Solicitor of the Treasury. That Act required public notice to be given of the application a certain number of days previous to the hearing. By the Act of Congress of May 27th, 1848, (9 *U. S. Stat. at Large*, 231,) it is enacted, that "the power to extend patents now vested in the Board composed of the Secretary of State, Commissioner of Patents and Solicitor of the Treasury," "shall hereafter be vested solely in the Commissioner of Patents;" and it is further provided,

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that the said Commissioner shall exercise the powers "upon the same principles and rules that have governed said Board."

The application for an extension of the patent before us was pending when the Act of 1848 was passed, and the Commissioner, after its passage, went on with the proceedings, as having been already properly instituted, and completed them by granting an extension. The argument against its validity is, that the proceedings fell with the modification of the Board by the Act of 1848; and, therefore, that it was necessary to begin them anew, observing the preliminary steps necessary in such cases. The obvious answer is, that this was not a repeal of the section providing for the extension of patents, and the enactment of a new system for the purpose; in which case, the principle of construction contended for would have been applicable, (*United States v. Boisdore's Heirs*, 8 How. 113,) but simply a repeal of so much of it as related to the action of the Secretary of State and the Solicitor of the Treasury in the matter, leaving the Commissioner alone to go on in the execution of the duty. This is the legal as well as the common-sense understanding of the change produced by the Act of 1848. The amendment seems guardedly worded, for the purpose of avoiding the great inconvenience, if not injustice, that might result to applicants, if the construction contended for by the defendants should prevail, namely, the necessity of renewing the applications, with sixty days' public notice. It, therefore, simply devolves upon the Commissioner, after its passage, the whole of the duty which was previously divided with the Secretary and the Solicitor, and directs that he shall be governed by the same principles and rules that had governed the Board composed of the three. This, as we understand, was the construction given to the Act by the Commissioner, and is the one upon which he has acted, and we think it is right and should be upheld.

The jurisdiction of the Commissioner over the application being established, his decision must be regarded as conclusive as to any informalities or irregularities that may have

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happened in the course of the execution of the duty, and cannot be the subject of examination and review on this motion, the same as if the case was before us on writ of error or appeal. The Act intended to make the decision of the Commissioner conclusive, except, perhaps, in the case of fraud, which is an exception to the general rule.

We are satisfied, therefore, that the plaintiff is clearly entitled to an injunction against the defendants, enjoining them from using, in the manufacture of fire-arms, the arrangements embraced in the second and third claims of his patent. Under the circumstances of the case, and in view of the affidavits produced in opposition to the motion, we shall refrain from passing upon the question raised in regard to the first claim, until the case shall come up for hearing upon the pleadings and proofs, when we shall be more fully in possession of the facts bearing upon that question.

BENJAMIN TATHAM, JR., AND GEORGE N. TATHAM

vs.

THOMAS O. LE ROY AND DAVID SMITH.

The history of improvements in machinery for making lead pipe by pressure, given.

The rules of law for determining the question of identity between two machines, stated.

Effect of a mere change in form or proportions, or of the mere substitution of one mechanical equivalent for another.

Tests for determining what is a substantial change in a machine.

Where the plaintiff was the first to apply a hollow ram sliding upon a core in a cylinder to the making of lead pipe by pressure, (a cylinder sliding upon a rod not being new in machinery,) and, in his patent, claimed as his invention the constructing of the ram hollow, so as to slide upon the core, and the combination of the same with the core: *Held*, that the mere use of a hollow ram in combination with a core, in a machine for making lead pipe by pressure, would not be an infringement of the patent, but that there must be a use of such combination, in such a machine, in substantially the same way in which the plaintiff had applied it.

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Where the change from a patented machine produces an effect, in the operation of the machine, different in kind, such difference in effect is evidence of a substantial change, although, without connecting the new effect with the change, the change might be only formal and unsubstantial.

But such new effect, in order to give materiality to an apparently formal change, must not consist in merely doing more work in a given time or in merely requiring less power. These results, if found, must follow from the different effect in kind.

The rule of damages for the infringement of a patent, stated.

Interest, by way of damages, may be given by the jury, in an action for the infringement of a patent.

(Before NELSON, J., Southern District of New York, November, 1852.)

THIS was an action on the case, tried before NELSON, J., for the infringement of Letters Patent granted to the plaintiffs October 11th, 1841, for an "improvement in the machinery for making pipes or tubes of lead, tin and other metallic substances." * The defendants had used, in the manufacture

* The specification of the plaintiffs' patent was as follows :

"*The Schedule referred to in these Letters Patent, and making part of the same.* Be it known that we, George N. Tatham and Benjamin Tatham, junr., both of the city of Philadelphia, and State of Pennsylvania, have invented certain new and useful improvements in machinery or apparatus for making and manufacturing pipes and tubes of lead, tin and other metallic substances, and their alloys. And we do hereby declare that the following is a full, clear and exact description of the construction and operation of the same, reference being had to the accompanying drawings, making part of this specification :

"Our invention of these certain improvements applies principally to the 'machinery or apparatus for making or manufacturing pipes and tubes from lead, or a mixture or compound of lead with other metals, as tin, or zinc, or any other compound or alloy of soft metals capable of being squeezed or forced, by means of great pressure, from out of a cylinder or receiver, through or between apertures, dies and cores, *when in a solid state,*' described and set forth in the specification of a patent granted to THOMAS BURR, of Great Britain, and also described in the first volume of the first series of the London Journal of Arts and Sciences, as therein will appear ; and our said invention is applicable in part also to other machinery for manufacturing leaden and other metallic pipes, which will be hereinafter referred to.

"In the plan described by Thomas Burr, the core (for the formation of the inner diameter or calibre of the pipe) is attached to the end of the piston, and, advancing before it through the cylinder, became bent and twisted out of centre with the dies, thus preventing or destroying the uniformity of thickness or the centrality of the bore of the pipes. This defect resulted from the difference of expansion and contraction, and from the extreme pressure required to drive out the solid metal, and from several other causes, the effect of which was to render that plan ineffective and ineligible. These defects it is the object of our improvements to remedy.

"Our said improvements may be fully understood by referring to the accom-

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of lead pipe machinery constructed in accordance with the specification of Letters Patent granted to Samuel G. Cornell,

panying drawings, and to the explanations thereof contained in this specification.

"We use a powerful hydraulic press, which is partially represented at figure 1. In this figure *a a*, is the cap or top of the press; *b b*, the base or frame of the bottom thereof, inclosing the great cylinder and the ram, which are not here exhibited. *C C C C*, are the upright wrought-iron pillars of the press. The pipes, the safety-valve and other parts of the hydraulic press are not here represented. This engine is so well known, and may be constructed in such variety of forms, as to render a description of it unnecessary, and the figure in the annexed drawings is intended only to exhibit the relative arrangements of the other parts of the apparatus. We use a strong iron cylinder, constructed in a manner substantially resembling that described by Thomas Burr, and intended for precisely the same purposes. The die is secured at the upper end of the cylinder between a circular plate and the top of the cylinder, in an aperture or recess fitted to receive it. The top of the cylinder is attached by means of screws or bolts, or otherwise, thereto, so as to be easily removed and replaced. The cylinder, with its several appurtenances, is to be firmly bolted or secured to the top of the hydraulic press. It is represented in perspective at *A*, in figure 1, and in section at *A A*, in figure 2. *k k*, figure 2, is a section of the die, which is a polished steel ring. *m m*, is the circular plate with a large aperture through it for the passage of the metal towards the die. *n n*, is the top of the cylinder. *X X*, figure 2, is a section of a part of the top of the hydraulic press, which part has an aperture (*i i*) in the form of an inverted cone, to allow access to the cylinder, for the purpose of charging it through the dies or other apertures, and for the passage of the pipes or tubes. The aperture is hidden at figure 1. THE PISTON, *B*, (operating within the cylinder,) is bored accurately throughout its length, so as to receive and fit a long core-holder, upon which it is to move or slide easily up and down, being at the same time furnished with proper packing. The HOLLOW PISTON is exhibited in its place, in perspective, at *B*, figure 1; and in section, at *B B*, figure 2. Its parts are shown detached at *a* and *b*, in figure 5, and a section of the face at *C*. Its packing (around the long core-holder) consists of tight rings occupying the places indicated at figure 2 by the letters *z z*; but it may be packed in other ways in common use, and well known to machinists. The face *C* should be made of cast steel. It is secured to the body of the piston by means of bolts or screws. The piston is secured in its place, upon the table or platform of the hydraulic press, in any convenient manner. We employ a cast-iron fixture, open in front to receive the piston-head, grasping the same, and, being firmly bolted to the table, is strong enough to bear the high degree of force often required to extract the piston from the cylinder, after it has been driven home. This instrument is represented in its place upon the table at *C*, in figure 1, and in plan at figure 3, *y*, and in transverse section at *z*. We employ a LONG CORE-HOLDER, which is a strong round rod of iron or steel, accurately turned and polished, so as to move or slide easily and truly through the hollow piston, fitting the same exactly. One end of this long core-holder is to be securely attached (by a pin or otherwise) to strong iron framework, below the table or platform of the press. The core-holder is to be sufficiently long to pass upwards through the table or platform, through the piston, and through the middle of the cylinder, to its discharging end, where it is to hold (in the centre of the die) a core or mandrel, attached, screwed or bolted into its end; or is itself to be tapered, if necessary, to the size required for the interior diameter or calibre of

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August 21st, 1847, for an "improvement in lead pipe machinery." The material defence was non-infringement. The

the pipes or tubes. The *long core-holder* is exhibited in its place at D, figure 1, and in section at D, figure 2, and detached at D, figure 4, where several different plans for its construction next the core are exhibited. The iron framework securing the end of the *long core-holder* is to be made with several arms, each to be firmly attached to one of the wrought-iron pillars of the hydraulic press. This frame is represented in perspective, in its place, at E E, in figure 1, and in plan, at figure 6, where the relative positions of the pillars that support the table or platform of the press are exhibited at *e, h, g*. The lower part of the framework must be placed at such a distance above the hydraulic ram-head as not to interfere with the rising of the same, when the press is in action. This distance should be of the length of the piston at the least. The TABLE or platform of the press is to be supported by strong iron pillars, two, three or four in number, standing between the arms of the framework fixture last described. The table is seen at F F, figure 1. It is to slide upon the wrought-iron pillars of the press, which thus serve as guides to it. The PILLARS supporting the table are represented at G G G, in figure 1. They are to stand upon the ram-head, which is a solid iron fixture upon the top of the ram itself, and is seen at H, in figure 1. The ram-head is to contain an aperture large enough to permit the end of the *long core-holder* to descend into the hollow of the ram, when occasion may require the removal of the piston, or a change in any of the different instruments.

"The operation of the machinery is, in most respects, the same as that described by Thomas Burr, to whose specification we here particularly refer. The several parts being adjusted in their places, as at figure 1, the piston being lowered, the cylinder is filled with melted metal, through the aperture between the die and the core; or, if preferred, through an aperture made for the purpose in the cylinder, which is to be stopped with a screw-plug or otherwise. The space occupied by the metal in the cylinder is represented in the sectional drawings by a tint of red color. Upon the metal in the cylinder becoming 'set' or solid, the press is to be set in action, and, as the ram of the press rises upwards, carrying with it the pillars, and the table or platform upon them, the piston (sliding upon the stationary *long core-holder*) is driven into the cylinder, and the metal therein is forced upwards between the core and the die, and issues above the top of the press in the shape of a pipe or tube. Lead perfectly cold, and even harder metal, may be driven by this machinery, and formed into pipes or tubes.

"We do not intend to limit or confine ourselves to the precise plan here above described of forcing the piston upwards into the cylinder, and of causing the pipe to issue above the press, since the same results will be produced when the action of the machinery is reversed, by securing the piston to the under part of the top of the hydraulic press, and bolting the cylinder upon the table or platform; thereby causing the cylinder to advance upon the stationary piston, and forcing the pipe downwards through an aperture in the table made to admit its passage. In this reversed mode of operation, it would be necessary to construct upright shafts or pillars, standing upon and secured to the table, and made to slide through boxes fitted in the top of the press. These uprights are to be connected above the top of the press, by a strong cross-beam, to the centre of which the end of the *long core-holder* is to be attached. The core-holder should slide through a box in the top of the press, and also through the stationary HOLLOW PISTON, and, reaching to the bottom of the cylinder, it must there hold a core or mandrel in the centre of the die, as before described. When the press is set in motion, the core-holder will rise with the upright framework and

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following extracts from the specification of Cornell's patent are sufficient to show the construction and operation of the machinery used by the defendants :

" My machine is applicable to the manufacture of pipes and tubes of lead, and such other metals and their alloys as are capable of being squeezed or forced, by means of great pressure, from a cylinder or receiver, through or between apertures, dies, cores or mandrels, when in a solid or semi-fluid state, and is mainly referable, in its general construction and purposes, to the machine patented by Thomas Burr in Great Britain, and described in the first volume of the first series of the London Journal of Arts and Sciences. * * *

" In my machine, I use the hydraulic press, the lead cylinder or receiver, the columns or pillars connecting the hydraulic press with the lead cylinder, the movable ram for pressing the piston upon the lead in the cylinder or receiver, the dies and cores to give the pipes the required form and calibre and dimensions, and such other parts of the old machines as may be necessary, substantially similar to the machine of the said Thomas Burr, now in common use. * * *

" In the machines heretofore used the die is placed in the lead cylinder—at

the cylinder, fixedly preserving its relative position with the die at the bottom of the cylinder.

" Figure 7 is a representation (partly in section) of this reversed mode of operation. A, is the cylinder reversed, having the die now at the bottom. B, is the hollow piston, secured to the top of the press. CC, are the upright pillars of the framework. DD, is the cross-beam thereof. E, is the long core-holder depending from the cross-beam. In this latter form or manner of arrangement we intend to apply the foregoing improvements to the apparatus for manufacturing pipes or tubes from lead or other metallic substances, invented by Charles and John Hanson, of Great Britain, for which Letters Patent of the United States were granted to the present inventor, Benjamin Tatham, junr., and to Henry B. Tatham, of the city of Philadelphia, under assignment from the said Charles and John Hanson, before patent issued, and recorded preparatory thereto, which Letters Patent are dated the twenty-ninth day of March, eighteen hundred and forty-one.

" We do not claim as our invention any part of the cylinder, nor of the dies, nor of the arrangement thereof in the cylinder, nor the manner of adapting these to the hydraulic press, nor the mode of operation generally, all of which have been substantially described in the specifications of the patents of Thomas Burr, and of Benjamin and Henry B. Tatham, assignees of Charles and John Hanson, heretofore referred to. But what we do claim as constituting our invention, and desire to secure by Letters Patent, are,

" FIRST. The long core, or core-holder, formed and held stationary with relation to the dies as described.

" SECONDLY. We claim the constructing of the piston B, *hollow*, in the manner described; and the combination of the same with the long core, or core-holder, upon which the piston slides.

" THIRDLY. We claim, as a modification of our invention, the arrangement and combination of the several parts above mentioned as exhibited in what has been termed 'THE REVERSED ARRANGEMENT,' shown at figure 7, in the accompanying drawings."

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the top thereof when the power is applied at the bottom, and at the bottom thereof when the power is applied at the top—and the core which forms the inner surface of the pipe and determines its calibre, is either attached to the piston, advancing before it through the lead, according to the method of Thomas Burr, or attached to a long stationary core-holder passing through the platform of the press, through the piston or ram, and through the centre of the lead cylinder to its discharging end, and the core being attached to the upper end thereof, and passing through the centre of the die, adjusted and secured so as to remain stationary in its proper position; and the pipe is formed by pressing the whole mass of the lead upwards by means of the piston, forcing it through the aperture between the die and the core. This long core-holder is secured to the platform of the press and lead receiver, so as to remain stationary the one to the other, and the piston slides over it. This is the method of George N. and Benjamin Tatham, as described in their patent granted October 11th, 1841.

"In these methods, the core and core-holder, or other apparatus used for like purposes, are liable to be broken, or twisted, or bent, or otherwise displaced by the upward or the lateral pressure caused by the piston pressing against the metal, which may be of unequal density, or from any other cause, so that the pipes will be imperfect, and often useless, and the machinery often injured or broken.

"To obviate these difficulties, a bridge, cross-bar or guide-piece has been placed in the upper part of the lead cylinder, near the die, closely fitting the core-holder which passes through it, and firmly secured to the interior of the cylinder by means of arms extending from the bridge to the inner surface of the cylinder, and there secured. This apparatus is to support the short or stationary core, or to guide the long core, and prevent its being displaced, or the core from being broken or bent. But it will be seen that in this method the mass of the lead in the cylinder, on being pressed upwards through the same, is divided by the arms into as many parts as there are arms, and, after passing the arms, is united and pressed together so as to adhere in its passage through the die. It is obvious, however, that the adhesion of these divisions will be more or less imperfect, and that the pipe formed in this way will be liable to burst under any considerable pressure. In all these methods, the great pressure required to lift the whole mass of the lead contained in the cylinder and force it through the die will, besides displacing or breaking the cores or the mandrels, often burst the lead cylinder and destroy the machine.

"The object attained by my improvement is, the forming of pipe in all cases at the point of contact of the piston and the lead, where the pressure is applied, without moving forward the whole mass of lead in the cylinder. This is the leading feature of my invention, and the various apparatus and the different arrangements and combinations thereof, hereinafter described, are all subsidiary to the accomplishment of this object, being the different methods by which it is accomplished.

"In my machine, instead of fixing the die in the upper or lower end of the lead cylinder, and there forming the pipe, in the manner above mentioned, I

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usually place and secure the die in the end of the piston which is to enter the lead cylinder and press against the lead. * * * * Around the die proper packing is placed, to make it fit the lower orifice of the lead cylinder into which it is to pass. The piston is hollow, with an opening or openings * * * near the bottom, to permit the passage of the formed pipe downward through it, and thence out at one of the openings. In a right line with the centre of the piston, I place a long movable core-holder, extending from the top of the piston upward * * * through the middle of the lead cylinder, and beyond to the top of the frame. * * * This core-holder is of sufficient size and strength to sustain any pressure required, without being broken or bent, or otherwise displaced, and is connected with the ram by means of * * * cross-heads, * * * one of which is secured to the piston, and the other to the movable core-holder by * * keys, * * * and the cross-heads are connected together and kept in their proper relative position by * * connecting rods, * * * which are secured to the cross-heads by * * nuts, * * * the die-holder or piston and the core-holder being thus relatively stationary the one to the other. The upper cross-head moves in, and is guided by a strong cast-iron frame * * secured to the lead cylinder by bolts, or otherwise. The frame extends above the lead cylinder to which it is secured. * * * In the top of the frame is placed an iron collar or bush, * * through which the movable core-holder passes, and is adjusted and kept in its place by means of * * set screws. * * * The upper cross-head, in the working of the machine, slides up and down in the frame, by means of which arrangement the movable core-holder is always kept in its proper position, that is, in right line with the centre of the piston. To the lower end of the movable core-holder I attach and properly secure the short core which is to form the interior surface of the pipe and determine its calibre, * * * which is not required to be more than an inch or an inch and a half long in the working machine. The nuts * * at the lower ends of the connecting rods * * may be turned off to permit the cross-heads to be moved further apart, thus separating the piston from the core-holder, to allow the die and core to be replaced or changed at pleasure. This being done, the core at the end of the core-holder may be inserted in the centre of the die * * and properly adjusted. The nuts are then screwed on, bringing the operating parts of the machine into their proper relative position, and there firmly securing them.

"The machine is thus made ready for operation. The piston, by means of the hydraulic ram, being moved up to the lower orifice of the lead cylinder, * * * the machine is charged with the metal in the ordinary way, and, when the metal is sufficiently set and cooled, the power is applied to the ram in the usual manner, causing it to press the piston upwards against the metal, which immediately flows downwards from the point where the pressure is applied, through the die and over the core, thus forming the pipe. The pipe, as it is formed, passes downward through the hollow piston, and out at the aperture, and is reeled in the ordinary way. When the metal in the cylinder is thus

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pressed out, the ram descends to the proper point, the cylinder is re-charged, and the process repeated in the usual manner.

"In my method, much less power is required than in the methods heretofore employed, as the pipe is formed at the head of the piston, by the pressure upon the lower portion of the metal, instead of being formed at the top of the cylinder, by forcing the whole mass of the lead upward through the die there placed. By reason of this greatly diminished pressure, and the peculiar construction and arrangement of the parts in my machine, neither the core nor core-holder is liable to be broken or bent, or otherwise injured or displaced; nor is the cylinder liable to burst by the lateral pressure. There being no division of the metal in the cylinder into parts by the bridge or guide before mentioned, as used in Hanson's plan, the pipe is much stronger and every way more perfect.

"Another great advantage of my method is the facility with which the dies and cores may be changed; it being only necessary for that purpose to drop the piston a little below the lead cylinder, and loosen the nuts at the lower ends of the connecting rods, thereby separating the die and the core, which are readily renewed, and different ones substituted, and the nuts again screwed up and the parts adjusted as before.

"By placing the die in the movable core-holder or mandrel, as it may in this case be called, and fixing the short core to the piston, and adjusting the parts as before, the pipe will be formed in the movable mandrel, which may be made hollow for that purpose, instead of being formed in the piston, and will in that case pass upwards through the hollow mandrel, and out at the top. * * * But the machinery employed and the principles upon which I form the pipe will be substantially the same in both methods, and the advantages over the old method equally important. * * * * *

"What I claim as my invention, and desire to secure by Letters Patent, is placing the die for forming the exterior surface of the pipe in the piston or the hollow mandrel, as the case may be, substantially as described, instead of placing it in the head of the lead cylinder, as has been heretofore done; so that, as the piston is forced into the cylinder, or the cylinder forced over the piston, the pipe will be formed at the point of pressure, without moving the mass of lead relatively to the cylinder; and, in combination therewith, I claim the cores for forming the interior surface of the pipe—the die and core being adjusted and held in their proper relative positions by any of the known methods."

In charging the jury, NELSON, J., said:

The first machine for making lead pipe by pressure was the Burr machine, which was constructed in 1820. In that machine, the core which formed the bore of the pipe was fastened into the face of the ram, and extended through the

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cylinder and into the die. Burr was the first person to whom it occurred that lead pipe could be made out of set or hard lead, by means of pressure. This machine was his contrivance to carry that idea into practical effect. It virtually failed, especially so in respect to the manufacture of pipe of the usual or ordinary size. It seems, from the testimony, to have been successful so far as respected the manufacture of pipe of two inches or two inches and a half in diameter, and above that size; but, for the ordinary size—under two inches—it was a failure, and it went out of use. What constituted the real difficulty in the way of the successful operation of the Burr machine, is a matter of controversy, as you have seen during the course of this trial.

In 1837, an improvement was made upon this machine of Burr by the Hansons, which went into successful operation. This machine was patented by them in England on the 21st of August, 1837. The improvement consisted in making a bridge at the bottom or near the bottom of the cylinder, for the purpose of holding a short core, and was founded upon the development of a new and beautiful idea. They had discovered, for the first time, that lead, like steel or iron, was susceptible of being welded together after separation when solid; and they were thus enabled to construct a bridge at the bottom or near the bottom of the cylinder, in which they could insert a short core, where it could be kept firm and steady. The lead had to be forced through the apertures in this bridge, which separated the mass when in a solid state; but it became re-united and welded together by means of pressure in the chamber beneath the bridge, and in the formation of the pipe as it was forced out of the die. The improvement was successful, and enabled the Hansons to make good merchantable pipe, and to make it cheaper and better than by any previous mode of manufacturing it, so that it superseded all prior methods of making lead pipe. The correctness of this idea, that lead could be separated when hard, and re-united by pressure, like the re-union of welded iron or steel, has been fully established on a trial in

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this Court, in which the Hanson machine was involved. The truth of this idea was denied by the most eminent chemists in New York upon that trial, and, as a consequence of their disbelief of the fact that this property belonged to the metal, they testified that the pipe was made, in the Hanson machine, while in a fluid state, because the welding of the lead in a set state was a physical impossibility. They stated that they had never known this property as belonging to lead. But the fact was proved, by actual experiment on the trial, to their entire satisfaction, and they afterwards came into Court and admitted they were mistaken.

Now, although this machine thus constructed manufactured merchantable pipe, and superseded all modes of manufacture known at that time, yet it was subject to an imperfection which embarrassed the manufacturer. The re-union of the lead, after its separation in passing through the bridge, was not at all times complete throughout the length of the pipe made from a given charge; and hence, when the pipe was subjected to a considerable pressure of water, a flaw would sometimes appear. This, I believe, was the only defect ever imputed to the article manufactured by the Hanson machine.

The next improvement upon the Burr machine was the plaintiffs', in 1841—the one in question in this suit. They bored the solid ram of Burr, and, instead of fastening the core on the face of the ram, extended it through the ram, and fixed it firmly to the cross-head of the frame—the core extending, also, through the cylinder into the die. The bore of the ram is fitted to the core or core-holder, either by adapting the aperture to it, or by packing, so that, when the machine is put in operation, the ram slides upon the core. The core, in the first place, is fastened to the cross-head, which is firm and immovable, differing in this respect from the Burr machine, in which the core was movable with the ram, being fastened upon its face. The core in the plaintiffs' machine is also steadied by the aperture in the hollow ram, or by packing. The advantage in this over the arrangement

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of Burr, is in steadying the core or core-holder, and in preserving its centrality in reference to the die. This machine appears to have been entirely successful in the manufacture of lead pipe of any dimension.

I will now call your attention to what is claimed as new in the plaintiffs' patent. After the description of the construction of the machine, which is minutely given, the patentees wind up by claiming, first, "the long core or core-holder, formed and held stationary with relation to the dies, as described;" and, secondly, "the constructing of the piston B hollow, in the manner described, and the combination of the same with the long core or core-holder upon which the piston slides." The third claim relates to the reversed arrangement of the machinery in the working machine, which it is not important to describe.

The first and third claims are not in controversy, and may be left out of the case. The dispute between the parties is confined to the second claim. It is insisted by the plaintiffs that the peculiar arrangement covered by that claim gets rid of the defect in the Burr machine, of the unsteadiness of the core in the manufacturing of pipe of the ordinary size, and also gets rid of the defect in the Hanson machine, because it dispenses with the bridge; and that this arrangement has been infringed by the defendants. The arrangement enables the plaintiffs to use a strong core or core-holder, and to fix it firmly at the cross-head, and, by the aperture in the ram and the packing, to preserve its centrality in relation to the die; by reason of which they have succeeded in making perfect pipe. This is, in substance, the new arrangement of the plaintiffs, and these are the advantages which they claim to have derived from the change, and from the improvement upon the previous machines.

Let me now call your attention to the construction of the defendants' machine. This, also, is claimed to be an improvement on the Burr machine. It was constructed some five or six years after the plaintiffs' improvement. It is arranged by boring the solid ram of Burr, and placing the die

in the face of it, at the same time closing the bottom of Burr's cylinder, and fixing the core firmly at the bottom, where Burr's die was placed. The core extends through the cylinder and into the die thus fixed in the face of the ram. In the operation of the machine, the core passes through the die and into the hollow ram nearly the length of it, the pipe, of course, passing through the same aperture above.

It will be necessary for you to examine the arrangement and construction of these two machines, in the particulars that I have mentioned, with great care and attention, because the determination of the case will hinge mainly, if not exclusively, upon the judgment you shall form in respect to them and their operation. In other words, the case depends upon the opinion you shall form of the substantial identity or want of identity between the two, as it respects the arrangement of the hollow piston and the core or core-holder found in them, and the operation and effect of the same in the manufacture of pipe. If, in looking at the arrangement and combination of the two, you arrive at the conclusion that they are substantially the same, then the use of the defendants' is an infringement of the plaintiffs'. If, on the contrary, you arrive at the conclusion that they are not substantially the same, then the defendants will be entitled to your verdict.

These questions of identity between two opposing machines are frequently exceedingly difficult, and often the most difficult questions involved in these patent cases. The question is ultimately one of fact, and the jury must examine it with a consciousness that they are to be responsible for its determination.

There are some principles of law bearing upon these questions which may shed some light upon your examination of them, and which it is proper should be stated. A change in form from the construction of an existing machine, is not a substantial change in the eye of the patent law; nor is a change in proportions. These changes require no great in-

genuity ; at all events, they do not call for the exercise of the inventive faculties. They are simply the work of a mechanic of ordinary skill, and, therefore, are entitled to no particular consideration when we are inquiring into the question of identity between the construction of two machines. So, also, the substitution of a mechanical equivalent, as it is termed, in the construction of a machine, is not a substantial change. There are many devices in construction that can be made by a skilful mechanic, differing very much from each other in appearance, but which, in the eye of the patent law, are regarded as identical. For instance, an inventor, in the construction of his machine, desires a given power, in order to give practical operation and effect to his discovery. One mechanic may furnish the power by means of a lever, another by means of a screw—two very different instruments—yet, so far as the use of the instruments and so far as their purpose to furnish the power is concerned, they are regarded simply as mechanical equivalents, and the use of one in one machine does not distinguish that machine from a machine in which the other is found. So, too, a given power may be obtained by a spring or by a weight, or by a pulley—apparently very different devices. Yet, as they are used for the same purpose, and to accomplish the same end in machinery, they are regarded as substantially identical. It is also proper to state, in this connection, that a patentee is not confined to the precise arrangement, in the construction of his machine, which he has described in his patent. This is obvious from the principles already stated. Formal changes are nothing—mere mechanical changes are nothing—all these may be made outside of the description to be found in the patent ; and yet the machine, after it has been thus changed in its construction, is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation. A familiar illustration of the principle that I am endeavoring to develop, and one bearing directly

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upon the issue between the parties here, will be found in the instance of the large core-holder or core described in the plaintiffs' patent. It is said, that the description in the patent is confined to a large core or core-holder. But, admitting this to be so, the change to a small one, if a small one can be used successfully, is but a change in proportions, as the larger includes the smaller one. Any person that could make a large one could make a small one, and could pack it to fit the aperture in the ram just as well as the large one, without anything more than the application of a little common sense, and ordinary skill in the working of the machine.

In addition to these instances which I have given you, in which the patentee is not tied down to the precise description given in his patent, there is another suggestion I wish to make, in connection with this branch of the case, and it is one that commends itself to the common sense of the jury. Any machine which has been constructed as an improvement upon a previous one, or as an entirely new manufacture, may be very considerably changed in its mechanical arrangement and construction, the description of it may be very much departed from in the construction, and yet it may accomplish the object and purpose for which it was designed. It may not be as perfect, in producing the result intended, but still it may, though changed and varied very much, do its work satisfactorily. It is proper also to remark, that any change or alteration which is suggested to the skilful operator from the working of the machine, and in the course of its operation—any useful change that may be the result of the practical working of the machine—is clearly a change that belongs, not to the operator, but to the original inventor of the improvement. Upon this branch of the case, and in this line of observation, I wish to guard you from falling into any error, because I am desirous that you shall comprehend accurately and clearly the principles of law that properly enter into the examination and decision of this difficult and somewhat metaphysical question. I, therefore, wish to prevent your being misled into extending these principles beyond the fair limit

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and scope that belong to them. What I mean to say, is this—that, in order to ascertain and determine whether the change in the arrangement and construction of an existing machine is to be considered as a substantial change or not, you must ascertain and determine whether the change is the result of mechanical skill, worked out by mechanical devices—of a knowledge that belongs to that department of labor—or whether the change is the result of mind, of genius, of invention, in which you discover something more than mere mechanical skill and ingenuity. A change in the arrangement and construction is not substantial, unless you find embodied in it, over and beyond the skill of the mechanic, that inventive element of the mind which is to be found in every machine or improvement that is the proper subject of a patent. If you find that, then the change is a substantial one, that entitles the party to a patent. Then it is a change that has added something to the useful knowledge of mankind and to the business interests of the country.

It will be seen, from these observations, that a difference in the mechanical arrangement and construction of the two machines is not necessarily a test by which to determine that the two are not identical. They may be, apparently, very different externally, and still embrace the same substantial identity in principle or mode of operation. So, on the other hand, the converse of the proposition is equally true. The two may, apparently, be very similar externally, and still, in principle and mode of operation, be very different. I do not know any better mode of examining a question of this kind, than to inquire whether the mechanical arrangement and construction of the two embrace the same set of ideas, the same leading features or ideas, which, in practical operation, produce the useful result. In other words, whether the arrangement and combination of the parts of machinery found in each are substantially the same, and operate in substantially the same way in producing the result. Hence, the real question in this case, as it respects the identity of the two machines, looks simply to their mechanical arrangement and

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construction, as to whether or not the defendants' incorporates, in its structure and operation, the spirit and substance of the plaintiffs' improvement—that is, uses the arrangement and mechanism of the plaintiffs' to perform the same functions or produce the same effect in the same way, or substantially the same way.

I will read to you two passages upon this branch of the case, which embody very fully and clearly the views that I desire to impress upon you, and which, being in the words of another, (Chief Justice Tindal, of the Common Pleas,) may, perhaps, take hold of your minds more strongly, from the variety of the illustration, than anything that I have said or could say. In *Walton v. Potter*, (*Webster's Patent Cases*, 590, *Curtis on Patents*, § 255, note 1,) Chief Justice Tindal remarked: "Now, there can be no doubt whatever, that although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place; and, if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbor's book, for he must be contented to rest upon his own skill and labor for the discovery, and he must not avail himself of that which had before been granted exclusively to another; and, therefore, the question again comes around to this—whether you are of opinion that the subject-matter of this second patent is perfectly distinct from the former, or whether it is virtually bottomed upon the former, varying only in circumstances which are not material to the principle and substance of the invention." I read another passage from the same case. (*Webster's Patent Cases*, 586, *Curtis on Patents*, § 202, note 1.) "Where a party has obtained a patent for a new invention, or a discovery he has made by

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his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances, the nature or subject-matter of that discovery, to obtain either a patent for it himself, or to use it without the leave of the patentee, because that would be, in effect and in substance, an invasion of the right; and, therefore, what you have to look at upon the present occasion, is not simply whether, in form or in circumstances, that may be more or less immaterial, that which has been done by the defendants varies from the specification of the plaintiff's patent, but to see whether, in reality, in substance and in effect, the defendants have availed themselves of the plaintiff's invention in order to make that fabric, or to make that article which they have sold in the way of their trade; whether, in order to make that, they have availed themselves of the invention of the plaintiff."

There is one other observation that I desire to make, and that is a practical one, which bears more directly upon the real point in issue between these parties than perhaps any of the general observations to which I have called your attention. You have seen that, after all, the case comes down to this naked question, as it respects this branch of it, and that is, whether or not the defendants' machine embraces, within its arrangement, the combination of the hollow ram and core or core-holder, patented to the plaintiffs. I am bound to say that I do not think the question is simply whether or not the defendants use the hollow ram in combination with the core; because I think that the combination of the hollow ram and the core or core-holder alone and in the abstract, is not the invention or improvement of the plaintiffs. Cylinders, sliding upon rods, had previously existed in mechanical constructions and in practical use, which is all that is found in the combination of the hollow ram and the core or core-holder upon which the hollow ram slides. That alone, and in the abstract, is not the invention of the plaintiffs, and, although the hollow ram and the core in combination may be found in the defendants' machine, that alone

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will not constitute an infringement. The question, in my judgment, is this. It has been conceded throughout, that the plaintiffs were the first persons who applied this peculiar combination to the purpose of making lead pipe by pressure. They were the first to conceive of the adaptation of this peculiar combination (which of itself was not new) to the purpose of producing this useful and practical result; and it is in this idea that the novelty of their improvement consists. The point in the case is, whether or not the defendants have applied this combination substantially in the same way for the same purpose. If they have, then they have appropriated the improvement which belongs exclusively to the plaintiffs, and the use of their machine is an infringement of the plaintiffs' patent. To this point you must turn your attention, and upon this, in my judgment, the question on this branch of the case must turn. Have the defendants applied this combination of the hollow ram and the core substantially in the same way that the plaintiffs have applied it, for the purpose of making lead pipe by pressure? If they have, they are guilty of infringing; if they have not, then they are not guilty.

The remarks which I have made to you thus far apply simply to the question of the identity of the mechanical arrangement and construction of the two opposing machines. There is another question involved in the case, which bears upon this, and to which it is necessary to call your attention. The defendants contend that, admitting there is an apparent substantial identity in the arrangement and construction of the two machines, and in their principle of operation, yet, in point of fact, the practical operation and effect of the two upon the mass of lead, in forming the pipe, are essentially different, and that such effect in the defendants' is highly beneficial in the operation of the machine. In other words, that because the defendants' forms the pipe at the point of pressure, at the face of the ram, the operation and effect of the power thus used upon the mass of lead are new. In this view of the case, and in respect to this branch of it, the law

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looks more to the result of the mechanical arrangement than to the arrangement itself. The new and different effect in the operation of the machine reflects back upon the mechanical arrangement and construction, and characterizes the change, and may authorize an inference of a substantial change, which the arrangement, disconnected from the new and different effect, would not. Without connecting the new effect with the change, the change might be only formal and unsubstantial. The case of the improvement in the mould-board of the cast-iron plough referred to by some of the learned counsel, illustrates this principle. It was there held, that a change in the shape of the mould-board, though apparently formal and one of proportion, and of itself amounting to nothing, became a substantial change by producing a new and different effect, in its operation, from that which was produced in the previous plough. It must be borne in mind, however, that the new effect, which is to give such materiality and importance to the apparently formal change, must not be looked for in the simple production of a larger quantity of pipe in a given time, or in the reduced amount of power required to operate the machine. All this may depend upon other considerations, as upon superior mechanical skill in the construction and arrangement of the machinery. But the new effect to which I am now calling your attention must be different in kind. The operation and effect upon the lead in the defendants' machine must be new and different from the operation and effect upon the lead in the plaintiffs'. And the capability of the defendants' machine to make a greater quantity of pipe in a given time, or to use a reduced amount of power, must be the result of the new and different operation and effect of the arrangement upon the mass of lead. This principle, which has been brought into the defence in this case, is, in the aspect in which it is presented, a very important one. I am desirous, therefore, that you should thoroughly comprehend it, and also the qualifications which belong to it, and which should be kept in mind in applying it.

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It is well known that new machines which have been devised for the purpose of carrying into practical effect an improvement or invention, oftentimes exhibit, when first constructed, and until tested by practical use, great imperfections in their results. It requires time and experience, and the observation derived from the practical working of the machine, to perfect it. Hence, the mere fact that a machine constructed and arranged, apparently or externally, like a previous one, produces a result more beneficial, is not always a safe test to determine that the two are substantially different. The result may be one derived from experience in the use of the previous machine. The new result, in the present case, must be a result derived from a different mechanical operation and effect upon the mass of lead in the cylinder, and not from the same operation and effect. This is a question of fact, and you will readily, from the time that has been consumed upon this branch of the case, call to mind the evidence bearing upon it—first, the examination of the experts on both sides, as regards the difference in the operation and effect of the two machines upon the mass of lead, in producing the pipe—also, the various experiments, many of them exhibited in your presence, others made elsewhere and detailed by the experts, tending, on the one side, to make out this new and different effect upon the mass of lead, in manufacturing pipe, and, on the other side, to discredit and disprove it. The question is thus raised, upon this evidence, for your determination. You must decide on which side the weight of the evidence lies. If it is in favor of the view taken by the defendants, that there is a new and different operation and effect upon the mass of lead in the cylinder, on account of the arrangement in the defendants' machine, then, I think, as a matter of law, that such new operation and effect give character to the mechanical arrangement and afford evidence of a substantial change. If, on the other hand, you think that the weight of the evidence is with the plaintiffs, and that there is no material or essential difference in the effect and operation of the two machines upon the mass, then you

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will be obliged to go back to the first question presented to you—whether or not there is, in the defendants' machine, a substantial change in the mechanical arrangement and construction, and in the operation of the same, from the combination, arrangement and operation of the plaintiffs' machine.

One word upon the question of damages. As there has been no serious question made on the subject, I shall simply call your attention to the principle that must govern. It seems that the defendants have made 711,551 pounds of pipe in their machine within the time for which the plaintiffs claim they have been guilty of infringing. The price of lead pipe, during that time, was six cents per pound, except for a small quantity, which was sold at five cents and three-quarters per pound. The price of pig lead was about four cents and a half per pound, during the same period. That would make a difference of one cent and a half per pound. But, out of this, the cost of manufacturing the pipe must be taken. What that is, is open to a good deal of observation. One witness states that the plaintiffs could have made it, in very large quantities, for one-eighth of a cent per pound. The rule in these cases is to give the actual damage or loss incurred by reason of the infringement, and that is the profits which the plaintiffs would have made if they had not been embarrassed by the interference of the defendants' machine. Because, the law presumes that the plaintiffs would have had the patronage which was diverted by the defendants. The profits which the plaintiffs have lost in consequence of the infringement, affords, therefore, a criterion by which to determine the amount of damages they have sustained.

The infringement claimed on the part of the plaintiffs took place between September, 1847, and April, 1848. It is claimed that they are entitled to the damages which they have actually sustained, together with interest upon the same from that time down to the present. My own view of this question is, that the jury, in estimating the damages, may take into account the interest, if they choose, and give it by way of damages. They may take into account in estimating

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the damages, the fact that the party has been deprived of them from the time the infringement took place down to the present time.

Charles O'Conor, Francis B. Cutting and George C. Goddard, for the plaintiffs.

Daniel Lord, William Curtis Noyes, Charles M. Keller and Edwin W. Stoughton, for the defendants.

HENRY L. PIERSON AND SAMUEL HOPKINS

vs.

CORNELIUS W. LAWRENCE.

Where duties paid to a collector are sought to be recovered back, on the ground that the proceedings in the Custom House, in initiating or conducting an appraisement of the goods on which the duties were paid, were irregular, the irregularities relied on must be set forth specifically in the protest.

The law as settled in *Thomson v. Matwell*, (*ante*, p. 385,) in regard to what is requisite in a protest against the payment of duties, again applied.

An accepted order for goods, although a purchase in the usage of the particular trade, as between vendor and vendee, is not a purchase under the 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) so as to authorize the entry of the goods, when imported, at a dutiable value fixed at the current price of like goods at the time the order was accepted, where the goods are to be manufactured after the acceptance of the order.

The date of an invoice, in an entry by the purchaser of goods, is, as against such purchaser, *prima-facie* evidence of the time of their purchase, and conclusive, until a mistake in the date is proved.

(Before NELSON and BETTS, JJ., Southern District of New York, November, 1852.)

THIS was an action to-recover back an alleged excess of duties paid to the defendant, as collector of the port of New York, on certain importations of iron. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts are sufficiently stated in the opinion of the Court.

Elias H. Ely, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. This cause was decided by the Court at the last term, but, at the instance of the counsel for the plaintiffs, the opinion of the Court was withheld, and leave was given to the plaintiffs to apply to the Court at the present term for a rehearing, upon the suggestion that important facts had been overlooked by the Court, or had not been properly presented to their attention. The Court consented to receive an argument on paper and to reconsider the case. The United States Attorney declined offering any further argument. The counsel for the plaintiffs has presented his views in a carefully prepared statement of facts and law, and the Court has reviewed, with close attention, these suggestions. The result is, that we have not been able to discover any error in our conclusions at the last term.

The case upon the facts is this: On the 7th of May, 1849, the plaintiffs made an entry, at the Custom House in New York, of 870 bundles of hoop-iron, valued at £174 10s. 9d. sterling, commissions, 2½ per cent., £4 7s. 3d., and charges, £1 1s. 5d., total, £179 19s. 5d., with an affidavit of one of the plaintiffs that the invoice accompanying the entry was true. That invoice is dated March 14th, 1849, and is from The Coalbrookdale Company to the plaintiffs. The iron was imported from Liverpool to New York in the ship *St. Lawrence*, and the date of the invoice, for the purposes of this case, may be taken to be the time of the departure of the ship from Liverpool, and that of the entry the time of her arrival in New York. On the 9th of May, 1849, one of the principal appraisers wrote on the face of the invoice: "Add 10s. per ton, to make market value, with chgs. and coms. as per invoice." This raised the entry to £191 2s. 3d., upon which sum duties were exacted. On the 10th of May, 1849, the plaintiffs wrote upon the face of the entry the following protest, addressed to the defendant: "We hereby protest against the payment

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of 30 *per cent.* duty on £191 2*s.* 3*d.*, charged on 870 bundles of hoop-iron contained in this entry, claiming that, under existing laws, said goods are only liable to a duty of 30 *per cent.* on £179 19*s.* 5*d.*, because that was the actual cost of the goods, and was the full market value at the time of purchase, and, if any delay occurred in the shipment, it was contrary to our express wishes and directions and owing to circumstances entirely beyond our control. We pay the amount exacted, in order to get possession of the goods, claiming to have the difference refunded."

Another entry was made by the plaintiffs, the same day, of 346 bundles of hoop-iron and 175 bundles of bar-iron, invoiced by the Coalbrookdale Company, March 14th, 1849, imported in the ship *Blanche*, from Liverpool, invoiced and entered at £120 7*s.* 5*d.*, and, as in the preceding case, raised by appraisement to £128 4*s.* 8*d.* On the 10th of May, 1849, a protest, in the same terms as in that case, was written by the plaintiffs on the entry. The oath of the owner and the order of the appraiser were the same in this instance as in the preceding one.

On the same day, a third entry was made, in like manner, by the plaintiffs, of 974 bars and 40 bundles of iron, imported in the ship *E. E. Perkins*, from Liverpool, invoiced by the Coalbrookdale Company, March 16th, 1849, at £198 5*s.* 2*d.* As in the preceding cases, the invoice valuation was raised by appraisement to £226 15*s.* 8*d.* The duties imposed thereon were paid by the plaintiffs under a written protest, dated May 10th, 1849, in the same terms as the one before set forth.

On the 21st of May, 1849, three other entries were made by the plaintiffs. One was of 839 bundles of bar-iron, imported in the ship *N. H. Wolfe*, invoiced March 27th, 1849, by the same Company, at £200 7*s.* 8., and raised by appraisement to £233 7*s.* 6*d.* The second was of 3,449 bars and 20 bundles of iron, imported in the ship *Liberty*, invoiced April 19th, 1849, at £277 7*s.* 3*d.*, and appraised at £329 12*s.* 0*d.* The third entry was on two invoices from the same Company, one dated April 6th, 1849, the other dated April 12th, 1849,

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imported in the ship Garrick. The joint invoice value was £786 5s. 4d. The appraised value was £866 6s. 9d. Duties were imposed and paid on the appraised values in all the cases, and like written protests were made by the plaintiffs.

On the trial, the plaintiffs proved the purchase-price or actual cost of the iron, by giving in evidence a correspondence between themselves and the Coalbrookdale Company, of Liverpool, by which it appeared that the iron charged in the invoices was ordered by the plaintiffs, by letters dated in New York in the months of November and December, 1848, and January, 1849, with specifications of the description and quality of the iron required. When those orders were received in Liverpool, the Coalbrookdale Company booked them, charging the various kinds of iron specified at the then current prices, and advised the plaintiffs that the orders were accepted. It was proved that this constituted a purchase, in the usage of the trade. The vendors then proceeded to prepare the iron conformably to the orders, and, when it was shipped, the invoices were made out at the prices prevailing at the time the orders were received, and without regard to the price or market value when the iron was delivered or shipped. Ordinarily, on the purchase of iron from manufacturers, some time elapses after the iron ordered is booked, before it can be rolled and prepared for shipping. Manufacturers are not accustomed to keep large stocks on hand awaiting orders, but to manufacture it to conform to the description ordered. The iron in the present case was ordered previously to the period it was expected to be shipped, to give time to have it manufactured.

It is to be assumed that the appraisement made by the appraisers exhibits the true market value of the iron at the times it was invoiced and shipped, for there is no evidence contradicting that valuation.

The plaintiffs protested against the duties exacted on the valuations of the appraisers, claiming that the iron was subject to duty only on the invoice prices, because these represented the actual cost and full market value at the time of

purchase. They now insist that the evidence produced by them on the trial proves that the market value and purchase-prices of the iron were according to the charges on the invoices and entries; and, further, that they have now made it evident, that the action of the appraisers and collector, in valuing the iron and imposing the additional duties, were irregular and without authority of law.

In support of the latter branch of this proposition, the counsel for the plaintiffs has gone into a minute and labored analysis of the provisions of the revenue laws in relation to the entry and appraisement of goods, and assumes, in maintenance of the first branch, as a principle of law, that, under the correspondence between the plaintiffs and the Coalbrookdale Company, there was a purchase of the iron by the plaintiffs at the time their orders were booked by the Company at Liverpool.

This latter position was the one most considered by the Court on the former argument, and we disposed of it adversely to the claim of the plaintiffs. We supposed that the re-argument was intended chiefly to reinforce the views of the plaintiffs and remove the difficulties of the Court on that point; but we are no less ready to review both points, under the advantage of the present argument, than if the same relative importance had been maintained between them as on the previous hearing.

We do not think that the plaintiffs have placed themselves in a position for questioning, in this action, the regularity of the proceedings in the Custom House in initiating or conducting the appraisements complained of, because they did not make objections of that character a ground of their protests. They dealt with the appraisement as being one right in form and even in substance, provided the time of shipment was properly taken as the time of purchase, and they cannot now charge upon the collector any defective or unauthorized exercise of power, not designated in their protests as grounds of objection. (*Mason v. Kane, Circuit Court, Maryland District, April Term, 1851.*) The same position

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was taken by this Court, in the cases of *Thomson v. Maxwell*, ante, p. 385. In that case, and in others decided about the same time, this point was carefully considered, and it was held that the importer could not maintain an action against the collector, to recover back duties paid, without proving that the moneys remained in his hands when the action was brought, or that a protest in writing was made at the time of payment, "setting forth distinctly and specifically the grounds of objection to the payment thereof."

We find that our construction of the statute in this particular has been sustained by the highest authority, in decisions published since our opinions were delivered. In *Norcross v. Greely*, (1 *Curtis*, 114,) a commission of $2\frac{1}{2}$ per cent. (with other charges) was added by the collector to the invoice value of an importation of crockery. The importers protested that they "pay no such commissions" as were added. The Circuit Court in Massachusetts decided that the plaintiffs were not entitled under the protest to recover back the payment. The objections taken at the bar were, that commissions were not usually paid in the trade of importing crockery-ware from England; that, if paid, there was no usual rate; and that $2\frac{1}{2}$ per cent. was not an usual rate of commissions; but the Court ruled that the plaintiffs could not avail themselves of those objections in the action, without setting them forth distinctly and specifically in the protest. Duties are not, in judgment of law, illegally exacted, so as to afford a right to the importer to recover them back, when the protest required by the Act of 1845 is not made, (*Lawrence v. Caswell*, 13 *How.* 488;) and the Act in terms fixes the requisites of the protest.

The counsel for the plaintiffs has gone through a labored research of the tariff Acts from their earliest enactment, and has argued from them that Congress has placed the whole system upon such a footing, that the oath made under the circumstances presented in this case, together with the sworn invoice, determined the purchase-price and dutiable value of the importation, and that, even if the Acts could bear the con-

struction that goods imported by the purchaser and owner could be subjected to an appraisement, yet an appraisement not ordered by the collector on his suspicion of an undervaluation in the invoice, and not conducted in all particulars by the appraisers pursuant to the direction of the Acts of Congress, was utterly void, and afforded no authority to the collector for increasing the duties.

We do not concur entirely with the counsel in the inferences he has drawn from the statutes he has examined, but we forbear from all discussion of the subject, for the reasons before indicated. These particulars of objection should have been pointed out to the collector in the protests, so that, if any error existed, he might have protected himself or the Government from the consequences, by having it rectified, or have relieved the plaintiffs without litigation. They cannot, under a proper understanding and enforcement of the Act of 1845, reserve such objections until the trial of their suit against the collector, and then make them available to charge him and the Government with the repayment of the duties collected. In our opinion, this branch of the case also falls within the provisions of the Act of 1845; and, as the protests did not set forth, distinctly and specifically, these objections to the payment of duties, they cannot now be regarded.

The particular point upon which we understood that a review of our former decision was sought was, whether the plaintiffs were entitled to enter the iron at the prices it bore when the contracts of purchase were closed, or whether it was liable to duties on its value at the times of its shipment. We listened to the application for a rehearing, under the impression that the point might involve the construction of the tariff Acts in a particular which does not seem to have yet been made the subject of judicial exposition; and, although satisfied with the construction we first gave to the law in this respect, we were anxious to see if any reasons, satisfactory to us, could be shown against our conclusions, in order that, if erroneous, they might be corrected before they should be promulgated.

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For the purposes of this decision, it is assumed that the proofs show that the iron imported conforms entirely to the articles stipulated, in the correspondence between the vendors and the plaintiffs, to be furnished under the orders given, and also that the usage of that trade regards the orders given by the plaintiffs, and their acceptance on being booked by the manufacturers, as a completed contract of purchase and sale. Under the equity of such a contract, if not by its legal effect, the iron, when manufactured, may be regarded as the property of the plaintiffs. We state these propositions in the strongest form in favor of the plaintiffs, in order that the point arising out of them, and in contest in this action, may be fully met and covered by our decision.

Assuming that the invoices were made up as of the times the iron was contracted for, and that they set forth correctly the prices agreed to be paid for the iron, we do not think that the contract between the parties constituted the *purchase* contemplated and provided for by the revenue acts, so as to fix the dutiable value of the goods or even justify their entry by those prices. It is to be observed that the tariff and revenue laws, in all their enactments of duties specific or *ad valorem*, have relation to the *res*, to property itself, and not to legal or equitable rights of property. Iron in bars or hoops is subjected to a duty of 30 *per cent. ad valorem*, and that tax fastens upon the commodity, not from the time it is manufactured for a particular purchaser, but from the time it is acquired by him for the purpose of importation. This was the effect of the law prior to the Act of March 3d, 1851, (9 *U. S. Stat. at Large*, 629.) (*Greely v. Thompson*, 10 *How.* 225.)

The 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) declares that "it shall be the duty of the collector," when *ad valorem* duties are imposed "on any goods, wares or merchandise imported into the United States," "to cause the actual market value or wholesale price thereof, at the time when purchased, in the principal markets of the country from which the same shall have been imported," to be ascertained, &c. This language points significantly to

things in being, to commodities having a market value and price in the principal markets of a country, and is in no way adapted to express the idea that a prospective contract of purchase with a manufacturer who is afterwards to make the article, shall fix the value or price at an indefinite period subsequently, when the purchaser may obtain the merchandise. The 35th section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 654,) in describing the invoices required and the oaths to be taken by importers, manifestly applies both to the merchandise in the condition in which it is imported. And the Act of March 1st, 1823, (3 *U. S. Stat. at Large*, 729,) so strongly relied upon by the plaintiffs' counsel on the argument, has relation, in its enacting sections and in the form of the oath prescribed to the owner, consignee or manufacturer, to the property imported, in the state and condition in which it was exported from its place of production, and most plainly contemplates the ordinary dealing between buyer and seller in market. The 4th section of that Act (*Id.* 731) enacts that, where goods imported shall be entered by invoice, the owner shall make oath that the entry contains a just and true account of all the goods, and that the invoice contains a just and faithful account of the actual cost of the said goods. The terms employed in the same section, in the manufacturer's oath (*Id.* 732) that "the goods were not actually bought" "in the ordinary mode of bargain and sale," supplies an interpretation of the sense in which Congress used the phrase *actual cost*, in the owner's oath, and plainly indicates the meaning to be that the goods, then owned by others, were acquired at the prices stated in the invoice. So, in connection with the manufacturer's oath, the requirements of the 5th section of the same Act (*Id.* 732) tend to confirm this construction; because, the word *procured*, there used, imports an actual possession of the property, and, *actual purchase* being so placed in juxtaposition with *procurement*, the same legal signification must be given to either expression in respect to possession of the goods.

That this consideration is entitled to weight, in determining

the intention of Congress in the whole provision, may be strongly illustrated by supposing that the Coalbrookdale Company had, at the time they received the orders of the plaintiffs, resolved to ship the iron called for on their own account, and registered the rates on their books and directed the quantities to be shipped by their Works. It is obvious they could not have invoiced the iron at those rates and prices, but must have charged the market price at the time the iron was *produced* by them, that is, when it came to their ownership manufactured, in a state for exportation. Upon the same principle, we think that the plaintiffs cannot be regarded as having been actual *purchasers* of the iron, within the meaning of the revenue laws, until they became owners of the thing itself—the subject-matter made liable to duties. Whatever in law would constitute a delivery and legal ownership, might satisfy the purpose of the revenue Acts in respect to possession; but, manifestly, the property must be in a state and condition that it may pass by delivery to the purchaser.

Chancellor Kent (2 *Kent's Comm.*, 468, and notes) states accurately the constituents of a valid contract of sale. The thing sold must have an actual or potential existence, and be specific or identified, and capable of delivery; otherwise, it is not strictly a contract of sale, but a special or executory agreement. Admitting the arrangement between the plaintiffs and the Coalbrookdale Company to have had all the essential properties of a contract of sale, it by no means follows that, as such, it became an actual purchase of the goods and merchandise, within the meaning and policy of the tariff Acts. Indeed, without laying emphasis upon the obvious design of Congress that the property imported should in kind be the subject of sale and delivery, to constitute a purchase, it may well be doubted, upon the authorities, whether the contract set up by the plaintiffs could carry with it any title or right in the plaintiffs to the iron after it was manufactured. (*Chitty on Contracts*, ed. 1851, 336; *Addison on Contracts*, 45, 46; *Smith's Mercantile Law*, 292, 293, 294.) The sale was not *in presenti*, and everything, even the creation of

the goods by the vendor, was to be done before delivery. Upon these qualities of the contract, it would be difficult for the plaintiffs to maintain an existing property in them to the iron, coeval with the making of the contract. It is to that date they refer their purchase or acquisition of it.

Suppose the value of iron had depreciated largely between the date of this contract and the time of the shipment—could the collector have directed a valuation of the iron as of the time of the order? And, in a stronger point of view, could the plaintiffs have been assessed or taxed on the amount of the purchase-price of the iron, as for so much property actually purchased by them? In our opinion, the term *actual purchase*, used in the revenue laws, is stronger, in its ordinary import and legal signification, than the phrase *contract of sale*, and necessarily implies the acquisition of the thing as actual property. We think, therefore, that on the fair construction of the statute, the plaintiffs are not permitted to claim the date of their contract as the time of the actual purchase of the iron.

We have given this part of the case an enlarged consideration, more to satisfy the counsel that no part of his elaborate and well-reasoned argument on this point has been disregarded by the Court, than to obviate any real difficulty presented in supporting the judgment before rendered by the Court. For, conceding that the plaintiffs were actual owners of the iron at the time alleged by them, and that its price then coincided exactly with their invoices, we think they cannot support this action, either for an overvaluation of the goods at the Custom House and the imposition of duties upon that valuation, or because of any irregularity or want of authority on the part of the appraisers or other officers of the Custom House, in appraising the iron or raising its invoice and entry valuation. To lay a foundation for the action, they must show that the duties were illegally exacted by the collector, and that they are entitled to appeal to the judicial tribunals for relief. (*Lawrence v. Caswell*, 13 How. 488.)

Laying out of view the form of the protests, and consider-

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ing the plaintiffs as entitled to prove their allegation that the iron ought not to pay duties on the valuation put upon it at the Custom House, and that they were entitled to enter it at the purchase-price, the invoices are, as against the plaintiffs, *prima-facie* evidence of the times of purchase, and become conclusive evidence on that point, unless a mistake of date therein is pointed out and proved by them. (*Marriott v. Brune*, 9 *How.* 619.) These invoices all bear dates concurrently with the shipments of the iron—March and April, 1849—and the plaintiffs show that the price of iron at Liverpool was then from 2*s.* 6*d.* to £1 7*s.* 6*d.* sterling, or more, higher per ton than the prices charged upon the invoices; and it was conceded on the argument, that the valuation upon which duties were imposed corresponded with the correct market value of the iron when shipped. There is no proof in the case, that any notice in fact was given to the collector that the invoices were incorrect in dates, and, under that state of facts, we think that the plaintiffs were legally concluded by their entries and oaths and by the invoices, from claiming a valuation of the invoices at periods anterior to those dates.

It is thus manifest that this action could not be supported, even if the form of the protests was not interposed as an objection by the defendant. We are, however, not at liberty, in deciding the case, to disregard that objection, and are of opinion that the protests made to the collector do not authorize the plaintiffs to take any exceptions to the authority of the appraisers to act in the valuation of the iron, nor to prove it was purchased at the times their orders for it were received and accepted by the Coalbrookdale Company, or at any time antecedent to the dates of their invoices. Judgment must accordingly be entered for the defendant.

HENRY L. PIERSON AND SAMUEL HOPKINS

vs.

HUGH MAXWELL.

The insufficiency of the protest against the payment of duties in this case, pointed out.

The doctrine of the case of *Pierson v. Lawrence*, (*ante*, p. 495,) applied.

(Before NELSON and BETTS, JJ., Southern District of New York, November, 1852.)

THIS was an action substantially like the case of *Pierson v. Lawrence*, (*ante*, p. 495.) The facts are sufficiently stated in the opinion of the Court.

Elias H. Ely, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. This case rests essentially upon the same class of facts as that of *Pierson v. Lawrence*, (*ante*, p. 495.) It is a suit to recover back an excess of duties exacted by the present collector on the importation of several invoices of iron from Liverpool. The invoices were from the Coalbrookdale Company and Bailey, Brothers & Co., to the plaintiffs, dated in April, May and June, 1849, and the iron was shipped concurrently with the dates of the invoices. The protests, written on the respective entries, are "against the payment of duty on (the increased valuation specified) added to the entry value by the appraisers, because the original entry was the actual cost and full value at the time of purchase." The protests designate no time of purchase different from that indicated by the invoices, at which the value is to be estimated, and there is no evidence impeaching the correctness of the valuation made by the appraisers in reference to the invoice dates. The plaintiffs cannot, under the protests, set up a different and long antecedent period of purchase,

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nor can they impugn the appraisement by giving proof of any irregular acts of the appraisers or other officers in making it. Those particulars should have been distinctly and specifically pointed out to the collector by the protests, in order to enable him to rectify anything erroneous in the manner of determining the value of the goods, or in the selection of the period at which that value was to be determined.

Judgment must be rendered for the defendant.

JULIUS FOCKE AND FRANCIS BOULT

vs.

CORNELIUS W. LAWRENCE.

A protest against the payment of duties must point out specifically the particular omission or irregularity complained of, or it will not be available in an action to recover back the duties.

The doctrine of the cases of *Pierson v. Lawrence*, (ante, p. 495,) and *Pierson v. Maxwell*, (ante, p. 507,) applied to the protests in this case.

A collector is not bound to take the invoice valuation of goods, supported by the owner's oath on the entry, as their dutiable value.

A collector is justified, in the absence of written notice of a different state of facts, in assuming the place of shipment of goods, as stated in the entry invoice, to be the place of their purchase, and the date of the invoice as the time of their purchase.

(Before NELSON and BETTS, JJ., Southern District of New York, November 1852.)

THIS was an action to recover back an alleged excess of duties and a penalty, paid to the collector of the port of New York. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts sufficiently appear in the opinion of the Court.

Elias H. Ely, for the plaintiffs.

J. Prescott Hall, (District Attorney,) for the defendant.

BETTS, J. The plaintiffs, merchants of Liverpool, shipped at that port three invoices of iron, in March, April and May, 1849. They took the owner's oath upon the invoices before the American consul at Liverpool, and swore that the iron was charged at the prices paid on actual purchase. On entry at New York, in May and June following, the invoice value was raised by the appraisers to the market prices of the iron at the dates of the respective invoices, and duties were exacted by the collector on that valuation, with the addition of a penalty. The importers subjoined to each entry a written protest against the additional duty. The language of two of the entries was, "claiming to enter the iron at actual and invoice cost." That of the third was, "claiming to enter it according to the sworn invoice."

The case differs from that of *Pierson v. Lawrence*, (*ante*, p. 495,) in this, that the plaintiffs were residents of Liverpool, and shipped the iron there on their own account. Their contracts of purchase were made with the manufacturers in Glasgow, October 30th, and November 1st, 1848, for future delivery, and the iron was all delivered at Liverpool in March and April, 1849. The plaintiffs offered no evidence against the correctness of the appraisers' valuation, taking the time of shipment as the time of purchase.

The plaintiffs urge, as in the case of *Pierson v. Lawrence*, in avoidance of the appraisement, *first*, that the invoice, verified by the owners' oath, is conclusive proof of the purchase-price of the goods; *secondly*, that the course pointed out by the Acts of Congress, to be pursued on the appraisement of imports at the Custom House, was not conformed to in this instance; *thirdly*, that no legal order to appraise was made. They also claim that the contracts of purchase were entered into in October and November, 1848; that the increased valuation and the imposition of the additional duty and penalty were all carried out at the Custom House in obedience to a Circular from the Secretary of the Treasury, and not by regular appraisement and the observance of the requirements of the revenue Acts; that a part of the purchase was *in præ-*

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senti, the plaintiffs having the right to an immediate delivery of the iron ; and that, in that respect, this case is distinguishable from that of *Pierson v. Lawrence*, and from that of *Pierson v. Maxwell*, (*ante*, p. 507,) where the purchases were prospective.

The plaintiffs proved, in this case, that an advance in the price of iron at Glasgow took place between the dates of the contracts of purchase and the shipments of the iron, but there does not appear to have been any distinct proof of the time or amount of that advance, nor of the market value of the iron in Glasgow at the period of the contracts, otherwise than by the testimony of a broker resident at Liverpool. These facts are stated in this opinion, not as the basis of the judgment of the Court, but that the case may appear substantially as presented to the Court.

Our decision is placed essentially upon the terms of the protests. The plaintiffs cannot go beyond or out of those, with their objections to the exaction of duties. If they supposed that the officers of the Customs had committed any irregularity in ascertaining the dutiable value of the iron, or if they desired more formal action on the part of the collector, the protests should have called his attention to the particular omission or irregularity complained of. In the case of *Barker v. Lawrence*, cited by the plaintiffs' counsel, in which the duties paid were recovered because of an irregular appraisalment, no question was raised by the defendant as to the sufficiency of the protest.

The presumption is, that the duties were levied according to law, and the collector is not personally subject to an action unless he exacts them against the protest of the importer, "setting forth distinctly and specifically the grounds of objection to the payment thereof." (*Lawrence v. Caswell*, 13 How. 488.) This is demanded by the statute, and it is a wise safeguard to a public functionary who exercises a very delicate and difficult trust, while it at the same time affords every reasonable protection to the rights of the importer. This Court has repeatedly expressed its purpose to adhere to the

language and spirit of this requirement of the law; and, applying that provision to this case, it is clear to our minds, that the plaintiffs have not shown that the collector violated any right set up by their protests, and which was secured to them by law. The protests import that the plaintiffs claimed the invoice charges to be conclusive evidence of the purchase-price and market value of the goods, but they give no intimation to the collector that the purchases were at a time different from the dates of the invoices, or that the market prices at the periods of purchase were different from what they were at the times of the shipments or at the dates of the invoices.

It is a great misapprehension to suppose that the collector is bound to take the entry of goods at the valuation of the invoice, supported by the owner's oath. His duty is directly the contrary. The 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) directs the collector to cause goods subject to *ad valorem* duties to be appraised, and specifically enacts that it shall be the duty of the appraisers, or of the collector, by all reasonable ways and means in their power, to ascertain, estimate and appraise the true and actual market value and wholesale price of the goods, at the time purchased, and in the principal markets of the country whence the same shall have been imported into the United States, "*any invoice or affidavit thereto to the contrary notwithstanding.*" To enable the importer to avoid the penalty of twenty *per cent.*, when the appraisement exceeds the invoice value by ten *per cent.*, the eighth section of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) permits the importer to make an addition to the entry price. That provision goes upon the assumption that the invoice price in no way determines the value of the goods.

If the plaintiffs were entitled to enter the goods at their market value at the place where purchased, (*Maxwell v. Griswold*, 10 *How.* 242; *Greely v. Thompson*, *Id.* 225,) still, the collector was not bound to know that the place of the purchases was different from that of the shipments, nor, more

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especially, that the times of the purchases were different from the dates of the invoices, unless he was expressly notified of such facts by the protests. It does not appear that he or the appraisers had any notice whatever of such facts. A verbal notice would be of no avail, even if the Court might be authorized to imply one, for the plaintiffs would be excluded from all advantage under it by the express provisions of the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 727,) which require it to be in writing.

We adhere to the judgment rendered in this case at the last term, finding that the plaintiffs, by their protests, point to no fact which in law can invalidate the appraisement, and also that, by the entries and the invoices, the collector was justified in taking the place and times of shipment as those of the purchases of the goods in question.

Judgment for the defendant.

HENRY T. CORNETT AND HORATIO R. NIGHTINGALE

vs.

CORNELIUS W. LAWRENCE.

Where, in a protest against the payment of duties, on an addition made by the appraisers to the invoice value, the only ground of protest stated was, that *the invoice exhibited the true market value of the goods at the place from which they were imported*: Held, in action to recover back the duties, that the only point raised by the protest was the correspondence of the invoice value with the value at the place of export at the date of the invoice, and that the plaintiff could not, under the protest, show that the invoice value was the actual purchase-price.

A protest against the payment of duties must set forth the specific objections of the party, and refer the collector distinctly to the facts, otherwise the party cannot avail himself of them in an action against the collector to recover back the duties.

(Before NELSON and BETTS, JJ., Southern District of New York, November, 1852.)

THIS was an action against the collector of the port of New York, to recover back an alleged excess of duties paid him. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts of the case appear from the opinion of the Court.

Elias H. Ely, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. In this case, and in the three preceding ones of *Pierson v. Lawrence*, (*ante*, p. 495,) *Pierson v. Maxwell*, (*ante*, p. 507,) and *Focke v. Lawrence*, (*ante*, p. 508,) the decisions of the Court, made at the last term, were withheld, at the instance of the counsel for the plaintiffs, until re-arguments could be heard in the cases. All of them relate to importations of iron, and involve substantially the same questions.

In this case, two entries of bar-iron were made by the plaintiffs, at the Custom House in New York, in May, 1849, on invoices dated at Liverpool in March and April preceding, and the valuations were raised by the appraisers to correspond with the market prices of the iron at Liverpool at the times of shipment. The proof is, that the values were stated on the invoices at the purchase-prices at the time contracts were made for the iron with the Coalbrookdale Company some months previously. The payment of the duties exacted by the collector on the increase in valuation was protested against, in writing, by the attorney of the plaintiffs, in this language, on each entry: "that, under existing laws, said amount is unjustly added, and is not liable to duty, because the said invoice and said entry exhibited the true market value of said iron at Liverpool, from whence said iron was imported."

There is no evidence to support the assertion of the protests, if they import that the invoices exhibit the Liverpool prices at the dates of the invoices. On the contrary, the

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plaintiffs proved on the trial, that the prices of iron advanced considerably at Liverpool between the alleged times of the purchase of these parcels and the times of their shipment; and the plaintiffs now insist that the contract prices should govern, and not the prices at the dates of the invoices.

The orders for the purchases in December and February preceding, and their acceptance by the manufacturers in Liverpool, were exhibited to the appraisers after the valuations had been raised. In our opinion, had these papers been submitted to the collector at the same time, that would not have satisfied the requirements of the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 727,) and would not have amounted to such notice to him as would enable the plaintiffs to maintain a personal action against him for the recovery of the duties exacted. They must, in their written protest, set forth their specific objections, and refer him distinctly to the facts on which the objections rest, in order to be enabled afterwards to avail themselves of them, in an action against him.

On examining the protests in this case, it is palpable that no other point is raised by them than that of the correspondence of the invoice charges with Liverpool prices at their dates; and, as already observed, that fact is indisputably against the plaintiffs.

Judgment for the defendant.

DANIEL M. WILSON AND OTHERS

vs.

CORNELIUS W. LAWRENCE.

The doctrine of the cases of *Pierson v. Lawrence*, (*ante*, p. 495,) *Pierson v. Maxwell*, (*ante*, p. 507,) *Focks v. Lawrence*, (*ante*, p. 508,) and *Cornett v. Lawrence*, (*ante*, p. 512,) applied to the facts of this case.

(Before NELSON and BETTS, JJ., Southern District of New York, November 1852.)

THIS was an action against the collector of the port of New York, to recover back an alleged excess of duties paid him. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts are stated in the opinion of the Court.

Elias H. Ely, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. This is another of the cases of iron importations. The iron in this case was imported by the plaintiffs in April, May and June, 1849. It was purchased by them from the Coalbrookdale Company, and Stitt, Brothers, of Liverpool, through an agent of the vendors in New York, by written orders addressed to the vendors in December, 1848, and January, 1849. On the trial, the agent testified that the course of business was to supply the iron at the prices which ruled when the order was booked and accepted. That date is not given in the proofs, but it is to be assumed that the arrangement was completed in due course of the mails. Letters from the vendors to the plaintiffs, of contemporaneous dates with the invoices, were put in evidence, advising the plaintiffs that the iron ordered had then been shipped at Liverpool. It was further proved that the price of iron materially advanced in Liverpool, between the times the orders were received and the dates of the invoices and shipments, and that the invoices represented the prices at which it was agreed the iron should be furnished to the plaintiffs at Liverpool. The plaintiffs, when the invoice price was objected to at the Custom House as being below the market value in Liverpool at the dates of the invoices, offered to show to the appraisers the correspondence above referred to, and claimed the right to enter the goods at the invoice valuations, based upon that correspondence and the actual purchase-prices on such contracts. Eight several entries were made. The appraisers raised the invoice prices to the market value at Liverpool,

and duties were exacted on that valuation. The duties on the increase in valuation amounted in the whole to \$538 80, against the payment of which the plaintiffs made, on the first entry, the following protest in writing: "We do hereby protest against the payment of duties on the extra 10s. per ton, added to the invoice per Wisconsin, from Liverpool, by the U. S. appraisers, as said invoice was made out and charged at fair market value at the time of purchase. We pay the additional duty to get possession of our iron, reserving our rights to future decisions on the subject." The other seven protests, written on the respective entries, varied somewhat from the terms of the first one, and were substantially as follows: "We protest against the payment of duty on any valuation exceeding our invoice, and only pay the duty on the value as appraised, to gain possession of our goods." The action is brought to recover back the extra payment of \$538 80.

This statement of the case brings all the points raised upon it by the counsel for the plaintiffs within the principles adopted in the several other cases reviewed and decided at the present term, relative to the rights of importers under purchases of this character and protests of like import. (*Pierson v. Lawrence*, ante, p. 495; *Pierson v. Maxwell*, ante, p. 507; *Focke v. Lawrence*, ante, p. 508; *Cornett v. Lawrence*, ante, p. 512.)

In our opinion, the iron was not purchased by the plaintiffs, within the meaning of the duty Acts of Congress, until it was acquired by them in a condition for shipment; and we think, especially, that under their protests they cannot legally raise any question as to any proceeding at the Custom House, except as to whether the appraisement was according to the fair market value of the iron at Liverpool at the dates of the respective invoices. No proof was offered impugning the justness of the Custom House valuation in this respect, and, upon the reasons assigned in the cases before referred to, we hold that the plaintiffs cannot, under their protests, avail themselves of any other objection to the payment of the duties which were exacted.

Judgment for the defendant.

ROBERT A. TUCKER AND ALPHEUS LIGHTBOURNE

vs.

HUGH MAXWELL.

Under a protest against the payment of duties and of a penalty, which only sets out that the entry invoice *is in all respects correct and just*, and that *no legal forfeiture or penalty has been incurred*, the invoice value of the goods having been increased on an appraisement, no question can be raised, in an action to recover back the duties and penalty, except as to the difference between the appraised and the market value of the goods at the place of shipment at the date of the invoice; nor can it be shown that the invoice value was the actual purchase-price.

What should be stated in such a protest, defined.

(Before NELSON and BETTS, JJ., Southern District of New York, November, 1852.)

THIS was an action against the collector of the port of New York, to recover back an alleged excess of duties and a penalty. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts are stated in the opinion of the Court.

Thomas W. Tucker, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. The plaintiffs moved for and obtained a rehearing of this case, and have submitted, in writing, the points upon which they ask a review of our previous decision. We have attentively considered the points and the reasons presented.

The plaintiffs, on the 29th of October, 1849, entered, at the Custom House in New York, 640 bags of pimento imported from St. Ann's Bay, in the island of Jamaica. The invoice was dated St. Ann's Bay, October 5th, 1849, and the pimento was valued on that and on the entry, at $2\frac{1}{2}$ d. sterling per pound. The pimento was appraised by merchant appraisers on the 3d of November, 1849, at $3\frac{1}{2}$ d. sterling per pound. Duties were

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charged conformably to that valuation, and a penalty or additional duty of \$1,020 was imposed because of the undervaluation upon the invoice. Against the exaction of the duty on the increase in valuation and of the penalty, the plaintiffs protested, in writing, in this language: "that the said invoice, as originally presented by us, is in all respects correct and just," and that "no legal forfeiture or penalty has been incurred."

On the trial, the plaintiffs proved that they purchased the pimento in the summer of 1849, and that the invoice price was the fair market value of the article at that time. It was further proved that the price advanced in October following. No evidence was given, on the trial, that the appraised valuation exceeded the market price at St. Ann's Bay at the date of the invoice, other than what is to be implied from the proof that in October the price had advanced to 3*d.* sterling per pound at that place, and that the article was then worth $\frac{1}{4}$ *d.* sterling more at Kingston.

We held, at the last term, that the protest would not authorize the plaintiffs to recover back anything beyond the difference between the appraised and the market value of the pimento at the time it was invoiced. And, even as to that fraction of $\frac{1}{4}$ *d.* sterling per pound, there was no clear and satisfactory evidence to outweigh the judgment of the public appraisers, supported by the valuation of merchant appraisers. Indeed, the only direct evidence to the point is a different valuation of the article by the Baltimore appraisers, on an importation into that port of pimento purchased and shipped at St. Ann's Bay about contemporaneously with the shipment of the parcel in question.

We adhere to our former opinion, and hold further, that the plaintiffs cannot recover the duties paid on the $\frac{1}{4}$ *d.* sterling per pound extra, supposing the appraisement to have been to that amount above the market value at the date of the invoice, because they did not specify in the protest that cause of objection. Had that particular been brought to the notice of the collector, he might have ordered a reconsidera-

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tion of the subject, and the importer might have been relieved from the improper charge; or, if justice had been denied him at the Custom House, he would then have had a legal foundation for an action to recover back the excess of duty.

The plaintiffs offered in evidence, on the trial, a letter written to the collector by the merchant appraisers, on the 27th of November, 1849, in which they asked him to re-appraise the pimento, on the ground that a like article had been entered and appraised in Baltimore at $2\frac{1}{2}$ *l.* sterling per pound, and that the information on which they acted in their appraisal might not have been so reliable as the evidence adduced at Baltimore, and that injustice might have been done to the plaintiffs in their valuation. That evidence was excluded by the Court, and we think it was properly rejected, as there was no color for holding it to be legal testimony in the cause. It was not brought to the attention of the collector when the duties were liquidated on the 29th of December, 1849, nor when they were paid on the 12th of January, 1850, and can, therefore, in no way be considered as forming part of the protest or notice in writing to him. So, also, it is manifestly out of our power, on this re-argument of the case, to notice the letter, if it might be regarded as legal evidence, no exception having been taken at the trial to the exclusion of the letter. We can only pass upon the evidence presented by the case agreed between the parties, and we discover nothing in that to support the allegation of the plaintiffs that the appraisers overvalued the pimento. We think, therefore, that in so far as respects the appraisal and the proceedings of the collector thereon, the plaintiffs make out no legal ground for reclaiming the moneys paid by them.

The plaintiffs further protested against the imposition and exaction of duties upon the invoice weight of the merchandise, and insisted that the same should be imposed upon the actual real weight thereof which was ascertained by the Custom-House weigher or other officer of the Government. We find no evidence in the case showing that any difference

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in weight between the invoice statement and that of the Custom House existed in respect to the pimento. The Court cannot assume that there was such difference, and they offer no opinion as to what would have been the effect of such difference, if one had been proved.

A further protest was added "against the imposition and exaction of any duties or penalty upon said merchandise whatever, the same being actually exported in bond." We find no evidence of that fact in the case. It is set forth in the petition for a rehearing, but is in no way admitted by the United States Attorney. He declined to appear on the re-argument, stating to the Court that he relied upon his previous argument and the decision of the Court at the last term. We are not, therefore, at liberty to act upon the allegation of the protest, or the re-statement of the fact in the petition for a re-argument. The plaintiffs should have shown on the trial the facts which would bring their importation within the Act excepting it, on re-exportation, from payment of duties at all, and then the protest would have brought up the objection now raised. The documents put in evidence only prove that the goods were entered for warehousing on the 29th of October, 1849, and that the duties were liquidated on the 29th of December, 1849, and paid on the 12th of January, 1850, under the above protest, but they nowhere prove the fact of re-exportation, or that the satisfactory security required by the Act of Congress, that the goods should be landed out of the jurisdiction of the United States, was given to the collector.

Judgment for the defendant.

Byam v. Eddy.

EZEKIEL BYAM AND OTHERS

vs.

EZRA B. EDDY. IN EQUITY.

Where a patent was granted for an improvement in making friction matches, the invention being only a new combination of old materials before used in making such matches, and consisting in a composition formed of phosphorus and earthy material and a glutinous substance only, without chlorate of potash, or any highly combustible material, in addition to the phosphorus: *Held*, that it was no infringement to use any one or all of the materials forming the composition, in making matches, provided they were not used in the combination patented, or to use them for such purpose in combination with chlorate of potash, as they were formerly used.

But a mere colorable difference, or slight variation in the combination, will not exempt a person from the charge of infringement.

Where a defendant, four months before the service of an injunction on him, had executed a bond to the plaintiff, acknowledging the validity of his patent, and his right to all that was granted by it: *Held*, that the bond was no evidence of a breach of the injunction, further than the recital in it, that the defendant had infringed the patent, might have a tendency to establish such breach; and that the inference or presumption arising from it might be overcome by credible and positive testimony, proving no infringement.

(Before NELSON and PRENTISS, JJ., Vermont, January 15th, 1853.)

THIS was a suit in Equity, founded on the infringement of Letters Patent. A provisional injunction having been granted against the defendant, pursuant to the prayer of the bill, the plaintiffs afterwards moved for an attachment against him for a breach of the injunction. An order to show cause against the motion was thereupon issued and served upon the defendant; and, his affidavit in answer thereto being filed, the matter came on to be heard upon affidavits and exhibits. The facts will appear from the opinion of the Court.

D. A. Smalley and Joseph A. Prentiss, for the plaintiffs.

Levi Underwood and Bradford Rixford, for the defendant.

PRENTISS, J. This is a motion for an attachment against the defendant, for contempt in violating the injunction granted against him on the 22d of last September, and served upon him on the next day. The injunction, which, it is proper to observe, was granted virtually without any hearing on the part of the defendant, though upon notice and appearance, refers to the bill, and, by the terms of reference, was intended to be co-extensive with the bill, and must be so understood. We must, therefore, look to the bill to see the extent of the injunction, what it forbids, and consequently what would be a disobedience of it.

The bill sets forth a patent to one Phillips, with the specification in full. The patent is stated to have been issued October 24th, 1836, for fourteen years; renewed and extended September 11th, 1850, for seven years from and after the expiration of the original term; and assigned to the plaintiffs September 17th, 1850. The patent purports to be for "a new and useful improvement in the manufacture of friction matches," and grants the exclusive right of making, using and vending to be used, "the said improvement."

The specification, after stating the invention to be "a new and useful improvement in the mode of manufacturing friction matches, for the instantaneous production of light," and to consist in "a new composition of matter for producing ignition," proceeds to say: "The composition used in preparing the matches usually called loco-foco, and which light by a slight friction, is a compound of phosphorus, chlorate of potash, sulphuret of antimony, and gum-arabic or glue. That which I use consists simply of phosphorus, chalk and glue." The specification then states the proportions of the ingredients, and the mode of preparing the composition, and, after saying that the proportions may be varied, and that the ingredients may also be varied by substituting gum-arabic or other gum for glue, and Spanish white or other absorbent earth or material for chalk, concludes in these words: "What I claim as my invention, is the using of a paste or composition to ignite by friction, consisting of phos-

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phorus and earthy material and a glutinous substance only, without chlorate of potash, or any highly combustible material, such as sulphuret of antimony, in addition to the phosphorus."

From the specification, it is obvious that the right secured by the patent consists, as expressed in the granting part of the instrument, merely in an improvement in the then existing mode of making friction matches; not in a combination of new ingredients not before known and used for that purpose; nor in a combination of any new with old ingredients, unless the use of chalk, Spanish white or other absorbent earths may be considered new, which would be contrary to the fact, as appears from the testimony of William Weller, an old manufacturer of friction matches in Fort Ann, New York. This witness, after stating that all the materials, except the absorbent earth, were contained in the old lucifer matches, says that that substance, as well as the other materials, was contained in the loco-foco matches; and that, in 1835, he made matches formed of glue or gum-arabic, or chalk or Spanish white, combined with phosphorus and chlorate of potash, and, during the spring and summer of 1836, publicly made, used and sold matches composed of these materials, and has continued to use that composition from that time to the present.

The invention claimed in the specification, then, is not a compound of new ingredients before used in making matches, but simply and only a new combination of old materials before in use for that purpose. It purports to consist in a composition producing ignition and combustion by friction, formed of phosphorus with the earthy materials and the glutinous substance only, without the presence of chlorate of potash, or of any other like objectionable ingredient, thus avoiding the danger supposed to exist in the combination of substances of such a nature with phosphorus. This, as I understand the specification, is the "new composition of matter," or new combination of materials, for producing ignition, claimed and patented as an improvement;

and it seems quite clear, that any person may use any one or all of the materials forming the composition, in making matches, provided he does not use them in the combination patented. Certainly, any one may lawfully use them for that purpose in combination with chlorate of potash, as they were formerly used, for that is a combination recognized as essentially different, and as being known and in use anterior to the patent.

The question, therefore, is, whether the defendant, in manufacturing and dealing in friction matches since the service of the injunction, as it is admitted he has done, has used the plaintiffs' improvement or combination of materials, or, in other words, made matches substantially according to their patent. I say, *substantially* according to their patent, for, a mere colorable difference or slight variation would not exempt the defendant from the charge of infringement. Such is the question in the case; for, as the injunction does not extend beyond what appears from the bill to be the right of the plaintiffs, unless there has been a violation of the right held by them under the patent set up in the bill, there can have been no disobedience of the injunction.

The plaintiffs' composition for matches, as described in their patent and charged to have been used by the defendant, is a compound, admitting of variation in the proportions of the ingredients, of one ounce of phosphorus, one ounce of glue or gum-arabic, and four ounces of chalk, Spanish white or other absorbent earth.

The composition asserted by the defendant to have been used by him, and which appears to have been publicly known and in use before the date of the plaintiffs' patent, is formed of four pounds of glue, two pounds of phosphorus, four pounds of whiting, and three-fourths of a pound of chlorate of potash; or, somewhat varying the ingredients and proportions, of four pounds of gum-arabic, two and one-half pounds of phosphorus, four pounds of whiting and one-half of a pound of chlorate of potash.

The only difference, aside from the relative proportions of

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the ingredients, between the composition patented and that claimed to have been used by the defendant consisting, as appears from the formula thus given of each, in one being made without and the other with chlorate of potash, the question in the case is reduced to the simple inquiry, whether the matches manufactured by the defendant contained that substance as a principal ingredient or material part, in conformity with the prescribed formula, or were made without the use of it, or with but so inconsiderable a portion of it as to be substantially according to the plaintiffs' patent.

The defendant, in his answer to the matters charged against him on this motion, after declaring that he has never violated or infringed the plaintiffs' patent, and that the bond executed by him to them was given through misapprehension on his part of the extent of their patent and of his own rights, occasioned by misrepresentation, says, that he has never at any time since he commenced business, which was last spring, made a match without the use of chlorate of potash, nor out of any composition of which that substance was not a constituent part, nor otherwise than according to what he states to be the ingredients and their proportions in the composition used by him.

Now, is the statement made by the defendant in his answer, true or untrue? What is the proof relative to the main essential fact asserted in it? Is the fact proved or disproved? In deciding this, if the proofs applicable to it are in any degree conflicting, they must be weighed, and the fact determined according as the weight or preponderance of proof may appear to be.

It appears that specimens of both kinds of matches manufactured by the defendant, there being two kinds, as inferable from the marks and labels, have been analyzed by Dr. Hayes, a professional chemist, and, for anything that is shown, a man of science and skill in his profession. In stating his analysis of one of the kinds of matches, Dr. Hayes says that he found the composition to contain, with the other materials he specifies, a very small portion of chlorate of potash or ni-

trate of potash. In stating another or second analysis of matches, marked as of the same kind, he mentions chlorate of potash as one of the materials of the composition, without saying anything as to its quantity or relative proportion. In giving his analysis of the other kind of matches, he names the substances into which the composition was resolved, without any mention of chlorate of potash as one of them. But, in reference to both kinds of matches, he says that phosphorus, gum or glue, and whiting or chalk, formed the essential parts of the composition, and that the composition was essentially the same as that of the matches made under the Phillips patent.

The results of these analyses, at least as to one of the kinds of matches, do not appear to disagree with what the defendant declares to be the constituent parts or materials of the composition used by him, except as to the quantity or proportion of chlorate of potash contained in it. And, as to the other kind, the disagreement is a matter of implication or inference, rather than of positive assertion or statement. Dr. Hayes says, to be sure, as to both, that the other ingredients, phosphorus, gum or glue, and whiting or chalk, formed the *essential* parts of the composition—a somewhat indefinite expression, implying, at least, that they did not form the whole of the composition. He admits that chlorate of potash, to some extent, was found in one of the kinds of matches, and he does not say that none of it was found or contained in the other. What proportion this substance bore to the others, in the two analyses in which it is admitted to have been found, is not stated, and, according to the opinion of one of the witnesses in the case, could not have been ascertained by chemical process. The point is a very material one, requiring some exactness of proof, at least as much as the nature of the subject will admit of, whether the proportion of chlorate of potash in the composition used in making the defendant's matches was really very small, so small as to be merely colorable, or to justify its being considered as used for the purpose of evasion, or whether the proportion was such as has

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always been used in that kind of composition, or as makes it a substantial part of the composition.

The bond executed by the defendant to the plaintiffs is an acknowledgment of the validity of the patent and of the plaintiffs' right to all that is granted by it. It is no evidence of a breach of the injunction, certainly any further than the recital in it, that the defendant had infringed the patent, may have a tendency to establish such breach. But the recital, in terms, only proves an infringement prior to the execution of the bond. The bond was executed in May. The pending proceeding relates to acts which have occurred since the service of the injunction, and embraces nothing further back than the 23d of September. Still, the admission of a prior infringement, unless procured by fraud or made through mistake, is entitled to its proper influence, with the other evidence in the case, in deciding upon the character of the acts directly in question. But no inference or presumption arising from it can overcome the weight of credible, positive testimony, such testimony being uncontradicted by any proof of the same nature or of equal certainty. This is especially true in a case partaking of the nature of a criminal proceeding, involving not only the imprisonment of the party, by way of punishment, but also the breaking up of his business.

Now, George E. Arnold says, that he has worked for the defendant in his shop, at Burlington, in the manufacture of friction matches, since the 15th of April last, and has made up the composition for most of the matches, and assisted in making all that has been made in the shop. He states the materials, with their proportions, used in the composition, which are the same specified in the formula we have already given. He says, that all the matches have been made according to the specifications in the formula; that no matches have been made, to his knowledge, of other or different materials; and that, if any had been otherwise made, he thinks he must have known it, as he has been constantly in the shop.

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Such, then, is the substance of the proofs relative to the actual composition of the matches manufactured by the defendant—a fact upon which, as we have seen, the case wholly rests. On the one side, the results of chemical analysis, such as have been already stated; on the other, the positive testimony of a witness, standing unimpeached, having full means of information, and swearing from actual knowledge. On which side the weight of proof is, would seem not to admit of a doubt, especially when it is remembered that one of the witnesses, who professes to have acquired much knowledge and skill in such matters, from long practice and experience, says, that he considers it impracticable to ascertain by analysis the proportions of the ingredients of a match. How this may be, I am unable to say, but such is the testimony. Upon the testimony I am to judge and determine; and my judgment is, what appears to be alone warranted by the proofs as they stand, that the attachment be refused, and the rule, of course, discharged.

THE UNITED STATES vs. CHARLES W. FARNHAM.

On an indictment for manslaughter, under the 12th section of the Act of July 7th, 1838, (5 *U. S. Stat. at Large*, 306,) against the captain of a steamboat, it is not necessary for the prosecution to show wilful misconduct, negligence or inattention in the captain.

The captain of a steamboat is responsible for the proper performance by the engineer, the pilot, and all the other officers, of their duties on board, unless their authority is expressly made independent of him.

The duties and responsibilities of the captain of a steamboat are the same as those of the captain of any other vessel; and, as to the relative duties and responsibilities of the different officers of steam vessels, there is no distinction between those which navigate inland waters, exclusively and sea-going vessels.

The 7th section of the Act above named makes it the duty of the *master* to see that the safety-valve of the boiler is raised when the steamboat stops.

Under that section, it is not sufficient to raise the safety-valve only when the pressure of steam is higher after than before the stoppage of the boat.

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Nor is the safety-valve to be raised only when the pressure of steam becomes, during the stoppage, higher than that named in the certificate of the inspectors as the pressure the boiler will bear.

Nor can other methods of lowering the pressure of steam—such as opening the furnace-doors—be substituted for the raising of the safety-valve.

It is a culpable omission in the captain to leave it to the discretion of the engineer whether to raise the safety-valve during a stoppage or not.

The omission of the captain to give orders for the raising of the safety-valve when the boat stops, is legal evidence to support an indictment against him under the 12th section of the Act, provided the omission to raise the safety-valve was the proximate cause of the destruction of life.

(Before BETTS, J., Southern District of New York, January 21st, 1853.)

THIS was an indictment against the defendant, under the 12th section of the Act of July 7th, 1838, entitled "An Act to provide for the better security of the lives of passengers on board of vessels propelled in whole or in part by steam," (5 *U. S. Stat. at Large*, 304,) for manslaughter, in causing the death of several persons, who lost their lives by the explosion of the boiler of the steamboat *Reindeer*, while she was landing passengers at Bristol dock, on the Hudson River. The defendant was the captain of the steamboat. The substance of the indictment, and the facts put in evidence to sustain it, on the trial, which took place before BETTS, J., sufficiently appear from the charge of the Court.

J. Prescott Hall, (*District Attorney*), for the United States.

William Curtis Noyes and *Dennis McMahon*, for the defendant.

BETTS, J., in charging the jury, remarked as follows :

The indictment in this case is founded on the 12th section of the Act of July 7th, 1838, which is in these words: "And be it further enacted, That every captain, engineer, pilot or other person employed on board of any steamboat or vessel, propelled in whole or in part by steam, by whose misconduct, negligence or inattention to his or their respective duties, the

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life or lives of any person or persons on board said vessel may be destroyed, shall be deemed guilty of manslaughter, and, upon conviction thereof, before any Circuit Court in the United States, shall be sentenced to confinement at hard labor, for a period of not more than ten years." The 7th section of the Act is to be taken in connection with the 12th, as indicating the particular act of negligence on which the indictment is based. That section is as follows: "And be it further enacted, That whenever the master of any boat or vessel, or the person or persons charged with navigating said boat or vessel, which is propelled in whole or in part by steam, shall stop the motion or headway of said boat or vessel, or when said boat or vessel shall be stopped for the purpose of discharging or taking in cargo, fuel or passengers, he or they shall open the safety-valve, so as to keep the steam down in said boiler as near as practicable to what it is when the said boat or vessel is under headway, under the penalty of two hundred dollars for each and every offence."

The indictment charges on the master of the Reindeer the crime of manslaughter, because, by his misconduct, negligence or inattention at the time and place alleged, the lives of many persons on board were destroyed. The question at issue on the indictment is, whether the Government has, by legal and sufficient proof, convicted the defendant of the crime of manslaughter.

The law does not require the public prosecutor to prove wilful mismanagement or malconduct by the accused. The inquiry is not, whether he was guilty of intentional negligence or inattention, but only whether he did what is forbidden by the law, and whether the explosion and destruction of life charged in the indictment arose from either of those causes. To resolve that question, you must have a clear and accurate understanding of the meaning of the terms used by Congress in the law.

By misconduct, negligence or inattention in the management of steamboats, mentioned in the statute, is undoubtedly meant the omission or commission of any act which may

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naturally lead to the consequences made criminal ; and it is no matter what may be the degree of misconduct, whether it be slight or gross, if the proof satisfies you that the explosion of the boiler was the necessary or most probable result of it.

In order to possess a satisfactory apprehension of the language of the Act, it is important to understand what are the duties of the captain of a steamboat—what responsibility he incurs personally—when his duty is merged in the duties of the other officers—and when the responsibilities of the other officers are independent of his. Was it the duty of the master to see to the state of the boiler, or that proper precautions were taken to relieve it from the pressure of steam when the boat was running or had stopped, or did that duty belong exclusively to the engineer ? The practice and opinions of experienced officers and engineers on the subject have been testified to. It appears that a practice has grown up and become very common, to allot to the different officers separate and independent trusts and commands ; and it is a general notion that it belongs to the pilot to navigate the vessel, independently of the captain, and that the engineer is, in his special department, not subordinate to the captain in the performance of his duties. If that were the true construction of the law, the captain would stand discharged of responsibility for all acts of the engineer appertaining to his particular department. There is no foundation in law for such distinction and restriction in the duties of officers of steamboats. They are the same in law as those of the officers of other vessels. The master is commander-in-chief. The law entrusts him with the control of the vessel and of every department of service on board ; and the engineer has no more right to refuse obedience to his orders than has the mate. The captain is charged with responsibility for the right performance of all duties which appertain to the command and management of the propelling power of the vessel. If there be misconduct or neglect in the engineer's department, the captain is, by the maritime law, responsible civilly,

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and, by this statute, criminally, for the consequences. But, if he procures competent persons, and gives them injunctions to perform the duties, the law will not impute guilt to him, if they, without his knowledge, neglect the duties assigned to them.

Although the captain may not select or engage the engineer, and the owners, as they have a right to do, employ him and fix the amount of his compensation, yet that circumstance in no way withdraws from the captain the rightful control over him, in every particular of his service on board, unless his authority is expressly made independent of the captain. This must manifestly be so, or there could be no unity of command or action in working the vessel. The notion expressed by some of the witnesses, that an engineer holds his place independently of the authority of the master, and that the latter has no power to restrain him, even if he is crowding the machinery with a head of steam beyond what the master deems to be safe or prudent, has no foundation in law. The master has supreme command in all respects, in directing the navigation of the boat, including control over the head of steam to be used. He is responsible for every misuse or neglect of that authority, and is, by the law in question, made a wrong-doer, answerable criminally on indictment, if he omits to interpose and suppress the danger. He is bound to see that all persons under his command do their duty properly; and this statute especially compels him, at his personal peril, to be actively awake to the safety of his passengers. It makes no difference in his favor, if the engineer be the more skilled and competent man in respect to the management of steam. The supremacy of authority is with the master, on general principles; and, in respect to specific duties imposed on him by law, he is responsible that proper measures be taken for their performance.

There is no distinction, in law or maritime usage, between the relative duties and responsibilities of different officers who serve on vessels propelled by steam, whether such vessels navigate inland waters exclusively or are sea-going ves-

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sels. The pilot cannot, at his discretion, take a course differing from that directed by the master. Nor can the engineer raise the steam to or keep it at a gauge beyond what is prescribed by the master, whatever may be the desire or judgment of the pilot or engineer in those respects. It belonging to the master, of right, to dictate to his subordinate officers, it will be presumed that what is done by them, under his observation, is so done by his direction or assent, unless he proves his ignorance or that his directions have been disregarded.

The great question in this case is, whether the omission to raise the safety-valve when the vessel stopped at the dock at Bristol, was an act of misconduct, inattention or negligence in the captain, within the meaning of the 12th section of the statute? This question arises on the 7th section of the same statute, which I have already read to you. The statute does not charge the engineer with the duty of raising the safety-valve, but it is imperative in respect to the master, and imposes the duty on him to see that the safety-valve is raised when the boat stops. The omission to do so thus becomes, in respect to him, a direct violation of the law, and has an important bearing upon the meaning and application of the 12th section.

It is not a correct interpretation of the law, to understand it as requiring the safety-valve to be raised only in the contingency that the boiler has acquired, while stopped, a higher pressure of steam than was upon it when the boat was under headway; for that would permit the captain, without regard to danger, to keep the head of steam, during stoppage, the same as it was before coming to the dock. This would be, manifestly, in violation of the whole policy of the enactments, because a boat might thus be running under any head of steam, no matter how extreme and perilous, and yet the steam might be maintained at the same height while at the dock. The law was framed to promote the safety of the vessel and of the property and passengers on board. The whole purpose aimed at would be frustrated, if the boat could be al-

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lowed to retain, when stopped, any pressure of steam she could generate whilst in motion. The object of the law was to secure a low state of steam, at all events, when the boat stopped; and, to effect this, the safety-valve is required to be opened, so as to keep the steam down, at all events, to what it was when the vessel was under headway. This presupposes that she is running with no more steam than is safe and prudent in the condition of her boiler. It would be, in itself, an act of misconduct to keep, at any time, a gauge of steam on the boiler beyond its fair capacity to bear; and, in addition to that plain obligation implied in the provisions of the 12th section, Congress superadded, in the 7th section, the express duty of raising the safety-valve on stopping the boat.

The course of the defence would seem to imply that the accused was justified in carrying any amount of steam within the range of fifty pounds to the square inch, which the certificate of the inspectors suggests the boiler would bear. But, the inspectors have no authority, under the Act, to dictate what amount of steam, whether forty or fifty pounds, more or less, may be used, or to compel steamboat owners or masters to follow their advice in that respect. It was wise and prudent in them to counsel parties on that subject. But this was only advisory and cautionary. They had no power to compel obedience. Nor was their opinion backed by facts which could give to it any special importance with the engineer or master. They had no authority to test the sufficiency of the boiler by steam or hydraulic pressure, to ascertain whether it could bear fifty pounds or ten pounds pressure to the inch. Moreover, these inspections are only periodical, and are required to be made at six months intervals. In this instance, the period for re-inspection had nearly come around, and that should have been a further caution to the officers of the Reindeer to be vigilant and prudent, and not to rely upon the opinions of inspectors, given months previously, as to the present safety and sufficiency of the boiler.

The testimony also affords reason to believe that, during the time since the last inspection, the boat had been running

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in active competition with others, which would have tended to overstrain and weaken the boiler, and to render less and less reliable and trustworthy the opinion of the inspectors upon its former condition and strength. This condition of things is necessarily incident, in a greater or less degree, to all boats in use ; and, therefore, it is not to be implied that Congress intended to take the height of steam put upon a boiler whilst a boat is running, as the measure of what may be retained when she is stopped. It would be to abrogate the beneficial object of this feature of the law, so to construe it. The whole scope of the enactment shows that Congress intended that steam vessels should be, at all times, restrained to the use of no more steam than is compatible with entire safety ; and the particular provision in question aims to fulfil that general intention, by guarding against an accumulation of steam when the vessel is at rest. Masters and engineers would be responsible, under the common and local law, for putting on an unsafe amount of steam in running boats. And Congress, without giving further sanction to that law, by inflicting a fine or punishment, under the United States authority, for its violation, has applied its positive enactments, in this particular, by an absolute injunction that the safety-valve shall be raised whenever the vessel is stopped. It is hoped that the provisions of the new law, which goes into effect in a few days, (*Act of August 30th, 1852, 10 U. S. Stat. at Large, 61.*) will prove more efficacious, both in ascertaining the actual strength of boilers, and in compelling a prudent use of them when the boat is in motion, than has been secured under the existing law ; but its regulations have no application to this case.

The special question for the jury to consider and determine is, whether the vessel was under a prudent and safe head of steam at the time she was stopped at the landing, and whether the boiler had a sufficient supply of water ; and next, whether the omission to open the safety-valve at that time was the cause of the explosion.

A ground of defence taken on this branch of the case is,

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that the safety-valve is required to be raised only as a means for lowering the steam in the boiler, and that the method pointed out in the Act need not be adopted, if other and better means are employed for effecting the same end. In this view, it is contended that the accused has clearly proved, from universal practice and the judgment of skilful and experienced men, that, when coal is used for fuel, the steam in the boiler is more speedily and certainly reduced and made safe, by opening the furnace and flue-doors, than by raising the safety-valve. I do not, however, interpret the statute as leaving it optional with the master to adopt the course prescribed by the statute, or to substitute another. I think the statute is peremptory, and that the master has no right to deviate from its particular requirement. The plain language of the Act must govern, and the master is bound to obey it. Congress has the like power to dictate in this particular as in that of the enrolment or inspection of steam vessels before they are allowed to run, and, in either case, to subject owners and masters to penalties for disobeying the prohibition.

The propriety of this enactment, or its fitness to secure the end proposed, or its inutility or inferiority to other methods, could not be determined with certainty by the opinions or theories of experts, if it were left an open question. This has been clearly evinced by the evidence on this trial. The statute is designed to obviate all obscurity or speculations on this point, and to supply a plain and determinate rule of action for the avoidance of a special hazard and peril, and, what is equally important, to insure implicit obedience to its regulations. Engineers, like other professional men, naturally incline to give slight heed to legislative directions which stand in conflict with their own opinions and practices. But it cannot be necessary to say more on this head, than that theories and speculations can have no place here. Congress has the power to give the rule, and we must accept the national will, as expressed in the law, as fixing the method which must be observed and adhered to, without

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regard to its abstract reasonableness or usefulness. Besides, it is far from being made clear, upon the evidence, that the usage of opening the doors of the furnaces relieves the boiler sufficiently, or that the idea is an erroneous one which induced Congress to require the safety-valve to be always opened for the discharge of steam when the boat is stopped. After an experience of twelve or thirteen years, Congress appears to adhere to the same opinion; and, in a few days, a law will go into operation compelling steamboats to have, not only one but three safety-valves ready for use, one of which must be self-acting and out of the control of the captain or engineer, so that it shall open at a particular point of steam, no matter what other means are in use to keep the steam below that point. Nor do I think that the engineers express themselves decidedly of opinion that opening the doors of the furnaces and flues can always be relied upon as sufficient, nor but that, under many circumstances, it will be necessary to open the safety-valve also, especially if there be a deficiency of water in the boiler.

It seems to the Court plain, that the object Congress had in view, in the provision, was to compel the master to have the safety-valve opened when the boat stops, without regard to other measures which may be employed to prevent an explosion. If experience has demonstrated the law to be useless or improvident, and that additional danger is incurred by raising the safety-valve, the Legislature should have been appealed to for a repeal or modification of the law, so that masters need not be compelled to use means calculated to increase danger instead of warding it off. The legislative will must govern; and that declared by this law must be obeyed until a different one is substituted by Congress. But, if we may judge by the late enactment on the subject, there has been no change of legislative opinion. It is no matter what may be the inconvenience or expense to the owners, or what delay it may cause in the progress of the boat. It is your duty, equally with that of the Court, to hold captains of steamboats to a strict obedience to the direction of the

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Legislature, and to regard an intentional deviation from it as a fault. Whether such neglect or misconduct be of a criminal character, will be more particularly considered hereafter.

The excuse set up for the master, in this instance, that he was occupied with other duties of his command, cannot avail as a defence, because it was in no way necessary that he should be personally at the engine and raise the valve with his own hand. He would stand acquitted of blame if he had laid express commands on the engineer and his assistants to see that it was done at every stoppage. He is not permitted to leave this duty to the judgment and discretion of the engineer, even if satisfied the latter has more skill and experience than himself.

The crime created by the statute does not rest upon any wrong intention of the officer who is subjected to indictment. As regards the defendant in this case, he is not accused of any wilful misconduct, or of any design to injure the vessel or any person on board, or to put either in danger. The indictment is not placed upon that ground. You will examine the evidence, and see whether you can fairly imply from it that the captain had given proper orders for the safety-valve to be raised when the boat was stopped; and, if not, you must regard his omission to take that precaution as legal evidence of misconduct, negligence and inattention, tending to support the indictment. In order to convict him, the District Attorney must prove some act of negligence or omission. It must be shown that the accused omitted to do something which it was incumbent upon him to do in fulfilment of his duty, or that he did something in violation of his duty. The mere circumstance of the valve's not having been raised, is not to be taken by itself as full proof of the crime charged against the captain. The essential question is, not whether the evidence shows that the captain was negligent of his duty, but whether the explosion was caused by the particular negligence proved; that is, whether the proof satisfies your judgment that the omission to raise the valve

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was the proximate cause of the explosion and of the death of the persons destroyed. And, in examining this point, it is important to ascertain what was the actual state of the boiler. If it was insufficient, from some inherent defect, at the time it was inspected, or had afterwards become so from ordinary use, and there was nothing discernible, by reasonable attention and diligence, to indicate any defect, and if, furthermore, it appears that such occult defect was the cause of the explosion, then the defendant cannot be made responsible criminally for consequences arising out of that condition of things. It is necessary that this branch of the case be carefully considered, and, if it appears upon the evidence that this boiler must, most probably, have exploded under a cautious use of steam, and that it was intrinsically unsafe under such circumstances, the omission to raise the valve on stopping the boat should not be regarded as adequate evidence that such omission caused the explosion, and the accused ought to be acquitted of the crime charged upon him by the indictment.

It is incumbent upon the jury to weigh considerably the proofs bearing upon this point, and to be satisfied there was no more than a reasonable head of steam upon the boiler at the time of the explosion ; because, latent defects in that will afford the master no protection, if he allowed an improvident and unsafe pressure of steam to be then generated. The accused is called on to answer for his negligence or misconduct in allowing the boiler to be under a dangerous gauge and pressure of steam, but not for an explosion arising from other causes. The only direct proof of any act of misconduct, negligence or inattention by the defendant, is his omission to have the safety-valve raised at the time it was, by statute, made his duty to raise it ; but, you must connect with that and consider all other circumstances in evidence attendant upon the catastrophe or directly preceding it, and judge from the whole evidence whether that omission was the productive cause of the explosion and homicide charged upon him. If, on consideration of all the facts and circum-

stances laid before you by the testimony, you are unable to determine, to the clear satisfaction of your judgment, what was the immediate cause of this disaster, and of the appalling destruction of life which attended it, or if, on such review, it remains doubtful in your minds whether the explosion was occasioned by any culpable inattention, or negligence or misconduct of the defendant, then he is entitled to your acquittal.

The jury, after retiring, came into Court, and requested a further explanation of the 7th and 12th sections of the Act.

Judge BETTS read the two sections to the jury, and remarked that, the command of the 7th section being positive, that the master shall open the safety-valve on the stoppage of the boat, it is a culpable omission in him to leave it to the option of the engineer to open the valve or not, at his discretion. It is the duty of the master to give explicit orders that the statutory direction in this respect be strictly obeyed. The true construction of the law does not authorize the master to keep the safety-valve down while the boat is stopped, although the steam is no higher during the stoppage than when the boat was under headway, provided the pressure before she stopped was an unsafe one. The law does not authorize the master to keep on a head of steam when the boat is stopped, which was dangerous when she was under headway.

The 12th section does not declare that the particular act of misconduct or neglect, in keeping down the safety-valve when the boat is stopped, is a criminal offence; but it becomes so, under that section, if the omission to open the valve at that time causes the explosion of the boiler. If the jury are satisfied, upon all the evidence, that an improper and unsafe pressure of steam was kept on the boiler, and that it exploded from that cause, and of the further fact, that, if the safety-valve had been opened when the boat was stopped, the danger would have been avoided, then, as before remark-

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ed, the master's disobedience of the 7th section in that respect would be legal evidence against him under the 12th section. That disobedience is not declared to be of itself a crime; but yet, if it causes the death of a person on the boat, it is competent evidence in proof of the misconduct or negligence which is made criminal by the 12th section.

DUTILH & COUSINERY vs. HUGH MAXWELL.

Under the proviso to the 61st section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 878,) an importer of goods from Austria is entitled to enter them on the payment of duties on their specie value, although the invoice is made out in a depreciated paper currency, legitimated by the Austrian Government; but, in order to avail himself of the benefit of the proviso, the deterioration of the invoice currency must be proved in the manner required by the proviso.

Accordingly, as the proviso authorizes the President to make regulations for estimating the duties on goods invoiced in a depreciated currency issued under the authority of a foreign Government: *Held* that, under a Treasury Circular requiring invoices of goods, when made out in such depreciated currency, to be accompanied by a consular certificate showing the specie value of such currency, the presentation of such certificate is a prerequisite to any correction of the invoice, or to any relief founded on such depreciation in currency.

Where no such certificate accompanies the invoice, and no bond for its production is given, its place cannot be supplied by parol evidence of the depreciation in the currency.

(Before BETTS, J., Southern District of New York, February, 1853.)

THIS was an action against the collector of the port of New York, to recover back an alleged excess of duties paid him. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts are stated in the opinion of the Court.

John S. McCulloh, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

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BETTS, J. The importations in question in this case were of merchandise purchased in Austria and invoiced and shipped at Trieste in June and September, 1849, and entered at the Custom House in New York in August, September and October, 1849. The purchase-prices of the goods were stated, in the invoices and entries, in the paper currency of Austria, from which a deduction on some of 28½ *per cent.*, and on some of 27½ *per cent.*, was claimed by the plaintiffs at the Custom House, to bring the invoice prices in florins to the specie standard. The values of the goods were, however, rated by the collector according to the nominal paper prices, and duties were exacted on those values. A protest in writing was made at the time by the plaintiffs, to the sufficiency of which in law no objection is taken on the part of the defendant. No consular certificate of the United States consul at Trieste, showing the depreciation of the invoice currency below the specie standard, was offered by the plaintiffs or demanded at the Custom House by the collector or any of his officers, nor is there evidence that the collector exacted a bond for its after production. The plaintiffs brought their action to recover back the duties paid on the differences between the specie value of the importations and that expressed in the invoices in the depreciated currency.

This Court has decided, in two cases heretofore before it, that the Government was entitled, by the revenue laws, to exact duties only on the specie value of goods in the country of production or exportation, and that, when the purchase-price was exhibited in a depreciated currency, the importer might prove, as a fact *in pais*, what was the actual value of the nominal currency in the foreign market. (*Grant v. Maxwell*, *ante*, p. 220; *Loewenstein v. Maxwell*, *ante*, p. 401.) In the last case, oral evidence of the fact of depreciation was given and received without question by the Government as to its admissibility or sufficiency, and the jury found the value of the currency upon that testimony. In the first case, the depreciation was proved both by the production of a consular certificate and by evidence *in pais*. No evidence other than

oral was given in the present case, and it was taken subject to the objection of the defendant as to its competency and effect.

The principle adjudged in the two cases above referred to is, that the Act of May 22d, 1846, (9 *U. S. Stat. at Large*, 14,) does not rescind the proviso to the 61st section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 673,) so as to permanently fix the value of the Austrian florin in respect to purchases and invoices made in that money on importations from Austria to the United States, but that subsequent adulterations or depreciations of the currency may be proved according to the provisions of the Act of 1799. In case the Government of that Empire legitimates a base currency in florins at a value equal to that of specie florins, the importer will be protected, by force of the Act of 1799, from losses so arising, and will be entitled to enter his goods on payment of duties upon the specie value of the importation. That construction of the law is in effect adopted at the Treasury, and, by a Circular issued September 19th, 1851, will govern future importations.

That doctrine is not called in question in this case, but the point is now raised for the first time, that the merchant cannot have the advantage of the principle without proving the deterioration of the invoice currency in the manner required by the Treasury instructions founded upon the authority conferred by the proviso to the 61st section of the Act of 1799.

There can be no doubt of the legal principle that, if a mode of proof is prescribed by the terms of the law, or by its fair interpretation, no other than the statutory evidence can be admitted.

It appears to me, that the cases adverted to, and this suit itself, rest upon a principle which, in effect, disposes of the question now presented. The right to maintain this action springs out of the provisions of the proviso referred to, as interpreted by this Court, in connection with the Act of 1846. If the latter Act works a repeal of the proviso, in respect to the currency of Austria, the plaintiffs have no footing upon

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which to base their action. In bringing forward that proviso as the authority for their demand, they must necessarily take it subject to all its legal qualifications and conditions. A cardinal one is a power in the President to establish regulations to meet the case of invoices exhibited in a depreciated currency, for the purpose of equalizing *ad valorem* duties. Its terms are, "that it shall be lawful for the President of the United States to cause to be established fit and proper regulations for estimating the duties on goods, wares and merchandise imported into the United States, in respect to which the original cost shall be exhibited in a depreciated currency issued and circulated under the authority of any foreign Government." The acts of the Treasury Department, to which matters affecting the revenue appropriately belong, are, in law, the acts of the President, (*Wilcox v. Jackson*, 13 *Peters*, 498,) and, accordingly, the instructions given by the Secretary of the Treasury, either by general Circulars to collectors, or by specific directions in a particular case, are to be regarded by the Court as regulations in that behalf established by the President. A part of the Circular of August 20th, 1845, is directly applicable to this subject, and is as follows: "Invoices of *ad valorem*, specific or free goods, when made out in a foreign depreciated currency, or a currency the value of which is not fixed by the laws of the United States, must, in each case, be accompanied by a consular certificate, showing the value of such currency in Spanish or United States silver dollars."

The decisions before cited regard a foreign currency debased by legislative authority since the Act of 1846, as being "a currency the value of which is not fixed by the laws of the United States," and hold that, accordingly, the importer can have relief against its effect upon his invoices, under the Treasury instructions founded upon the 61st section of the Act of 1799. It follows, as a necessary consequence of that doctrine, that, in order to obtain the relief, he must present his claim under the sanction prescribed by the instructions, and must accompany each case by a consular certificate. A

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collector has no power to dispense with this requirement, or, by a course of practice or construction, to enable importers to draw from the Treasury, upon other and inferior evidence, duties paid in upon a wrong valuation of importations, the same as if a consular certificate had accompanied the invoice and been presented to prove the debasement of the invoice currency. That document is the statutory evidence and authority upon which the invoice may be rectified; and it cannot legally be corrected without either exacting the presentation of the certificate with the invoice, or taking a bond to produce it. This bond, of necessity, becomes estreated to the Government if the certificate is not forthcoming according to its condition; and the direction of the President that a bond must be given to produce the certificate, is full notice that the certificate is a prerequisite to any relief in this respect.

The entry, in this case, was made without the offer of a consular certificate, or any demand of one by the collector, or of a bond for its production, and the protest against the exaction of duties on the invoice value makes no mention of the existence of such a certificate.

Upon these facts, I am of opinion that the plaintiffs have not, by legal and sufficient evidence, substantiated a right of action against the defendant, and that judgment must be entered for him.

WILLIAM CRAIG AND CHARLES M. DUTILH

vs.

HUGH MAXWELL.

Where a protest against the payment of duties claimed a discount on the value in paper currency stated in the invoice, "as per consul's certificate," and the invoice stated the fair market value of the goods, at its date, at the foreign port, in paper currency, and also the correct rate of discount for specie value: *Held*, that the statement in the protest amounted to an averment that a proper

consul's certificate was presented to the collector with the invoice, or, at least, that the importer had one, or was able and offered to produce it. It is not necessary that such a certificate should be absolutely presented with the invoice when the entry is made; but, if it is not so presented, a bond must be given to produce it. Where such a certificate is offered and rejected, or when an offer is made to produce one, and the collector does not exact such bond, it will be presumed that the collector refused to be governed by the certificate if exhibited. Under such circumstances, the importer stands on the same footing as if such a certificate had accompanied his invoice.

(Before BERR, J., Southern District of New York, February, 1853.)

THIS was an action to recover back an alleged excess of duties paid to the defendant, as collector of the port of New York. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts are stated in the opinion of the Court.

John S. McCulloh, for the plaintiffs.

J. Prescott Hall, (District Attorney,) for the defendant.

BERRS, J. In September, 1849, the plaintiffs made entry, at the Custom House at New York, of three parcels of goods imported from Trieste. The invoices were all dated at Trieste, July 10th, 1849, and the prices of the goods were stated therein in paper florins, with a discount of $18\frac{1}{2}$ *per cent.*, to bring them to specie value. The same abatement was claimed by the plaintiffs on the entry, but it was refused them at the Custom House, and the collector, on the 24th of September, 1849, exacted and received payment of duties upon the paper valuation of the invoices. The plaintiffs, at the time of payment, made on the entry the following protest, in writing: "We do hereby protest against the payment of duty on 2,939.52 florins, as per entry, claiming a discount of $18\frac{1}{2}$ *per cent.* on the paper currency, as per consul's certificate. We pay the amount exacted, to gain possession of the goods, claiming to have the difference refunded."

No consular certificates are proved to have accompanied

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the invoices, nor is it shown that the collector demanded a bond of the plaintiffs for their after production. It was proved on the trial that the invoices stated the fair market prices and value of the goods at Trieste at their date, in paper florins reduced to their specie value, and that the depreciation of the paper currency was then at the rate claimed upon the invoices and entry. It was also proved to be a frequent usage at the Custom House at New York, when an invoice was presented of Austrian goods, charged in paper currency, accompanied by a consular certificate certifying the depreciation of that currency, for the collector to separate the certificate from the invoice, as not admissible nor entitled to any consideration, because the value of the Austrian florin was fixed by law.

I think that the statement in the protest must be understood to be an averment that a proper consular certificate was presented to the collector with the invoices in this case, and that the receipt of the money of the defendants by the collector on such protest, is an implied admission by him that he was cognizant of the certificate. The language of the protest, if not deemed a direct assertion that a consular certificate accompanied the invoices, at least imports that the plaintiffs had one in their possession, or were able and offered to produce it. The instructions from the Treasury Department do not require a consular certificate to be absolutely presented with the invoice when an entry is made. The instructions of May 14th, 1831, require a certificate by a United States consul of the value of the foreign currency, but do not fix the time of its production. The Circular of October 16th, 1832, makes it necessary, in all cases when the invoice is not accompanied by the certificate, to give bond to produce it within eight months, if the goods were imported from any place on this side of the Cape of Good Hope. The injunction to furnish consular certificates in cases wherein they are necessary, is renewed with greater emphasis in the Circular of April 4th, 1840. It says, that each invoice in depreciated currency is required to be accompanied by a consular

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certificate, stating the true value of such currency in silver, &c., and that, in default thereof, bond is to be given for its production, according to the instructions of October, 1832. This is in substance repeated in the Circular of October 12th, 1849.

When the importer offers a consular certificate, and it is rejected as imperfect and not fulfilling the requirements of the President, or asserts that he will produce one, it is the duty of the collector to take a bond from him to produce one conformable to the demand of the law; and, if such bond is not exacted, it must be presumed that the collector refused to be governed by the consular certificate if exhibited. In such case, the importer ought to be exempted from the expense and delay of obtaining one, it being officially made known to him that the collector will not regard it when produced.

I consider the evidence in this case as amounting to satisfactory proof that the collector refused to make the deduction claimed upon a certificate of the consul showing it to be the true rate of depreciation, and that the plaintiffs stand on the same footing as if a consular certificate to the fact had accompanied their invoices. They are, therefore, entitled to judgment for the difference of duty paid between the silver value of the importations and the prices in paper. The amount is to be adjusted at the Custom House, if not agreed between the parties.

DUTILH & Co. vs. HUGH MAXWELL.

The doctrine of the case of *Dutilh v. Maxwell*, (*ante*, p. 541,) applied.

Where duties on an importation are fully paid, a consular certificate of depreciation in the foreign paper currency in which the invoice was made up, cannot be afterwards presented to the collector, so as to entitle the importer to recover back the duties paid on the difference between the specie value of the goods and their invoice value.

(Before BETTS, J., Southern District of New York, February, 1858.)

Dutilh v. Maxwell.

THIS was an action against the collector of the port of New York, to recover back an alleged excess of duties paid him. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts are stated in the opinion of the Court.

John S. McCulloh, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. The plaintiffs, on the 15th of February, 1851, made entry of an importation of merchandise from Trieste, and, at the same time, produced at the Custom House two invoices thereof, dated at Trieste, August 27th and 28th, 1850, in which the value of the goods was stated in the currency of Austria, and claimed the right to enter the goods at their specie value and pay duties on that only. The discount claimed for the difference was sixteen *per cent*. The collector exacted duties on the nominal or paper value stated on the invoices. This was paid under protest, on the 21st of February, 1851, and, to recover that amount, with interest from that date, the plaintiffs have brought their action against the defendant. In these respects, the case presents the same features as that of *Dutilh v. Maxwell*, (*ante*, p. 541,) decided in favor of the defendant.

There is a difference in the particularity of the protest made in this case at the time of payment, which merits notice. It is in writing, upon the entry, addressed to the defendant, and is in these terms: "The exaction of excessive duties on the depreciated currency in which our annexed invoice is made out, as the law requires, and the rate of which depreciation is stated by our invoice and entry, is hereby protested against, and the object, to recover back this and all future similar exactions from yourself and the United States, by suit or otherwise, is, at the time thereof, hereby expressly reserved, the said payments being made only to obtain possession of our goods; and we maintain that the

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fair wholesale cash value or prices of our merchandise, in the principal markets of the country of production, at the times specified by § 16, Tariff, 1842, must be ascertained, and the allowance for the depreciation of currency, as set out by our invoices and entries, be made in estimating the dutiable value of the merchandise, and in exacting the duties thereon." This is a very full and perspicuous statement of the grounds of objection to the duties demanded, but it was not supported by the production of a consular certificate at the time, nor is there any evidence that one had been presented at the Custom House, accompanying any previous importation of the plaintiffs, or that, on the occasion of this protest, one was offered or referred to by the plaintiffs. The oral testimony on the trial satisfactorily proves a large depreciation of the Austrian paper currency from the year 1848 to the time of these importations. Had such certificate been previously offered to the collector with a like protest, I think that, within the spirit of the case of *Marriott v. Brune*, (9 How. 619,) and within the reason of the Act of March 2d, 1799, the plaintiffs would have been entitled to the benefit of that evidence upon the protest in the case, more especially if, on making this entry, they had offered to furnish the certificate thereafter.

The duties were paid under this protest, on the 21st of February. On the 28th of February, seven days afterwards, another importation from the same place was entered by the plaintiffs, of similar merchandise, the invoices being dated at Trieste, November 6th and 7th, 1850, accompanied by a consular certificate showing the depreciation of the Austrian paper florin at Trieste, on the 6th of November, 1850, to have been 20½ *per cent.* The equity of the plaintiffs to the restoration of the excess of duties paid on the importation in question, was thus, by evidence supplied immediately afterwards, made most manifest, and would seem to claim consideration from the fact that the importations and entries were so nearly simultaneous, while it is to be fairly inferred that the time of exportation was also the same. The point

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for consideration on this state of facts is, whether the plaintiffs can, by means of that after evidence, now have a remedy at law for such payment, as one illegally exacted by the defendant.

It is well settled, that a payment exacted and made without a written protest is not illegal, and affords no foundation for an action by the importer against the collector to recover it back. (*Lawrence v. Caswell*, 13 How. 488.) The Supreme Court, however, in *Marriott v. Brune*, (9 How. 619,) allowed an after protest, put in whilst the moneys remained in the hands of the collector, and before the duties were closed up, to retroact and avail the importer, the same as if it had been presented at the time the duties were paid. This was for the reason that, "till the final adjustment, the money remains in the hands of the collector, and is not accounted for with the Government, and more may be necessary to be paid by the importer." That is, the advance of money by the importer, to obtain his permit or make his entry, is not regarded as a final payment, as it does not at the time go into the public treasury. But, after the duties are fully ascertained at the Custom House, and the adjusted amount is demanded by the collector and paid by the importer, the payment is regarded as "closed up," and the Court does not feel justified in embracing the case "under any existing equities." (*Id.* 636.) That is the predicament in which the present case stands. The duties were fully made up and paid on the 21st of February, and the money, on its payment to the collector, passed into the Treasury of the United States, and became public funds; (*Act of March 3d*, 1839, 5 *U. S. Stat. at Large*, 348, § 2; *Cary v. Curtis*, 3 How. 236;) and the protest cannot be made to invoke an after consular certificate to prove the payment illegal. Such certificate must have been presented at the time, or a bond have been tendered to produce it. The importer, to support an action afterwards for the recovery of the money so circumstanced, must bring himself within the requirements of the Act of February 26th, 1845, (5 *U. S.*

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Stat. at Large, 727;) and the instructions of the President, under the proviso to the 61st section of the Act of March 2d, 1799, (1 *Id.* 673,) being also a statutory appointment, prerequisite to a right of recovery, must have been equally observed and fulfilled. The plaintiffs in the present case, not having accompanied their invoice with a consular certificate, nor presented one to the collector until after the duties were closed and paid, failed to make the proofs exacted by the statute, and cannot recover back the duties paid on that entry.

Judgment for the defendant.

ERNEST FIEDLER *vs.* HUGH MAXWELL.

Where an invoice sets forth the prices of goods in a foreign paper currency, and also carries them out reduced to a specie standard, and the importer makes the entry in the specie value, and, on appraisement, the value is returned at the invoice paper currency prices, which is greater by 10 *per cent.* than the specie value—*It seems*, this is not such an excess of appraised value over the value declared in the entry as to warrant the imposition of a penalty of 20 *per cent.* for undervaluation.

Trover will lie against a collector who unlawfully detains the goods of an importer, and it is no defence that the collector acts under the instructions of the Secretary of the Treasury.

(Before BERR, J., Southern District of New York, February, 1853.)

THIS was an action of trover against the collector of the port of New York, for the conversion of certain merchandise imported by the plaintiff. The merchandise in question was invoiced at Trieste and imported thence. The invoices, two in number, set forth the prices of the goods in Austrian paper florins, and carried them out reduced to the specie standard. The entry on both invoices was made in specie value only. The invoice charges were raised by the appraisers, or rather confined to the nominal value stated in paper currency, and

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the Custom House appraisers, and also merchant appraisers on a re-appraisement, returned the goods to have been charged at proper prices in that currency. The plaintiff made his entry at the specie value of the importations, and, this being more than 10 *per cent.* below the paper denomination, a duty was charged on the difference, and also a penal duty of 20 *per cent.* The invoices on entry were accompanied by the certificate of the American consul at Trieste, that the paper currency at the time was depreciated 17½ *per cent.* Oral proof of the same fact was given before the jury on the trial, and it was not controverted by the defendant. The plaintiff made due protest in writing against the exaction of the additional and penal duties, tendered to the collector in specie the legal duties, and demanded the delivery of his goods. This being refused, he brought an action of trover against the collector in the Supreme Court of the State, and the cause was removed by the defendant, by *certiorari*, into this Court. On the trial, a verdict was taken by consent for \$901, subject to adjustment at the Custom House and to the opinion of the Court on a case to be made.

John S. McCulloh, for the plaintiff.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. This case embraces several questions which have been passed upon by this Court. The law thus settled must be considered as the law governing the subject, until it is changed by the Supreme Court or by Congress. The plaintiff was entitled to enter his goods at the specie value of the Austrian florin, on payment of the legal duties chargeable upon that amount. (*Grant v. Maxwell*, *ante*, p. 220.) The defendant, therefore, had no authority in law to impose duties on any other valuation.

It is exceedingly doubtful whether, if these goods had been subject to duty on a paper valuation, the collector

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could have also imposed a penal duty because of a difference of more than 10 *per cent.* between silver and paper currency. This could hardly, in any reasonable acceptance, be considered an excess of appraised value over the value declared in the entry; because, the invoice accompanies the entry, and the transcription of the summation of its charges into the entry does not, without the presentation of the invoice, constitute the proceeding known to the law or in practice as an entry made. Under such circumstances, when the valuation insisted upon by the Government and that claimed by the importer are both of them on the face of the invoice, placing the latter alone upon the scrip called the entry, could not, except under the severest interpretation of the language of the Act, subject the goods to a penal duty.

Be that as it may, it is clear, upon the main point, that the plaintiff was entitled to enter his importations at their specie value in the Austrian market.

The only point not covered by previous decisions of this Court relates to the form of the action. There are two cases decided by the Supreme Court, (*Conard v. The Pacific Ins. Co.*, 6 *Peters*, 262, and *Tracy v. Swartwout*, 10 *Peters*, 80,) which recognize it as a clear principle of law, that an importer can maintain trespass or trover against a United States officer for the detention of his goods on the ground that they are subject to a lien on behalf of the Government, if no such lien is given by law. A collector of the customs cannot defend himself against such an action by showing that he acted under the instructions of the Secretary of the Treasury in enforcing the payment of duties or obtaining due security therefor. If his acts are not warranted by law, the owner of the goods can assert his right by an action of trover, and will be entitled to full remuneration for the injury done him.

Judgment must be rendered for the plaintiff upon the verdict, according to the stipulation in the case, with costs.

WILLIAM B. REYNOLDS AND PATRICK GRANT

vs.

HUGH MAXWELL.

Where two entries on importations from the same Austrian port were made, not much over one month apart, and the goods were valued in the invoices, in both cases, in a depreciated paper currency, and a deduction was claimed in both cases on that account, a proper consular certificate having been presented to the collector in the first case, and rejected on the ground that no allowance for depreciation could be made, and there being a proper written protest in the second case: *Held* that, although the importer presented no consular certificate with his entry in the second case, he was entitled, in that case, to a deduction of the rate of depreciation stated in the certificate in the first case.

(Before BETTS, J., Southern District of New York, February, 1853.)

THIS was an action against the collector of the port of New York, to recover back an alleged excess of duties paid him. The facts are stated in the opinion of the Court.

John S. McCulloh, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. In this case, a verdict was rendered for the plaintiffs, by consent of parties, subject to the opinion of the Court and to correction and adjustment at the Custom House.

The plaintiffs made two importations of wool into New York, from Trieste, one by the ship *Antoinette Maria*, the entry of which was made on the 5th of March, 1851. The invoice was dated at Trieste, November 14th, 1850, and a deduction of 23 *per cent.* was claimed from the valuation stated in paper currency. A certificate of the United States consul at Trieste was attached to the invoice, certifying that the *agio* on silver at Trieste, on the 14th of November, 1850, was 23 *per cent.* Duties were exacted by the defendant on the

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invoice amount, and, on the 6th of March, 1851, they were paid by the plaintiffs under a written protest claiming the deduction of 23 *per cent.* to bring the goods to actual cost. On the 15th of April, 1851, the other entry was made, of an importation from the same port by the brig Smyrna. The invoice was dated at Trieste, January 23d, 1851, and the price of the wool was charged in paper florins. The plaintiffs claimed to enter the goods at the silver value of the florin, but presented no consular certificate with their invoice. The defendant exacted duties upon the paper valuation, and that amount was paid, April 17th, 1851, under the following protest: "We hereby protest against the payment of duties on the foregoing entry, calculated at paper florins, claiming the true value is expressed in the invoice in silver florins, and we pay the excess of duties to get possession of the goods." It was proved on the trial, by a witness acquainted with the Austrian currency, that the paper currency in Austria, on the 23d of January, 1851, exceeded the specie value 24 *per cent.*

The entry by the Antoinetta Maria was directly within the principle recognized by this Court in recent cases, and the plaintiffs are entitled to recover the excess of duties paid on that importation, with interest from the time of payment. To bring the importation by the Smyrna within the same rules, it must appear that the entry or payment was made under circumstances giving the plaintiffs the advantage of the consular certificate which accompanied the previous invoice and entry. It is to be observed that, although the two entries were not exactly coincident in time, yet the interval between them was not much over one month, and, the protests having relation to importations from the same port, and the consular certificate from that port, having been presented without avail in the first case, it may fairly be presumed that the collector acted, as to the second entry, with full knowledge of that certificate, and refused to allow the plaintiffs the benefit of it. Moreover, it was proved before the jury that it is a common occurrence, in making entries at the Custom House, when a consular certificate accompanies an in-

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voice of Austrian goods, for the collector to tear it off and give it back to the importer as useless, as, under the instructions of the Treasury Department, he regards the value of the Austrian florin as being fixed by statute at 48½ cents, and takes no notice of evidence proving a depreciation below that. I think that, upon this evidence, the jury would have been well warranted in finding that the duties were, in the case of the Smyrna, exacted by the collector upon the paper value of the goods, with knowledge of the consular certificate which accompanied the importation immediately preceding, and with a full understanding between him and the plaintiffs that they would not be allowed a deduction from the paper valuation stated in the entry, upon that or any other description of proof.

The verdict being taken for the plaintiffs by consent of parties, subject to the opinion of the Court upon the law of the case, I shall hold, upon the evidence, that the collector was bound to have taken cognizance under the protest in this case, of the consular certificate on file with the previous importation, and to have demanded a bond for the production of a later one, if that was not satisfactory as to the true rate of depreciation at the time of the purchase.

The plaintiffs proved the depreciation of the paper florin to have been 24 *per cent.* at Trieste at the date of the invoice, but, in my opinion, the collector is only chargeable with the rate certified by the consul. The plaintiffs are, therefore, entitled to recover, with interest, the duties paid on the difference between the paper and silver value of the invoice and entry rated at 23 *per cent.*, and also costs of suit.

JOSEPH W. ALSOP, JR., AND HENRY CHAUNCEY

vs.

HUGH MAXWELL.

The doctrine of the case of *Dutilh v. Maxwell*, (*ante*, p. 541,) applied to importations from Chili, Peru and Bolivia.

(Before BETTS, J., Southern District of New York, February, 1853.)

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THIS was an action against the collector of the port of New York, to recover back an alleged excess of duties paid him. A verdict was taken for the plaintiffs, subject to the opinion of the Court. The facts are stated in the opinion of the Court.

John S. McCulloh, for the plaintiffs.

J. Prescott Hall, (*District Attorney*), for the defendant.

BETTS, J. The plaintiffs, in May, September and November, 1851, made four several entries, at the Custom House in New York, of merchandise imported from Valparaiso and Coquimbo, in Chili, and invoiced at those ports in the months of January, February, May and June, 1851, made up in the paper currency of the country. Each invoice was accompanied by a consular certificate stating the specie value of the currency in which the invoice prices were exhibited. The collector exacted duties upon the nominal value of the merchandise, which was paid by the plaintiffs under written protests against the legality of the demand. The plaintiffs also proved, on the trial before the jury, that the currency was debased or depreciated to the amount of the reduction demanded on the entries.

It is unnecessary to detail the reasoning in support of the justness of this claim. It is sufficiently set forth in several cases recently decided by this Court. I find, also, that the Circuit Court in Massachusetts coincides with these principles. I have been furnished with an opinion given by Mr. Justice Curtis, in that Court, in October last, in which he holds the collector responsible to an importer for an excess of duties exacted on goods imported from Chili, on facts very analogous to those proved in the present case.

Judgment is, therefore, rendered for the plaintiffs, with costs.*

* In the case of *Theodore W. Riley v. Hugh Maxwell*, decided at the same time, the same doctrine was applied to importations from Peru and Bolivia, and to invoices made up in the depreciated paper currency of those countries.

APPENDIX.

I.

[The following charge was delivered to the Grand Jury, at the October Term, 1851, of the Circuit Court of the United States for the Northern District of New York, by Mr. Justice NELSON.]

THE FUGITIVE SLAVE LAW.

So far as it respects an obstruction to the execution of legal process, or a forcible rescue of a fugitive from service, under the Act of September 18th, 1850, (9 *U. S. Stat. at Large*, 463,) commonly called "The Fugitive Slave Law," the provisions of that Act probably supersede those of the Act of April 30th, 1790, (1 *U. S. Stat. at Large*, 112,) with one exception.

The provision in the 23d section of the Act of 1790, for the case of assaulting, beating or wounding any Federal officer, or other person duly authorised, while engaged in serving or executing any process, may apply as well to the execution of process under the Act of 1850 as under any other Act, the case not being specifically provided for in the Act of 1850, and there being no necessary repugnancy between the two Acts in this respect.

There is some doubt whether a Circuit Court has jurisdiction of the offences named in the 7th section of the Act of 1850, as that Act in terms limits cognizance of those offences to the District Courts.

It may be a question whether the provision of the 11th section of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 73,) conferring on the Circuit Court concurrent jurisdiction with the District Court of all crimes and offences cognisable therein, applies to jurisdiction subsequently conferred on the District Court in as specific terms as that conferred by the Act of 1850.

The provision of the 2d section of the Act of August 8th, 1846, (9 *U. S. Stat. at Large*, 72,) by which the District Court is authorised to remit to the Circuit Court any indictment pending in the District Court, no doubt embraces the cases specified in the 7th section of the Act of 1850.

The consequences of forcible resistance and obstruction to the execution of the Act of 1850, considered.

At the commencement of the term, Mr. Justice NELSON, in charging the Grand Jury, after instructing them upon the law applicable to the several cases that were to come before them, proceeded as follows :

The District Attorney has called my attention to a crime recently committed in one of the most populous towns in the Western part of this State—the case of the seizure and rescue of a fugitive slave out of the hands of a Federal

officer, by an unlawful assemblage of people, more or less armed, pending an examination before a magistrate in pursuance of an Act of Congress passed September 18th, 1850, (9 *U. S. Stat. at Large*, 462.) The crime, as alleged, was committed in the edge of the evening, in the midst of the local police and municipal authorities of a city of intelligence and character; and this, after threats and other unmistakable evidences of an intended rescue and crime had been given out. The marshal, and all the authorities associated with him, and other persons coming to his aid and assistance, were overborne by the violence of the mob, and law and legal authority were trampled under foot. The case is one calling for grave and serious inquiry on the part of the public authorities. Neither time nor expense should be regarded in the investigation of the crime, and in bringing the guilty offenders to justice. In a case so serious, striking at the very foundation of a Government of laws, and substituting in its place brute force and anarchy, the whole power of the Government should be put into requisition to suppress the spirit of disorder and punish the guilty. No Government is worth preserving that does not or cannot enforce obedience to its laws.

The 7th section of the Act of 1850 makes it a misdemeanor, subject to fine and imprisonment—the fine not to exceed \$1,000, and the imprisonment not to exceed six months—for any person knowingly to obstruct the arrest of a fugitive from service, or for any person to rescue or attempt to rescue the fugitive after the arrest is made, or to aid or abet or assist, directly or indirectly, in an escape or rescue. The punishment, according to this Act, is by indictment and conviction before the District Court of the United States for the District within which the offence is committed.

The 22d section of the Act of Congress passed April 30th, 1790, (1 *U. S. Stat. at Large*, 117,) also provides for the case of the obstruction of legal process in the hands of an officer of the Federal Government. The offence is punishable by a fine not exceeding \$300, and imprisonment not exceeding twelve months. So far as it respects an obstruction to the execution of legal process, or a forcible rescue of the prisoner, under the Fugitive Slave Act, the provisions of that Act probably supersede those of the Act of 1790, with one exception. The Act of 1790 provides for the case of assaulting, beating or wounding any Federal officer or other person duly authorized, while engaged in serving or executing any process. This case is not specifically provided for in the Act of 1850, and may apply as well to an execution of process under that Act as under any other Act, there being no necessary repugnancy between the Acts in this respect.

There is some doubt as to whether the Circuit Court of the United States has jurisdiction of an offence committed under this Act of 1850, as the Act in terms limits the cognizance of the offence to the District Court. I have, therefore, advised the District Attorney to present the cases before that Court. The 11th section of the Judiciary Act of 1789, (1 *U. S. Stat. at Large*, 78,) confers on the Circuit Court concurrent jurisdiction with the District Court of all crimes and offences cognizable therein. But it may be a question whether this provision applies to jurisdiction subsequently conferred on the District Court as specifically as that conferred by the Act of 1850. There is a provision in a recent Act of Congress, by which the District Court is authorized to adjourn or continue criminal cases pending therein to the Circuit Court, which, no doubt,

embraces the cases in question. (*Act of August 8th, 1846, 9 U. S. Stat. at Large, 72, § 2.*)

The forcible resistance to and obstruction of the law to which I have referred, involve something more than the simple defeat of the execution of an Act of Congress. The Act of 1850 was passed to carry into effect an important provision of the Constitution of the United States, which declares that "no person held to service or labor in one State, under the laws thereof, escaping into another, shall, in consequence of any law or regulation therein, be discharged from such service or labor, but shall be delivered up on claim of the party to whom such service or labor may be due."

The State of New York, in full Convention assembled, ratified and adopted the Constitution of which this provision is a part, on the 26th of July, 1788, when she entered into the Union, and thereby pledged the faith and honor of the people of the State to the observance and fulfilment of all its provisions and injunctions, and of all laws enacted by Congress in pursuance thereof. The faith and honor of the State are involved, therefore, in the discharge of these duties and obligations, and, while these virtues are acknowledged by the people of the State, the Constitution will be revered and obeyed, and, so far as she is concerned, the Union will be cherished and preserved. It is not to be believed that, in the comparatively short period, in the being of a nation, of sixty-three years, her sons have so far degenerated as to become recreant to the obligations of the Government formed by their fathers and cemented by their blood, and under which they have enjoyed a degree of freedom and prosperity, and a share of all the social blessings flowing therefrom, that never before fell to the lot of the human race. Nor is it to be doubted that, when it is seen that there is a sentiment of treasonable opposition, in some parts of the State, against the Government, organized and breaking out into open acts of resistance to the Constitution and laws, they will awake to the danger, and put down, with a strong hand, this spirit of disunion, and vindicate the faith and honor of their fathers and the character of their State.

The question, whether this provision of the Constitution is to be carried into execution in the spirit in which it was adopted, is not one that concerns New York alone. If that were all, the question could be settled among ourselves. But other States have an interest—fifteen of them, a deep and abiding interest—in its observance. The compact has been made with them and with their people, and, until they consent to release us from it, we are bound by it, by every faith and tie that can give sanction to an obligation. It is true, New York may possess the physical power to disregard her obligation, and set the Constitution at naught, and abide the consequences. There are, I am sorry to say, Acts upon her statute-books which, if carried out into practical effect, would have already accomplished it. But they have not been carried into effect, and I trust never will be. They are, fortunately, a dead letter. Before the people of New York, or of any other Northern State, make up their minds to disregard and disobey this provision of the Constitution, they will, I doubt not, look well to the consequences. Common sense, as well as common prudence and wisdom, would dictate this.

As I have already said, the provision in question is a material part of the Constitution—the fundamental law of the Union, framed by our fathers, and

under which we live—so material and important, that any one conversant with the history of that instrument knows that without it the Union would never have been formed. Let any one or more of the Northern States, therefore, annul or utterly disregard it, setting the fundamental law, in this respect, at defiance, and be successful in maintaining such disregard and abandonment of duty, against the whole force and power of the general Government, and a disruption of the Union is already accomplished. One or more members of the Confederacy cannot annul a material part of the compact which they have entered into with the other States, because they have no interest in it, or even if it be against their interest, and, at the same time, claim an observance of the compact by others. There can be no such obligation on those others, legal or moral. It requires but common sense, and common honesty, to settle this. That other State or those other States, interested in the rejected and repudiated part, after an unavailing effort by the constituted authorities of the Union to enforce obedience, would have a right to regard the compact as at an end, and to withdraw from a Confederacy of faithless associates. There are two sides to the compact, and both must be observed, or neither.

These principles are fundamental. They lie at the foundation of all contracts and compacts entered into by parties, whether for government or any other purpose; and they exact nothing more than common honesty and good faith, in the observance of the duties and obligations of each.

Seeing, therefore, and properly appreciating these consequences, as the inevitable tendency and result of breaking and setting at naught a material part of the Constitution, with what concern should every good citizen contemplate the act, and with what alacrity and spirit should he come up to its support and maintenance! What vast and momentous interests may depend upon his active and patriotic devotion in defence of the Constitution and laws of his country!

No one need for a moment harbor the supposition or belief that the Northern States will not be held to a strict fulfilment of their constitutional obligations arising out of this clause of the compact. The people of fifteen States of the Union are deeply interested in its execution, and demand its observance. They have already determined that it must no longer be disregarded, and have appealed to their Northern brethren to come up to their constitutional duties and obligations and save the Union. Many of them have confidence that they will, and are at this moment, upon the strength of that confidence, maintaining a vigorous and manful struggle with their less confident brethren, in behalf of the Union. It requires but an honest and faithful discharge of these duties and obligations by the North, to cheer them on and crown their patriotic efforts with success. Let the great State of New York, therefore, not falter in her duty, nor prove recreant to her obligations, at this time and in this struggle. No State has a greater stake in the preservation of the Union; nor is there any one whose voice, for good or for evil, will be more powerfully felt throughout its limits.

Disorderly and turbulent men—the common disturbers of society—are found in every Government; and occasional outbreaks against law and legal authority must be expected. They scarcely compromise the character of a people, when the violence is speedily suppressed and the guilty offenders are sternly pun-

ished. New York may thus redeem herself from the odium of suffering the Constitution and laws of the Union to be trampled under foot, and from a just responsibility to the other members of the Confederacy. She will thus vindicate herself from the bad example of having broken the compact; and other States will not, so far as her action is concerned, be released from their obligations. But, should she falter in this duty, and in redeeming her own plighted faith to the Constitution, how can she expect to preserve the Union, or, that other States, deeply concerned in the observance of her obligations, will remain with her in the Confederacy? It would be vain to expect it; and her conduct, in the case supposed, will have rendered her powerless in any attempt to coerce the association. Having broken the compact herself, and cast off her constitutional obligations, she will have rendered herself morally impotent to exact fidelity from others.

Any one conversant with the history of the times, and with the great issue now agitating the country, and in which the perpetuity of this Union is involved, cannot fail to have seen that the result is in the hands of the people of the Northern States. They must determine it, and the responsibility rests upon them. If they abide by the Constitution—the whole and every part of it—all will be well. If they expect the Union to be saved, and to enjoy the blessings flowing from it, short of this, they will find themselves mistaken when it is too late.

II.

[The following proceedings took place in the Circuit Court of the United States for the Southern District of New York, at the City of New York, on the 25th of October, 1852.]

THE DEATH OF DANIEL WEBSTER.

At the opening of the Court, Mr. J. Prescott Hall, United States District Attorney, addressed the Court (held by Judge BETTS) as follows:

May it please your Honor: Since the last adjournment of this Court, the intelligence, sad but not unexpected, has reached us, that DANIEL WEBSTER is no more. He died yesterday morning, in the full possession of all his mental powers, exhibiting in his death, as he had always exhibited in life, the entire superiority of his mind over all corporeal attributes. When we consider his greatness as a man, his public services, his glowing patriotism, his political distinction, his official station, his matchless eloquence, and, as lawyers, his professional eminence, which placed him, beyond dispute and without doubt, at the very head of the American bar, it seems fit that the occasion of his death should not be suffered by this tribunal to pass by without some special notice of the event, and some evidence to endure, upon its records, of the high consideration with which he was here regarded.

I rise not, sir, to pronounce an eulogium upon this great man. "The world knows that by heart;" and a nation's tears are at this moment poured out upon the bier where he lies in the solemnity, the repose and the majesty of his death. He died, sir, as we all could have wished him to die, when the inevitable hour should come—his profound intellect clear, serene and unclouded, triumphing over all the infirmities of physical decay, and relying upon those religious consolations which are the only solace in the dread hour of mortal dissolution.

I knew Mr. WEBSTER well. I had the honor of his acquaintance, and hope it is not too much to say, of his friendship, for more than a quarter of a century. It was his counsel and advice which led me to this great city, where I met with professional encouragement far beyond my deserts. I have seen him under every variety of circumstances—in the secluded hours of consultation, where his client's interests seemed to absorb all his remarkable power of attention. I have seen him in the midst of his family circle, dispensing and enjoying a genial hospitality. I have partaken of his innocent and manly amusements. I have walked with him alone, at twilight, upon the shore of the "far-resounding sea." I have seen him in the forum and in the Senate-chamber—his gigantic intellect towering above all his compeers. And, under no circumstances nor on any occasion did I ever know him to forget his own dignity, or cease to impress, if not overwhelm, with the sense of his surpassing greatness. From his lips I have never heard an irreverent, a profane or an unseemly expression; while his playful wit, his deep philosophy, his varied acquirements and unrivalled powers of conversation are among the richest treasures of my recollection.

He has gone down to the grave full of years and full of honors. His voice will no longer be heard in the Court-room or in the halls of legislative debate; but his example still remains, and his fame, undying and wide-spread as the world, will be cherished among the chief treasures of his country. His sun is set, but it leaves behind that long and luminous track which shows what glorious orb it is that has descended beyond the horizon. The philosopher, the patriot, the "great man eloquent," has gone to "his recompense of reward," and there remains not upon the whole earth another intellect to supply his place.

I move you, sir, in consideration of our professional loss and the national bereavement, that this Court do now adjourn, and that the cause of its adjournment be entered upon its records, in perpetual remembrance of the sad event.

Judge BETTS replied, in substance: It has not been the usage with this Court, or the Presiding Officer, on occasions like the present, to accompany the acceptance of motions of this character with extended observations on his part. I trust, however, that a long and intimate acquaintance, in professional, legislative and private life, with the eminent subject of the eulogy pronounced so feelingly and eloquently by the United States Attorney, will render it not inappropriate for me to add the expression of my deep sympathy in this great bereavement, and join my individual testimonial with that of this assemblage of the friends and associates of the deceased, to his surpassing gifts as a jurist,

statesman, orator, scholar, companion and friend. These proceedings at this place, although not within the special sphere of Mr. WEBSTER's professional and public life, seem to be eminently appropriate, not only because this tribunal was frequently the field on which were displayed his commanding eloquence and juridical powers, but especially because his highest distinctions at the bar were those of a national lawyer and an expounder of the Constitution of the country. I accept the motion of the United States Attorney, and direct that the testimonial of this meeting to the talents and character of Mr. WEBSTER be recorded upon the minutes of the Court; and, in further respect to his memory, it is ordered that judicial business be suspended for the day, and that the Court now adjourn.

III.

[The following proceedings took place in the Circuit Court of the United States for the Northern District of New York, at Albany, on the 25th of October, 1852.]

THE DEATH OF DANIEL WEBSTER.

At the opening of the Court, Samuel Stevens, Esq., addressed the Court (held by Mr. Justice NELSON and Judge HALL) as follows:

May it please the Court: Since the adjournment of this Court on Saturday evening, a member of our profession, who, as a jurist, had no superior in profound wisdom, deep and varied learning, and clear, forcible and convincing eloquence, in this or any other country, and who, as a statesman, justly occupied the highest position in the councils of this nation, and the largest space in the confidence and affections of the people of the United States, has departed this life. DANIEL WEBSTER died at Marshfield, a few minutes before 3 o'clock, yesterday morning.

The present year has been singularly fraught with melancholy events both in this country and in England. Scarcely three months had elapsed since the nation was called upon to deplore and lament the death of Henry Clay. It is no injustice to others to say, that those two great men, for the last forty years, have acted the most important parts in the councils of this nation; and that, to their patriotism and their wisdom this country is deeply indebted for the stability of its Government and institutions, and for the unexampled prosperity and happiness of its people. England, too, during this year, has been called upon to mourn the loss of two of her most distinguished sons—Sir Robert Peel and the Duke of Wellington.

It is some consolation to us, while we most deeply deplore the loss of our two great statesmen and jurists, that they were called to their last rest full of years, possessing the entire confidence and deep affection of the people of the United States, and with well and faithfully-earned honors thickly clustering around them.

As an evidence of our heartfelt appreciation of the great loss which our profession and our country have sustained in the death of Mr. WEBSTER, and as a mark of our never-dying respect for his worth and memory, I move that this Court do now adjourn.

Mr. Justice NELSON responded as follows: The Court readily acquiesce in the propriety of this motion. The long and eminent life of Mr. WEBSTER in the profession, and in the public councils of the nation, well entitles his memory to this mark of respect from his professional brethren and the Court. It is not too much to say that, in our profession, which he loved, he had no superior in this or any other country.

We shall direct the adjournment of the Court, agreeably to the request of the bar, and that the proceedings be entered upon the minutes.

Judge HALL said: I am well aware that, on ordinary occasions of this character, it would be most appropriate for me to remain silent and leave to the Presiding Judge the expression of the sentiments and sympathies of the Court. But, having been so recently the personal associate and official colleague of Mr. WEBSTER, I cannot refrain from declaring my concurrence in the sentiments already expressed, as well as my deep sympathy with those who feel most keenly the afflicting dispensation which has taken from us one whose genius and intellect and eloquence and learning eminently entitled him to rank, by common consent, as the profoundest American lawyer and the ablest American statesman.

IV.

RULES.

[The following Rules have been adopted since January 29th, 1851, in the Circuit Court for the Southern District of New York.]

JANUARY 27th, 1853.

ORDERED, that all and each of the Commissioners appointed by this Court, by order or rule entered January 20th, 1851, to take affidavits in civil causes depending in the Courts of the United States, &c., be and the said Commissioners are hereby appointed and authorized to act as Commissioners, and each of them is hereby appointed and authorized to act as a Commissioner, under the provisions of the Act of Congress entitled "An Act for giving effect to certain treaty stipulations between this and foreign Governments for the apprehension and delivering up of certain offenders," approved August 12th, 1848.

MAY 7th, 1853.

ORDERED, as a standing rule of this Court, that the Clerk issue a *venire* to the Marshal, for a Grand Jury to be in attendance at the commencement of each regular term of this Court.

[The following Rules have been adopted since October 22d, 1850, in the Circuit Court for the Northern District of New York.]

AUGUST 15th, 1855.

ORDERED, that the Clerk of this Court be, and he is hereby vested with general power to name Commissioners, in commissions to be issued to take testimony, in like manner that the Court or a Judge thereof can now do by the 67th Equity rule prescribed by the Supreme Court of the United States.

JULY 1st, 1858.

IT IS HEREBY ORDERED, that the rule formerly adopted by the District Court of this District, while having Circuit Court powers, and which afterwards became and was made a rule of this Court, under which the First Judge of the County Courts and the Clerks of the several Counties in this District were made or appointed Commissioners, and authorized to discharge certain duties conferred by Acts of Congress upon Commissioners appointed by the Circuit Courts of the United States, shall be and the same is hereby repealed, annulled and vacated, and that such officers and persons shall no longer be *ex-officio* Commissioners under the said Acts of Congress, by appointment of this Court, or of the said District Court whilst exercising the powers and authority of a Circuit Court.

[The following Rule has been adopted in the Circuit Court for the District of Connecticut.]

APRIL TERM, 1857.

THE parties shall be allowed to examine their witnesses and exhibit their proofs in open Court, at the hearing of the cause, in the same manner as on the trial of actions at common law. Provision shall be made by the party or parties so examining the witnesses in Court, for taking down the testimony of such witnesses, and placing a transcript thereof on file, in all appealable causes.



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ADMIRALTY.

1. Where an action *in personam* is brought in the District Court, in

Admiralty, on a money demand amounting to less than \$50, but the libellant's claim, with interest, amounts to more than \$50 at the time the decree is made by the District Court, and he has a decree in that Court for more than \$50, an appeal lies to this Court from such decree. *Godfrey v. Gilmartin*, 340

2. On such appeal, the action becomes a plenary suit in this Court, and, if the decree is affirmed by this Court with costs, full costs of this Court may be taxed. *id.*

3. A surety in a stipulation given on the release from attachment of the property of a respondent in a suit in Admiralty *in personam*, in the District Court, cannot, where the stipulation is in a sum certain, be compelled, as surety, to pay more than that sum, although the stipulation is conditioned to pay such sum as shall be awarded to the libellant by the final decree in the suit. *Brown v. Burrows*, 340

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1. A plaintiff, in moving for an attachment against a defendant for contempt of Court in not obeying an injunction, must state, in the proofs on which the application is founded, the specific acts of omission or commission which constitute the alleged contempt. *Parkhurst v. Kinman*,

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2. When, in such a proceeding, the defendant is ordered to answer interrogatories to be filed, such interrogatories must be limited to the particular offences so alleged, and must not inquire in regard to matters not charged specifically in such proofs. *id.*

3. Nor can the plaintiff require the defendant to answer interrogatories as to particulars which are charged on information and belief, and are not established by direct evidence. *id.*

4. Interrogatories which were unauthorized having been demurred to by the defendant, and he having answered, taking issue upon others: *Held*, that he was entitled to recover his costs on the demurrer, but the enforcement of the costs was stayed until the issues on the interrogatories answered should be disposed of. *id.*

5. *Held*, also, that the proper mode of proof on such issues was by testimony taken orally before a Master. *id.*

6. The 30th section of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 88,) gives authority to this Court to compel witnesses to attend before a Commissioner for examination *de bene esse*, in the same manner as to compel them to appear and testify in Court. And, upon due proof of service of a subpoena upon a witness, requiring his attendance before a Commissioner, and the certificate of the Commissioner that the witness did not attend before him, it is proper that an attachment should issue against the witness. *Ex parte Humphrey*, 228

7. But that statute does not apply to a witness who is casually absent from home, although he is found at a place more than one hundred miles from the place of trial of the cause, unless he is about going to sea, or is aged, infirm, &c. *id.*

8. Where an attachment is issued against such a witness, the question of the authority of the Commissioner

and of the regularity of the proceedings before him, is properly brought before the Court by affidavit. *id.*

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BILL OF LADING.

1. Where a bill of lading of bales of cotton describes them as "in good order and well-conditioned," those words have reference to the external condition of the cotton, and import that it was in good shipping condition at the time it was received on

board of the vessel, but do not warrant the internal condition of the cotton in the bales. *Bradstreet v. Heran*, 116

2. Where cotton in bales was shipped at New Orleans for New York, and the master of the vessel gave a bill of lading for the cotton as "in good order and well-conditioned" when received on board the vessel, and it was in bad shipping condition when it arrived at New York, a large part of the bales being old and rotten, and badly torn and damaged, and the cotton being consequently soiled and damaged by exposure, and it appeared that the effects of this damage upon the external state of the cotton were developed at New Orleans before it was shipped: *Held*, on a libel *in personam*, in Admiralty, by the master against the consignees of the cotton, to recover the freight, that, as the damage to the cotton exceeded the freight, the libel must be dismissed. *id.*

3. *Held*, also, that as the consignees had made large advances upon the cotton on the faith of the representation in the bill of lading, that it was shipped "in good order," their security, as *bond-fide* purchasers, ought not to be lessened or impaired by permitting the master to contradict that representation. *id.*

4. *Held*, also, that although the cotton might have been sold for an excess beyond the advances, sufficient to cover the freight, the consignees were entitled to it in the condition described in the bill of lading, as security for their advances, without regard to the fluctuations of the market, or to sales to be made at any particular state of it. *id.*

See CARRIER, 3, 4, 6.

BILL OF SALE.

See LIEN, 2, 3.

BILLS OF EXCHANGE.

1. J., for the accommodation of M., accepted a draft drawn by M., paya-

ble to his own order. In a suit against J. on the draft, brought by P., to whom M. transferred it before due, J. set up that his acceptance was obtained by fraud: *Held*, that a receipt signed by M., expressing a consideration for the transfer of the acceptance to P., was not competent evidence against J. to prove the payment of value by P. for the acceptance. *Platt v. Jerome*, 186

2. Before the draft was passed to P., it was put by M. into the hands of one B., to negotiate. B. inquired of J. as to the draft, who said it was a business draft and would be paid at maturity. Afterwards, and before taking the draft, P. applied to B. to know what J. had said about the draft, and was told, and then took the draft: *Held*, that P. could not be in any more favorable position, as regarded the inquiries he made of B., than if he had made them of J. himself, in which case he would have been bound to disclose to J. any knowledge he had that J. had been defrauded in giving the acceptance. *id.*
3. *Held* further, that if P., when he applied to B., knew that J. had been defrauded in giving the acceptance, such knowledge would affect his title to the draft. *id.*

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CARRIER.

1. Where a passenger accompanies his baggage, the fare charged for his passage includes compensation for its transportation, and the carrier becomes responsible for its safe delivery. *The Elvira Harbeck*, 386
2. If a passenger does not accompany his baggage, the carrier may claim compensation in advance for its transportation, or may postpone his claim till the delivery, and rely on his lien or on the personal responsibility of the owner; in either of which cases, the carrier is responsible for the safe-keeping and delivery of the baggage. *id.*
3. Where a person took passage in a vessel, but his personal baggage did not reach him in season to be put on board of that vessel, and he sailed without it, and it was put on board of another vessel, a receipt or bill of lading being given for it by the mate of the latter vessel, but it was never delivered at its port of destination: *Held*, in an action *in rem* brought against the latter vessel for the value of the baggage, that the case was one of the ordinary shipment of goods on freight, for whose safe delivery the vessel was liable, and that her owner was not to be regarded merely as a gratuitous bailee, responsible only for gross negligence. *id.*
4. *Held*, also, that the words "personal goods" on the margin of the receipt or bill of lading, were at most but a description of the character of the goods, and did not exempt the owner of the goods from freight, or the vessel from responsibility. *id.*
5. Where goods in cases are shipped by sea, and, on being opened, after delivery, are found to be injured, it will, in an action by the owner of

the goods against the carrier, to recover damages for the injury, be presumed that they were properly packed, in a fit state for transportation, by the manufacturer or shipper, unless there is something in their appearance or condition to afford ground for a contrary inference, or unless some evidence to that effect is given. *English v. The Ocean Steam Navigation Co.*, 425

6. And this will be the presumption, although the bill of lading contains the clause, "weight, contents and value unknown." *id.*

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1. In an action against a collector of

the customs, to recover the value of goods lost while on deposit in a Custom-House warehouse, under the provisions of the Act of August 6th, 1846, (9 *U. S. Stat. at Large*, 53,) no recovery can be had unless it appears that the defendant was guilty of actual personal negligence in regard to the safe-keeping of the goods, and that, in consequence of such personal negligence, they were lost. *Brisac v. Lawrence*, 121

2. Such negligence in the collector cannot be inferred from the mere loss of the goods. Whether such inference would be proper in an action against the store-keeper who had charge of the goods, *quere. id.*
3. The collector is not personally responsible for the negligence of his subordinates in the Custom-House Department. *id.*
4. The rule stated, as to the responsibility of a collector for losses occurring through defects in the regulations established by the Treasury Department for the transaction of the business of the customs. *id.*
5. The fact that the book-keeper in the warehouse was intoxicated daily, is not enough to render the collector liable for a loss of goods stored in the warehouse, but it must be shown that the goods were lost from that particular cause. *id.*

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1. Whether a libellant, in Admiralty, is entitled to damages, in a case of collision, for the delay and loss of trips while his vessel is undergoing the necessary repairs, *quere. The Rhode Island*, 113
2. There is no settled rule as to whether anything should be allowed, or as to

the measure by which the allowance, if any, should be determined. *id.*

3. In a case where no vessel was hired to supply the place of the libellant's vessel, and the District Court allowed to the libellant interest, at the rate of six *per cent. per annum*, upon the value of his vessel before the collision, for the interval after the collision until she was repaired and fitted to resume her trips, the allowance was upheld against an appeal by both parties, not as being founded on any established principle, but as being just in the particular case and as high a measure of damages as was warranted. *id.*

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COPYRIGHT.

1. To constitute a person an *author* under the copyright Act of February 3d, 1831, (4 *U. S. Stat. at Large*, 436,) he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself. *Atwill v. Ferrell*, 39
2. He may arrange or compile a new production from materials before known, or obtained for him by the labors of others, but he cannot obtain a copyright for those materials in the same state in which they are furnished to him. *id.*
3. A person cannot appropriate as his own, by copyright, alterations and improvements made in a musical composition by others at his procurement and for him. *id.*
4. Where a bill in Equity contains allegations which constitute an assertion of authorship under the copyright Act, in terms sufficiently explicit to constitute a perfect title at law in the plaintiff, the bill will be held good on *general* demurrer, notwithstanding the defectiveness and inconsistency of other allegations in the bill as to the authorship. *id.*
5. An action on the case is the proper form of remedy to recover damages for the violation of a copyright, and *trespass* will not lie for such violation. *id.*
6. Under the copyright Act of February 3d, 1831, (4 *U. S. Stat. at Large*, 436,) the deposit of the title-page in the proper clerk's office, the publication of notice according to the Act, and the delivery of a copy of the book, are indispensable conditions precedent to a title to a copyright. *Baker v. Taylor*, 82
7. Where the title-page of a book was deposited in 1846, and the notice of the entry, as printed in the copies of the book, stated the entry to have been made in 1847: *Held* that, under § 5 of the Act, the error was fatal to the title. *id.*
8. Whether the error arose from mistake or not, makes no difference. *id.*
9. A sale of a book naturally imports publication, and the presumption is that the purchaser exercised his right to know the contents of the book and to make them known to others, and that an actual publication followed the sale. *id.*
10. Hence, where copies of a book were sold prior to the date of the deposit of a copy of the title-page: *Held*, that such sale was evidence of a publication of the book at the time of the sale. *id.*
11. And, where a printed copy of the book, then complete, was deposited in the clerk's office at the same time the title-page was deposited there: *Held*, that these facts, in connection with the fact of such prior sale, warranted the inference of an actual publication of the book prior to the date of such deposit. *id.*
12. Under § 4 of the Act, a person is not entitled to the benefit of a copyright unless he deposits the title-page *before* the publication of the book. *id.*
13. The State Reporter, Mr. Comstock, by whom the third volume of Comstock's Reports of cases argued and determined in the Court of Appeals of the State of New York was prepared, was the *author* of that volume, within the copyright Act of February 3d, 1831, (4 *U. S. Stat. at Large*, 436.) *Little v. Gould*, 382
14. Under the Acts of the Legislature of New York of April 11th, 1848, and April 9th, 1850, in relation to

the Reports of the decisions of the Court of Appeals, the interest of the Reporter in said third volume, as an author, passed to the Secretary of State, in trust for the benefit of the State, and it was competent for that officer to take out a copyright for the volume under said Act of February 8d, 1831. *id.*

15. The words, "any notes or references," in the Act of April 9th, 1850, embrace the head-notes and marginal notes of the Reporter, together with the arguments of counsel and the cases cited therein. *id.*

16. Where, under said Acts of the Legislature of New York, a contract was entered into by the State officers with A., to publish the volumes which should be prepared by the Reporter, and the contract declared that it was intended to operate as an assignment of the copyright: *Held*, that A. was, as assignee of the copyright, entitled to a remedy by injunction for its infringement. *id.*

17. *Held*, also, that A.'s right was not affected by the provision in the 22d section of the 6th article of the Constitution of New York, that all "judicial decisions shall be free for publication by any person." *id.*

See DEMURRER, 3.
DISCOVERY, 2 to 6, 8, 9. ;
PLEADING, 1.
REPORTS.

CORPORATION.

1. Where corporate rights and interests are affected in any way wrongfully and injuriously, those rights and interests, generally speaking, and unless some special ground be shown, must be asserted and defended, both at law and in Equity, in the corporate name. *Bradley v. Richardson*, 343

See MONEY HAD AND RECEIVED.

COSTS.

1. In suits at common law, in the Cir-

cuit Courts of the United States, neither party can recover costs upon any equity in the case, nor do those Courts possess authority to award them as an incident of their power over the parties or the subject-matter in litigation. They are purely a subject of legislative appointment. *Coggill v. Lawrence*, 304

2. Where an action was commenced in a State Court against a collector, to recover back an excess of duties paid on the importation of foreign merchandise, and the action was removed into this Court by the defendant, under § 3 of the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 633, and the plaintiff obtained a verdict for \$9 50: *Held*, that the plaintiff was not entitled to any costs. *id.*

3. It was the intention of Congress that the description of revenue cases mentioned in § 3 of said Act, should, when removed into this Court, after being commenced in a State Court, be proceeded in, in all particulars, as cases originally commenced in this Court. *id.*

4. Such removal does not bring with it the State law as to costs, and, therefore, in cases of that kind, the costs in this Court are regulated by § 20 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 83,) which allows no costs to a plaintiff when he recovers less than \$500, and provides that he may, in such case, be adjudged to pay costs, at the discretion of the Court. *id.*

5. Where, in a cause removed into this Court under § 3 of said Act of 1833, the plaintiff obtained a verdict for \$9 50: *Held*, that the case was not a proper one for the allowance of costs to the defendant. *id.*

6. *Semble*, that cases removed into this Court from a State Court, under § 12 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) do not bring with them the State law of costs, but are subject to the provisions, as to costs, of § 20 of the same Act. *id.*

See ADMIRALTY, 2.

ATTACHMENT, 4.
 PATENTS, 38.
 PRACTICE, 5.
 SEIZURE, 4.

COTTON.

See BILL OF LADING, 1 to 4.

COURTS OF U. STATES.

1. A party entitled to sue in this Court by reason of a constitutional qualification, acquires no right to any standing here different from what he would have in any other tribunal competent to take cognizance of his case. *The City Bank of New York v. Skelton*, 26
2. Whenever, therefore, jurisdiction over his case has attached, this Court will proceed with it conformably to the general principles of law, and to the usage and practice of the Court. *id.*

See ACTION.

ATTACHMENT, 6 to 8.
 COSTS.
 DISCOVERY, 11 to 13.
 FUGITIVE SLAVE LAW, 4 to 6.
 GRAND JURY.
 INJUNCTION, 1 to 3, 6, 7.
 JUDGMENT, 1 to 4.
 JURISDICTION.
 JURY.
 PRACTICE, 14 to 30, 32, 33.

CROSS-BILL.

See DISCOVERY, 15 to 17.

CUSTOM HOUSE.

See COLLECTOR.

D

DAMAGES.

See COLLISION.
 PATENTS, 90 to 109.

DECLARATION.

See DEMURRER, 1.
 INSURANCE, 6, 7.
 PATENTS, 18 to 20, 76 to 84.
 PRACTICE, 7, 8.

DECREE.

See JUDGMENT, 1 to 4.

DEDICATION.

See PATENTS, 14 to 21, 89.

DEED.

See POWER, 4 to 6.

DEFENCE.

See EQUITY, 1, 2.
 PATENTS, 85 to 87.

DEMURRER.

1. Variances between the declaration and the writ cannot be taken advantage of on general demurrer. *Wilder v. McCormick*, 31
2. A special demurrer to a bill in Equity is insufficient unless it points out specifically by paragraph, page or folio, or other method of reference, the parts of the bill to which it is intended to apply. *Atwill v. Ferrett*, 39
3. Where an action at law for the infringement of a copyright was brought against G., and then the plaintiff filed a bill in equity against G., F. and A., charging them, as co-partners, with having committed the acts for which G. was sued at law, and seeking a discovery from all of them in aid of the suit at law: *Held*, that G. could not, by demurrer, object to the bill as multifarious in respect to his co-defendants, especially as it appeared by the bill that they resided out of the jurisdiction of the Court. *id.*

4. *It seems*, too, that the charge in the bill that the defendants committed the acts complained of as copartners, would be an answer to the objection of multifariousness, provided the bill contained other proper allegations connecting them with the object and purpose of the discovery prayed. *id.*

See ATTACHMENT, 2 to 4.
COPYRIGHT, 4.
DISCOVERY, 2, 6, 9.
FORGERY.
MARRIAGE, 2, 8.
PATENTS, 76 to 84.
PLEADING.
PRACTICE, 7, 8.

DEPOSITIONS.

See ATTACHMENT, 6 to 8
PRACTICE, 23, 24.

DEVISE.

See POWER.

DISCLAIMER.

See PATENTS, 38 to 41.

DISCOVERY.

1. A defendant cannot be compelled to make discoveries in answer to a bill which seeks to enforce penalties and forfeitures against him by means of such discoveries. *Ahoill v. Ferrett*, 39
2. Where a bill in Equity claimed a forfeiture of pieces of music under § 7 of the copyright Act of February 8d, 1831, (4 *U. S. Stat. at Large*, 438,) and also sought a discovery from the defendants of the number of pieces printed by or for them, and of the number on hand: *Held*, that the bill was bad, on special demurrer. *id.*
3. If the forfeiture had been waived in the bill, the discovery might be compelled in aid of the recovery of damages in a suit at law. *id.*

4. And *it seems* that, on such discovery, Equity might compel the defendants to deliver up to the plaintiff the forfeited copies. *id.*
5. But the defendants cannot be directly required to convict themselves of the act which carries with it the forfeiture. *id.*
6. The objections which may be taken by general demurrer to a bill founded on a copyright, and seeking a discovery in regard to its infringement, in aid of a suit at law, are: (1.) That the plaintiff sets forth no title in himself to the subject-matter of the copyright; and (2.) That the bill lays no legal foundation for the discovery sought. *id.*
7. To obtain a discovery in Equity in aid of a suit at law, the bill must show it to be necessary for the plaintiff, and that, when made, it can be used to his advantage. *id.*
8. Such a discovery will not be granted where it is sought in aid of an action of *trespass* for the violation of a copyright. *id.*
9. And a bill seeking such discovery will be held bad, on general demurrer. *id.*
10. *It seems*, too, that such a bill is defective in substance, where it seeks a discovery from three defendants, and the action at law is against only one of them. *id.*
11. Under § 15 of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 82,) the Courts of the United States have power, on the application of a party to an action, to require the production of books or writings in the possession or power of the adverse party, which contain evidence pertinent to the issue, only in cases and under circumstances in which a Court of Chancery, by the ordinary rules of proceeding in that Court, would compel the production of the same. *Finch v. Rikeman*, 301
12. The authority conferred by the Act can be exercised, therefore, only

in cases where the relief might have been had by a bill of discovery, and as a substitute for that proceeding.

id.

13. Where, in an action at law for the infringement of a patent, the plaintiff applied to this Court for an order requiring the defendant to produce his books, for the purpose of enabling the plaintiff to establish therefrom the quantity and value of certain machinery made by the defendant, which the declaration charged to have been made in violation of the patent: *Held*, that the application could not be granted, because the direct consequence of the evidence, if obtained, would be to subject the defendant to a penalty under § 14 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) and the plaintiff had not relinquished his claim to the penalty. *id.*

14. A bill of discovery will not be allowed in any case where the discovery will subject the defendant to a penalty, unless the bill relinquishes all claim to the penalty. *id.*

15. A defendant in a suit in Equity founded on the infringement of a patent, cannot, by a cross-bill which sets up no color of title in himself, demand a discovery from the plaintiff in the original suit as to the source or validity of his title. *Young v. Colt*, 873

16. It is essential to a bill of discovery that it should set forth a title sufficient to support or defend a suit, and pray a discovery pertinent to that title and nothing beyond. *id.*

17. And, where it cannot be sustained as a bill for discovery, it cannot be retained for the purpose of relief, unless it makes a case for relief independently of the discovery sought. *id.*

See DEMURRER, 3, 4.
PLEADING, 1.
PRACTICE, 3, 4, 12.

DISTRICT COURTS.

See FUGITIVE SLAVE LAW, 4 to 6.

DIVORCE.

See MARRIAGE, 2, 3.

DRAFT.

See BILLS OF EXCHANGE.

DRAWINGS,

See PATENTS, 83 to 87, 88, 89, 139.

DUTIES.

1. The proviso to the 61st section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 673,) which declares "that it shall be lawful for the President of the United States to cause to be established fit and proper regulations for estimating the duties on goods, wares and merchandise imported into the United States, in respect to which the original cost shall be exhibited in a depreciated currency issued and circulated under authority of any foreign Government," is not repealed by the Act of May 22d, 1846, (9 *U. S. Stat. at Large*, 14,) which prescribes the rates at which certain foreign coins shall be estimated in computations at the Custom House. *Grant v. Maxwell*, 220
2. Notwithstanding the Act of May 22d, 1846, an importer of foreign goods is entitled, under the proviso to the 61st section of the Act of 1799 and the Treasury Instructions issued for carrying the same into effect, to enter his goods on paying duties only upon their cash value in the country of their purchase; and is entitled, in order to fix that value, to have the paper or nominal value at which they were purchased and invoiced, reduced to its specie value in such country at the time of the purchase, and to enter the goods on that valuation. *id.*
3. Where goods were purchased in Austria, in 1850, and imported into New York, and the invoice and entry set forth the purchase-price in paper florins, and they were paid for in paper currency, and it appeared that

the paper florin was depreciated in Austria, at the date of the purchase of the goods, below the value of the silver florin, although it was the legal currency in Austria, and was a legal tender at its nominal value: *Held* that, although the Act of May 22d, 1846, directed the florin of the Austrian Empire to be estimated at forty-eight and one-half cents, yet, under the proviso to the 61st section of the Act of 1799, and the Treasury Instructions in regard to invoices made out in a foreign depreciated currency, the goods were chargeable with duty only on their value in silver florins, after allowing for the depreciation. *id.*

4. Where wool, the growth and production of Buenos Ayres, was purchased there for exportation to New York, but, on account of the blockade of Buenos Ayres, was transported in lighters to Montevideo, and shipped thence to New York: *Held* that, under § 16 of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) the costs and charges of such transportation from Buenos Ayres to Montevideo could not be added as a part of the dutiable value of the wool. *Wilbur v. Lawrence*, 314
5. The Tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 42,) did not vary the law previously in force regulating the method of ascertaining the quantity of merchandise imported. Such quantity is still to be ascertained by the rules prescribed in §§ 58 and 59 of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 671, 672.) *Wilson v. Maxwell*, 316
6. Accordingly, where soap in boxes was imported in 1850: *Held*, that the dutiable weight was the gross weight of the soap and boxes, deducting only 10 *per cent.* as tare, as prescribed by § 58 of the Act of March 2d, 1799, and that the importer was not entitled to an allowance of the actual weight of the boxes as tare. *id.*
7. But, the soap having been entered at the Custom House at a valuation based upon its net weight, after deducting the actual weight of the

boxes, and the Custom-House valuation, upon an allowance of only 10 *per cent.* on the gross weight as tare, having exceeded the invoice valuation by more than 10 *per cent.*, and the collector having then imposed an additional duty or penalty of 20 *per cent.* upon the Custom-House valuation, claiming that such penalty was authorized, in consequence of such excessive valuation, by § 8 of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43): *Held*, that the penalty was illegally imposed. *id.*

8. The weight of the boxes, cases or packages in which goods are imported is not the subject of *appraisal*, within the meaning of § 8 of the Act of July 30th, 1846. *id.*
9. Where property is purchased abroad by the United States, and is shipped to this country, to be delivered to the United States on payment of the purchase-money, and is landed under the general permit of a collector and placed in a public store, the legal right of property therein is vested in the United States, subject only to the vendor's lien for the purchase-money. *The United States v. Lutz*, 383
10. Such property, being imported for the United States, is not subject to any import duty, and, therefore, the sale of it by a collector, for the non-payment of such duty, is void. *id.*
11. And, if such property be in the actual possession of the United States at the time of such sale, and it be taken from that possession by the purchaser of it on such sale, the United States are entitled to recover its possession by an action of replevin against such purchaser. *id.*
12. Under the 16th section of the tariff Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) and the 8th section of the tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) it is the duty of a collector to assess duties upon the appraised value of goods imported by their manufacturer, notwithstanding there is an invoice sworn to by their owner. Those sections are not confined to

- goods imported by a purchaser.*
Thomson v. Maxwell, 385
13. Under the Act of February 26th, 1846, (5 *U. S. Stat. at Large*, 727,) it is a condition precedent to a right of action against a collector for the return of duties paid under protest, that the claimant shall, in his protest, point out to the collector, by positive and direct notice, every particular of fact and of law which he relies upon as protecting his goods from the duties demanded. *id.*
14. Where a protest was in these words: "We protest against paying additional duty and penalty on" (describing the goods) "they being appraised too high. We claim to have" (naming the amount) "refunded, being amount paid for additional duty and penalty:" *Held*, that the person making such protest could not, in an action against the collector for the return of the amount so paid, raise any objection to the regularity of the appraisal proceeding. *id.*
15. Where a protest is written on an entry, they compose, in effect, one paper, and it is unnecessary to repeat in the protest the description given of the goods in the entry. *id.*
16. Where goods were described in the invoice as "plain Indiana squares," "embd. Indiana hdkfs.," "emb. Indiana shawls," "embd. hdkfs." and "plain do.," with no allusion to the material of which they were composed, and were described in the entry as "worsted and cotton shawls," and were reported by the appraisers as "wool and cotton, and worsted and cotton shawls, suitable for wear," and as "worsted shawls, suitable for wear," and the protest under which duties were paid on them described them simply as "cotton and worsted shawls," and they were subjected by the collector to a duty of thirty *per cent.*: *Held*, in an action to recover back the excess of duties paid be-
- yond twenty-five *per cent.*, there being no evidence explaining the character of the articles, that they were properly chargeable with thirty *per cent.*, as being "articles worn by men, women or children," and falling within Schedule C of the Tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 44.) *id.*
17. Where the time of exportation is taken by the appraisers as the time of valuation, and the importer claims that the time of manufacture or production should have been taken, he must make that a ground of protest, and must give evidence to show the incorrectness of the appraisal. Ordinarily, the two periods may properly be treated as the same. *id.*
18. Where goods are, on appraisal, valued at more than ten *per cent.* above the invoice price, they are, nevertheless, not liable to an additional duty of twenty *per cent.* under the 8th section of the Tariff Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) if they were manufactured by the importer, or were procured by him in the country of their production otherwise than by purchase. *id.*
19. In an action to recover back duties as having been illegally exacted, no ground of objection to the payment of the duties can be taken, which was not specifically and distinctly stated in a protest made at the time of paying the duties. *Durand v. Lawrence*, 396
20. Where the protest merely protested against the payment of the duty, but stated no ground of objection: *Held* that, on the trial of an action to recover back the duty paid, the plaintiff could not question the validity or accuracy of the appraisalment on which the duties were paid. *id.*
21. Where the invoice valuation of goods imported by their manufacturer is increased on appraisement by more than ten *per cent.*, the collector

* See *Belcher v. Laurason*, (21 How.) *contrd.*

- has no authority to impose the penalty prescribed by the 8th section of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43.) *id.*
22. Under the 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) appraisers must, in valuing importations, adopt the real market value of the goods abroad in cash, and not their value in a depreciated paper currency. *Loewenstein v. Maxwell*, 401
23. Goods purchased in Austria were invoiced and entered here in florins at their specie value. The appraisers here valued the goods according to the nominal value of the florin in paper currency, which was eleven *per cent.* less than its specie value: *Held*, that the appraisement was erroneous and should have been made in florins at their specie value. *id.*
24. In such a case, a protest against the additional valuation found on such appraisement, and a claim to enter the goods according to the invoice and actual cost, is a sufficient protest, without a specification as to how the appraisement was made to exceed the true value of the goods. *id.*
25. Such an erroneous appraisement is not conclusive on the importer as to the dutiable value of the goods. *id.*
26. A quantity of coal was invoiced and entered at a certain weight and price per ton. On appraisement, the price per ton was reported to be correct, but the quantity was reported as so much greater as to make the entire valuation greater by 10 *per cent.* than the entry valuation. The collector exacted a penalty of 20 *per cent.*, under § 8 of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43): *Held*, that this was illegal. *The Manhattan Gas-Light Co. v. Maxwell*, 405
27. *Held*, also, that the importer was not liable, in such case, under § 4 of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 43,) to pay the fees of the weigher and measurer. *id.*
28. Where duties paid to a collector are sought to be recovered back, on the ground that the proceedings in the Custom House, in initiating or conducting an appraisement of the goods on which the duties were paid, were irregular, the irregularities relied on must be set forth specifically in the protest. *Pierson v. Lawrence*, 495
29. The law as settled in *Thomson v. Maxwell*, (*ante*, p. 385,) in regard to what is requisite in a protest against the payment of duties, again applied. *id.*
30. An accepted order for goods, although a purchase in the usage of the particular trade, as between vendor and vendee, is not a purchase under the 16th section of the Act of August 30th, 1842, (5 *U. S. Stat. at Large*, 563,) so as to authorize the entry of the goods, when imported, at a dutiable value fixed at the current price of like goods at the time the order was accepted, where the goods are to be manufactured after the acceptance of the order. *id.*
31. The date of an invoice, in an entry by the purchaser of goods, is, as against such purchaser, *prima-facie* evidence of the time of their purchase, and conclusive, until a mistake in the date is proved. *id.*
32. The insufficiency of the protest against the payment of duties in this case, pointed out. *Pierson v. Maxwell*, 507
33. The doctrine of the case of *Pier-son v. Lawrence*, (*ante*, p. 495), applied. *id.*
34. A protest against the payment of duties must point out specifically the particular omission or irregularity complained of, or it will not be available in an action to recover back the duties. *Focks v. Lawrence*, 508
35. The doctrine of the cases of *Pier-son v. Lawrence*, (*ante*, p. 495,) and

Pierson v. Maxwell, (*ante*, p. 507,) applied to the protests in this case. *id.*

36. A collector is not bound to take the invoice valuation of goods, supported by the owner's oath on the entry, as their dutiable value. *id.*

37. A collector is justified, in the absence of written notice of a different state of facts, in assuming the place of shipment of goods, as stated in the entry invoice, to be the place of their purchase, and the date of the invoice as the time of their purchase. *id.*

38. Where, in a protest against the payment of duties, on an addition made by the appraisers to the invoice value, the only ground of protest stated was, that *the invoice exhibited the true market value of the goods at the place from which they were imported*: *Held*, in an action to recover back the duties, that the only point raised by the protest was the correspondence of the invoice value with the value at the place of export at the date of the invoice, and that the plaintiff could not, under the protest, show that the invoice value was the actual purchase-price. *Cornett v. Lawrence*, 512

39. A protest against the payment of duties must set forth the specific objections of the party, and refer the collector distinctly to the facts, otherwise the party cannot avail himself of them in an action against the collector to recover back the duties. *id.*

40. Under a protest against the payment of duties and of a penalty, which only sets out that the entry invoice is in all respects correct and just, and that no legal forfeiture or penalty has been incurred, the invoice value of the goods having been increased on an appraisement, no question can be raised, in an action to recover back the duties and penalty, except as to the difference between the appraised and the market value of the goods at the place of shipment at the date of the invoice; nor can it be shown that the invoice value was

the actual purchase-price. *Tucker v. Maxwell*, 517

41. What should be stated in such a protest, defined. *id.*

42. Under the proviso to the 61st section of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 673,) an importer of goods from Austria is entitled to enter them on the payment of duties on their specie value, although the invoice is made out in a depreciated paper currency, legitimated by the Austrian Government; but, in order to avail himself of the benefit of the proviso, the deterioration of the invoice currency must be proved in the manner required by the proviso. *Dutilh v. Maxwell*, 541

43. Accordingly, as the proviso authorizes the President to make regulations for estimating the duties on goods invoiced in a depreciated currency issued under the authority of a foreign Government: *Held* that, under a Treasury Circular requiring invoices of goods, when made out in such depreciated currency, to be accompanied by a consular certificate showing the specie value of such currency, the presentation of such certificate is a prerequisite to any correction of the invoice, or to any relief founded on such depreciation in the currency. *id.*

44. Where no such certificate accompanies the invoice, and no bond for its production is given, its place cannot be supplied by parol evidence of the depreciation in the currency. *id.*

45. Where a protest against the payment of duties claimed a discount on the value in paper currency stated in the invoice, "as per consul's certificate," and the invoice stated the fair market value of the goods, at its date, at the foreign port, in paper currency, and also the correct rate of discount for specie value: *Held*, that the statement in the protest amounted to an averment that a proper consul's certificate was presented to the collector with the invoice, or, at least, that the importer had one,

- or was able and offered to produce it. *Craig v. Maxwell*, 545
46. It is not necessary that such a certificate should be absolutely presented with the invoice when the entry is made; but, if it is not so presented, a bond must be given to produce it. *id.*
47. Where such a certificate is offered and rejected, or when an offer is made to produce one, and the collector does not exact such bond, it will be presumed that the collector refused to be governed by the certificate if exhibited. *id.*
48. Under such circumstances, the importer stands on the same footing as if such a certificate had accompanied his invoice. *id.*
49. The doctrine of the case of *Dutilh v. Maxwell*, (*ante*, p. 541), applied. *Dutilh v. Maxwell*, 548
50. Where duties on an importation are fully paid, a consular certificate of depreciation in the foreign paper currency in which the invoice was made up, cannot be afterwards presented to the collector, so as to entitle the importer to recover back the duties paid on the difference between the specie value of the goods and their invoice value. *id.*
51. Where an invoice sets forth the prices of goods in a foreign paper currency, and also carries them out reduced to a specie standard, and the importer makes the entry in the specie value, and, on appraisement, the value is returned at the invoice paper currency prices, which is greater by 10 per cent. than the specie value—*It seems*, this is not such an excess of appraised value over the value declared in the entry as to warrant the imposition of a penalty of 20 per cent. for undervaluation. *Fiedler v. Maxwell*, 552
52. Trover will lie against a collector who unlawfully detains the goods of an importer, and it is no defence that the collector acts under the instructions of the Secretary of the Treasury. *id.*
53. Where two entries on importations from the same Austrian port were made, not much over one month apart, and the goods were valued in the invoices, in both cases, in a depreciated paper currency, and a deduction was claimed in both cases on that account, a proper consular certificate having been presented to the collector in the first case, and rejected on the ground that no allowance for depreciation could be made, and there being a proper written protest in the second case: *Held* that, although the importer presented no consular certificate with his entry in the second case, he was entitled in that case to a deduction of the rate of depreciation stated in the certificate in the first case. *Reynolds v. Maxwell*, 555
54. The doctrine of the case of *Dutilh v. Maxwell*, (*ante*, p. 541,) applied to importations from Chili, Peru and Bolivia. *Alsop v. Maxwell*, 557

E

EJECTMENT.

See POWER, 5, 6.

EMINENT DOMAIN.

1. The right of eminent domain empowers the Legislature to devote private property to public use. *De Varaigne v. Fox*, 95
2. An Act of the Legislature of New York, reciting that certain lands were needed by the Corporation of the city of New York for the purpose of extending the Alms-House Establishment of the city, and providing that, on the ascertainment and payment to the owner of the lands, of the loss and damage for taking them, the Corporation should be seized of the lands in *fee-simple absolute*, does not exceed the rightful authority of the Legislature. *id.*
3. In the exercise of its power to devote private property to public use,

the Legislature is the exclusive judge of the degree and quality of interest which are proper to be taken, as well as of the necessity of taking it. *id.*

4. Where the Legislature has conferred an estate in *fee-simple absolute* in the premises taken, it must be assumed that it judged it necessary to do so, to answer the public use contemplated. *id.*
5. Such a grant of a *fee-simple absolute* will not be construed as a conditional fee or usufruct, leaving the possibility of a reverter to the original owner on the lapse of the particular use, but will be held to have vested the entire property forever in the grantee. *id.*
6. If a change in the destination of the property granted, after a continuance for twenty-six years of the use of it first contemplated, raises any interest or right on the part of the original owner, it is of an equitable character, cognizable only in Chancery, and not at law. *id.*

ENGINEER.

See STEAMBOATS, 2, 3, 8.

ENTRY.

See DUTIES, 15, 16, 28, 26, 30, 31, 36, 37, 40.

REVENUE LAWS.

EQUITY.

1. It seems to be an established rule in Equity, that matter entitling a party to an amendment of a contract may be set up by way of defence to a proceeding to enforce a specific performance of the contract, where the clause omitted through mistake or accident would, if found in the instrument, constitute a ground of defence. *Woodworth v. Cook*, 151
2. But such a defence cannot be set up where the rights of a *bond-fide* purchaser have intervened, which would

or might be seriously prejudiced by giving effect to the defence. *id.*

3. It is not sufficient for a debtor, or for those who are entitled to assert his rights, in order to induce a Court of Equity to relieve against a judgment at law, to show that the debtor was wrongfully deprived of an opportunity of making a defence in the suit at law, unless a defence, apparently, would have been available. To entitle them to the interposition of a Court of Equity in their behalf, it must appear that the judgment is unjust and inequitable, and ought not to be enforced. *Bradley v. Richardson*, 843

4. Where property of a debtor, which is subject to an attachment in a suit pending at law, is sold to one to hold in trust for certain creditors of the debtor, and a judgment is rendered in the suit at law, and the creditors for whose benefit the purchase was made institute proceedings in Equity to be relieved against the judgment so obtained, alleging that it was unduly obtained and for too large an amount, the Court will not inquire merely whether the judgment was just and equitable as between the parties to it, but whether it includes claims or demands not covered by the action, or not due and payable at the commencement of the action, or which, by a proper application of payments or credits, will appear to have been paid and satisfied, and were, therefore, not existing legal claims; and, unless the judgment appears to be wrong in some of these particulars, and consequently to have been rendered for more than the property ought to have been charged with, the plaintiffs will have no ground of complaint, whatever may have been the manner in which the judgment was obtained. *id.*

See ATTACHMENT, 1 to 5.

COPYRIGHT, 4.

DEMURRER, 2 to 4.

DISCOVERY.

EMINENT DOMAIN, 6.

INJUNCTION.

INTERPLEADER.

MARRIAGE, 2, 3.

PATENTS, 50 to 55, 57 to 62, 110 to 112.

PLEADING.

POWER, 5.

PRACTICE, 9 to 24.

RECEIVER.

RENTS AND PROFITS.

ESTOPPEL

See JUDGMENT, 7, 8.

MONEY HAD AND RECEIVED, 4.

PATENTS, 19, 75, 114 to 117.

EVIDENCE.

1. Where, on a joint indictment against three for murder, one of them is tried separately, it is not competent for him to give in evidence a conversation between the other two, when they were alone, inculcating themselves and exculpating him from all participation in the crime. *The United States v. Douglass*, 207

2. What is direct evidence, and what circumstantial evidence. *id.*

3. In a case of circumstantial evidence, the jury, in order to convict, must find the circumstances to be satisfactorily proved as facts, and must also find that those facts clearly and unequivocally imply the guilt of the accused, and cannot be reasonably reconciled with any hypothesis of his innocence. *id.*

See BILL OF LADING, 3.

BILLS OF EXCHANGE, 1.

CARRIER, 5, 6.

DUTIES, 44.

GRAND JURY, 19 to 26.

PATENTS, 3, 25, 35 to 37, 75, 88, 89, 91 to 93.

PRACTICE, 15 to 24.

STEAMBOATS, 9.

VERDICT.

EXAMINERS.

See PRACTICE, 15 to 22.

EXCEPTIONS.

See PATENTS, 90.

PRACTICE, 1, 2.

EXPERIMENT.

See PATENTS, 15, 16, 140.

EXTENSION.

See PATENTS, 42 to 44.

F

FACTOR.

1. The undertaking of a factor is merely to answer for the solvency of the buyer of the goods, or rather to guaranty to the principal the payment of the debt due from the buyer. He becomes liable to pay to the principal the amount of the purchase-money, if the buyer fails to pay it when it becomes due. And his undertaking is not collateral, within the statute of frauds, but is an original and absolute agreement that the price for which the goods are sold, or the debt created by the sale of the goods, shall be paid to the principal when the credit given on the sale shall have expired. *Bradley v. Richardson*, 343

2. If the factor has agreed that he will advance to a certain amount upon the goods consigned to him, to that extent his advances may be treated as payment in advance of so much towards the goods, and, so far, the one may be set off against the other. But all moneys advanced on account beyond the amount agreed to be advanced upon the goods will constitute a present legal debt, for which he will have a present legal right of action. *id.*

3. If the principal procures and has the benefit of the advances, he is thereby precluded from objecting to them as not answering the agreement, whatever may be the form in which they are made. *id.*

4. If the factor commences a suit at law against the principal, to recover the unpaid balance due to him for his actual advances, having previously made sales of goods upon a credit not yet expired, and being at the same time liable upon acceptances and bills for the principal not yet matured, he is entitled to have the avails of the sales, as they become due, applied in satisfaction of the additional advances which he is compelled to make upon such bills and acceptances as they become due, and cannot be required to apply such avails in satisfaction of his present legal claims existing at the commencement of his suit. *id.*

FEEES.

See DUTIES, 27.

FEE SIMPLE.

See EMINENT DOMAIN, 2, to 5.

FOREIGN COINS.

See DUTIES, 1 to 3, 22 to 25, 42 to 48, 50, 51, 53.

FORFEITURE.

See DISCOVERY, 1 to 5.
PATENTS, 14 to 26, 89.
PRACTICE, 32, 33.

FORGERY.

1. An indictment for forgery, under § 19 of the Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 120,) in altering a certificate issued under § 41 of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 659,) alleging that the certificate was issued by the collector *ex-officio*, is bad on demurrer. *The United States v. Schoyer*, 59
2. By the Act of 1799, the certificate was to be issued by the *supervisor* of the revenue, and the indictment ought to allege that the collector was designated by the President to

fulfil the duties of supervisor, under the Act of March 3d, 1803, (2 *U. S. Stat. at Large*, 243,) and that the certificate was granted by the collector in that capacity. *id.*

FRAUD.

See BILLS OF EXCHANGE.
PATENTS, 44.

FREIGHT.

See BILL OF LADING, 2, 4.
CARRIER, 4.

FUGITIVE SLAVE LAW.

1. When, under § 6 of the Act of September 18th, 1850, (9 *U. S. Stat. at Large*, 463,) known as the *Fugitive Slave Act*, a warrant is issued by competent authority, that is sufficient to justify the arrest and detention of the fugitive until he is discharged by due course of law, and any person concerned in rescuing or attempting to rescue such fugitive out of the custody of the law, subjects himself to the penalties of the Act. *The United States v. Reed*, 435
2. So far as it respects an obstruction to the execution of legal process, or a forcible rescue of a fugitive from service, under the Act of September 18th, 1850, (9 *U. S. Stat. at Large*, 462,) commonly called "The Fugitive Slave Law," the provisions of that Act probably supersede those of the Act of April 30th, 1790, (1 *U. S. Stat. at Large*, 112,) with one exception. *The Fugitive Slave Law*, 559
3. The provision in the 22d section of the Act of 1790, for the case of assaulting, beating or wounding any Federal officer, or other person duly authorized, while engaged in serving or executing any process, may apply as well to the execution of process under the Act of 1850 as under any other Act, the case not being specifically provided for in the Act of 1850, and there being no necessary repugnancy between the two Acts in this respect. *id.*

4. There is some doubt whether a Circuit Court has jurisdiction of the offences named in the 7th section of the Act of 1850, as that Act in terms limits cognizance of those offences to the District Court. *id.*
5. It may be a question whether the provision of the 11th section of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 78,) conferring on the Circuit Court concurrent jurisdiction with the District Court of all crimes and offences cognizable therein, applies to jurisdiction subsequently conferred on the District Court in as specific terms as that conferred by the Act of 1850. *id.*
6. The provision of the 2d section of the Act of August 8th, 1846, (9 *U. S. Stat. at Large*, 72,) by which the District Court is authorized to remit to the Circuit Court any indictment pending in the District Court, no doubt embraces the cases specified in the 7th section of the Act of 1850. *id.*
7. The consequences of forcible resistance and obstruction to the execution of the Act of 1850, considered. *id.*

G

GRAND JURORS.

See GRAND JURY.

GRAND JURY.

1. The Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 88, § 29,) the Act of May 18th, 1800, (2 *Id.* 82,) and the Act of July 20th, 1840, (5 *Id.* 394,) adopt the State regulations respecting the procurement of grand and petit jurors to serve in the Federal Courts, and apply to those Courts the State regulations respecting the *qualifications* and the exemptions of grand and petit jurors. *The United States v. Reed*, 435
2. A challenge to a grand juror for favor, on the ground that he is the prosecutor or complainant upon a charge, or that he is a witness on the part of the prosecution, and has been subpoenaed or been bound in a recognizance as such, goes to the *qualifications* of the juror. *id.*
3. A challenge to the array of the grand jury in a given case, on the ground that they have been selected, summoned and returned by a person unfit to summon an indifferent jury in the case, touches the *qualifications* of the panel. *id.*
4. Therefore, State regulations respecting such challenges are applicable in the Federal Courts. *id.*
5. But *peremptory* challenges in criminal cases in the Federal Courts are regulated by the common law. *id.*
6. The absence of a *venire* for the summoning of a grand jury, in a case where it is required, is a ground of challenge to the array. *id.*
7. Challenges to the array of grand jurors are abolished by the laws of New York, and are consequently also abolished in the Federal Courts in New York. *id.*
8. But still, where there has been any improper conduct on the part of the officers employed in designating, summoning and returning the grand jury, an accused person who is prejudiced thereby has his remedy by motion to the Court for relief. *id.*
9. All objections, however, to the proceedings in the selection and summoning of grand jurors, over and beyond the right of challenge, are presented to the Court for the exercise of its sound discretion, and, although there may be technical irregularities, it will not interpose, unless satisfied that the accused party is prejudiced by them. *id.*
10. Under the Act of August 8th, 1846, (9 *U. S. Stat. at Large*, 73, § 3,) providing that no grand jury shall be summoned in the Federal Courts except upon an order for a *venire*, to be made by a Judge, a *venire* should be issued by the clerk of the Court, in pursuance of the order. *id.*
11. A verbal order given by a Judge

- to the clerk in such case is sufficient, though no order be filed or entered of record. *id.*
12. The omission to issue a *venire* in such case, if a ground of challenge to the array, and if taken advantage of at the proper time, is fatal to the panel. *id.*
13. But, if not a ground of challenge, or if the time for making the challenge be passed, it is only a ground for a motion to set aside the panel for cause. *id.*
14. The mere omission, however, to issue the *venire*, is not such cause, where the application is addressed to the sound discretion of the Court. *id.*
15. By the law of New York, (2 R. S. 724, §§ 27, 28,) persons "held to answer," that is, arrested and held to bail to appear at the term of the Court at which the grand jury attends, to answer such complaints as may be presented against them, are the only persons who can challenge either the array of grand jurors, or the individual grand jurors for favor. *id.*
16. Where a party appeals to the sound discretion of the Court to set aside an indictment for irregularities in drawing or summoning the grand jury, he must implicate the good faith of the officers concerned in discharging those duties. *id.*
17. Those officers, in New York, are bound to use the State boxes and the State ballots in drawing grand jurors, as the same are furnished to them by the State officers, and have no right to change or alter either. *id.*
18. It is the uniform practice, in the Federal and State Courts, for the clerk and assistant of the District Attorney to attend the grand jury and assist in investigating the accusations presented before them. That practice must be regarded as settled; but any abuse or improper conduct on the part of any person admitted to the grand jury, will be investigated by the Court. *id.*
19. The Court has no power to inquire into the mode in which the examination of witnesses was conducted before the grand jury, for the purpose of invalidating an indictment. *id.*
20. It will inquire, however, into the manner of swearing the witnesses, when they are sworn in open Court, and into the competency of the evidence, whether oral or documentary, and into the manner of authenticating the latter species of evidence. *id.*
21. Where witnesses before a grand jury are testifying in regard to facts about which they have previously made *ex parte* affidavits, it is not improper for them to consult those affidavits, to refresh their recollection; nor is there any objection to their swearing that certain facts, of which they have previously made statements on paper, are true. *id.*
22. Evidence before a grand jury must be competent legal evidence, such as is legitimate and proper before a petit jury. *id.*
23. On a criminal charge against several persons, for a participation in the rescue of a person from the hands of a public officer who held him in custody, the witnesses who were to testify before the grand jury were sworn in open Court in the following manner: The clerk of the Court was furnished with a general description of the persons accused—*The United States v. M. S. and others*—and then administered to the witnesses this oath: "You, and each of you, do severally solemnly swear, that the evidence you shall give to the grand inquest touching charges against M. S., and others, concerning which you shall be interrogated, shall be the truth, the whole truth, and nothing but the truth. So help you God." Upon the testimony given under this oath, twenty-four bills of indictment were found against twenty-four different persons, one against each. No indictment was found against "M. S. and others," nor was any indictment found against any two persons jointly. On a motion by E. R., the defendant in one of the indictments, to quash it, on

the ground that the oath was void as to him: *Held*, that the oath was free from objection. *id.*

24. A general oath to give evidence touching criminal charges to be laid before the grand jury, without reference to any particular person, is unobjectionable. *id.*

25. If the oath embraces one or more persons by name, whose cases are about to be laid before the grand jury, and in respect to which the oath is administered, and nothing more, evidence cannot be given under it in support of any accusation against others. *id.*

26. The Court has no power to revise the judgment of a grand jury upon the evidence, for the purpose of determining whether or not the finding was founded upon sufficient proof, or whether there was a deficiency in respect to any part of the complaint. *id.*

GRANT.

See PATENTS, 56.

I

IMPORTS.

See DUTIES.

INDICTMENT.

See FORGERY.
FUGITIVE SLAVE LAW, 6.
GRAND JURY.
MURDER, 1.
STEAMBOATS.

INFORMER.

See PRACTICE, 32, 33.

INFRINGEMENT.

See COPYRIGHT, 16, 17.

DISCOVERY, 15.

PATENTS, 10, 30, 38, 49, 59, 62 to 75, 82, 90, 108, 109, 111, 112, 122, 123, 134 to 136, 142.

PRACTICE, 5, 6.

VERDICT.

INJUNCTION.

1. This Court has no power to restrain or interfere with a suit prosecuted and pending in a State Court, by enjoining the further prosecution of such suit. *The City Bank of New York v. Skelton*, 14

2. But this Court, in executing a jurisdiction vested in it, may, in a case of which it has cognizance, act upon parties who are suitors in a State Court in relation to the same subject-matter, so far at least as to compel their submission to such judgment as this Court may render in the case. *id.*

3. Where funds were deposited in a bank, and afterward S., claiming the funds as his property, commenced a suit for their recovery in a State Court against the bank and Y., the depositor of the funds, and, while that suit was pending, Y. commenced two suits in this Court against the bank, to recover the funds and damages for their detention, the bank having no interest in the funds: *Held*, on a bill filed in this Court by the bank against S. and Y., that although this Court would not decree an interpleader in the case, or enjoin the suit in the State Court, yet it would enjoin the prosecution by Y. of his suits in this Court, until the final decision of the suit in the State Court. *id.*

4. *Held*, also, that this Court would give the parties the option to consent by stipulation to interplead in this Court on the subject-matter, and, in case they did so, would allow the bank to pay the funds into Court, first deducting such costs and expenses as the Court should allow. *id.*

5. This Court has power, in a proper case, to prohibit a non-resident plaintiff from prosecuting an action against a defendant residing within

this State. *The City Bank of New York v. Skellon*, 26

6. The Circuit Courts of the United States have power to control and stay actions pending before them, either by order on the common law side of the Court, or by injunction on the Equity side. *id.*
7. But they will not exercise such authority over actions pending in a State Court, nor will a State Court interfere with actions pending in the Federal Courts. *id.*
8. The decision in this same case, (*ante*, p. 14.) that this is a proper case for this Court to stay by injunction an action at law pending here, reviewed and affirmed. *id.*
9. Considerations stated, in regard to the granting of provisional injunctions. *Little v. Gould*, 165

See ATTACHMENT, 1 to 5.

COPYRIGHT, 16, 17.

PATENTS, 75, 110 to 113, 135.

PLEADING, 1.

PRACTICE, 5, 6.

REPORTS, 8.

INSURANCE.

1. These points are settled in the construction of policies of insurance: First, They are to have a liberal and benign interpretation in behalf of the insured; Second, They are to be construed and enforced according to the plain intent of the parties, if no settled rule of law interposes to prevent; Third, Whether or not, by the general rules of insurance law, the fact that the insured party had no insurable interest in the subject insured at the time it was intended the contract should commence its operation, although he possessed such interest at the time of the loss, would render the policy invalid, yet it is competent for the parties to contract with a view to such a condition of things. *Houshaw v. The Mutual Safety Ins. Co.* 99
2. There is strong color, however, for the doctrine, that the party intended

to be insured will be protected, if he had an interest at the time of the loss, without any express stipulation to that effect, although he had no interest at the commencement of the risk. *id.*

3. A time policy, against marine risk, on a steam-vessel, for a succession of voyages, each voyage to bear its own average, made at the instance of N., on account of whom it may concern, the loss payable to H., for the sum of \$15,000, is an agreement by the underwriters to insure all the interest to that amount which shall be owned in the vessel at the time of her loss within the policy, and to pay the loss to H., for the benefit of the actual owners. *id.*
4. Such a contract is legal, and H., in his own right, or as trustee, is competent to enforce it. *id.*
5. The policy might, also, be construed as intending each separate trip of the vessel to be a distinct voyage, the risk on which would commence at its inception, and thus the party interested at the time of the loss would also be interested at the commencement of the risk. *id.*
6. Where the declaration on such a policy averred that, at the time of the loss of the vessel, H., the plaintiff, was interested in her to the amount of the said insurance: *Held*, that it need not aver that H. was interested in her at the time of the insurance, or at the time of the commencement of the risk. *id.*
7. And, where it averred that the insurance was for the use and benefit of H., as trustee for N., and that, as such trustee, H. was interested in the vessel at the time of her loss: *Held*, that it need not set forth the nature or extent of the trust, they being matters of evidence. *id.*

INTEREST.

See COLLISION, 3.

PATENTS, 95, 101, 106, 109.

INTERPLEADER.

1. Upon the general principles of Equity jurisprudence, a bank may, in a proper case, have relief by bill of interpleader against separate and adversary parties who claim title to moneys therein deposited. *The City Bank of New York v. Skelton*, 14

See INJUNCTION, 3, 4.

INTERROGATORIES.

See ATTACHMENT, 2 to 5.

INVENTION.

See PATENTS, 1 to 10, 134.

INVOICE.

See DUTIES, 7, 12, 16, 21, 23, 24, 26, 31, 36 to 33, 40, 42 to 48, 50, 51, 53.

REVENUE LAWS.

J

JUDGMENT.

1. A judgment or decree docketed in a Court of the United States for the Southern District of New York, is a lien on the lands of the defendant in whatever county of the District they are situated. *Cropery v. Crandall*, 341
2. It is not necessary to the creation of such lien, that a transcript of the judgment or decree should be filed in the office of the clerk of any county in the District. *id.*
3. The statutes of New York which limit the duration of the lien of the judgments and decrees of the State Courts apply to the judgments and decrees of the Courts of the United States within the State. *id.*
4. But the New York statute of May 14th, 1840, (*Laws of 1840, chap. 386, § 26*), prescribing what acts are

necessary to be done to create the lien of a State judgment or decree, does not apply to the judgments or decrees of a Court of the United States. *id.*

5. As a general if not universal rule, in order to bind a defendant, or to confer any rights upon a plaintiff, by force of a judgment in a *personal* action, the former must be served with notice of the institution of the suit, so that he may have an opportunity to appear and defend. *The Globe*, 427

6. But a proceeding *in rem* forms an exception to the general rule, and binds the *res* in the absence of any personal notice to the party interested. *id.*

7. A *foreign* vessel was attached by a proceeding *in rem*, under a law of Ohio, in a Court of that State, for repairs made and supplies furnished, and sold upon a judgment duly recovered in pursuance of such attachment: *Held*, that the judgment was conclusive upon the transfer and disposition of the vessel, in whatever place she might be found, and upon the title to her, by whomsoever it might be questioned, and whether involved directly or collaterally. *id.*

8. *Held, also*, that this was especially so where the owner of the vessel at the time appeared in the suit in the Ohio Court, and contested the proceedings throughout. *id.*

See EQUITY, 3, 4.

LIEN, 9.

RENTS AND PROFITS.

JUDICIAL DECISIONS.

See REPORTS.

JURISDICTION.

1. Under § 11 of the Judiciary Act of 1789, (*1 U. S. Stat. at Large*, 78,) construed in connection with Art. 3, sec. 2, of the Constitution of the United States, it is not sufficient to give jurisdiction of a suit to a Circuit

Court, that one of the parties to it is an alien. *Prenliss v. Brennan*, 162

2. The controversy, in order to give jurisdiction, must be one in which a citizen of a State and an alien are parties. *id.*

3. Where the plaintiff was a native of New York, but had resided in Canada and been in business there for thirty years before bringing his suit, and resided there when he brought his suit, and had taken the oath of allegiance there to the Queen of Great Britain, and the defendant was a citizen of Canada and a subject of the Queen of Great Britain: *Held*, that this Court had no jurisdiction of the case. *id.*

4. Though the plaintiff might, for some purposes, be regarded as a citizen of the United States, he was not a citizen of the State of New York, which was essential to give jurisdiction. *id.*

See PATENTS, 43, 44.
PRACTICE, 30.

JURORS.

See GRAND JURY.
JURY.

JURY.

1. A qualified peremptory challenge in a criminal case, that is, a right to set aside a juror without challenging him for principal cause or to the favor, and to have him finally excluded from the jury unless the panel is exhausted by the challenges of the prisoner, exists in favor of the Government in the Courts of the United States. *Per NELSON, J. The United States v. Douglass*, 207

2. This is the settled doctrine of the common law, and was recognized by the Supreme Court of the United States in *The United States v. Marchant*, (12 *Wheat.* 480.) *Per NELSON, J.* *id.*

3. The Act of July 20th, 1840, (5 *U. S.*

Stat. at Large, 394,) applies only to the mode of selecting the jury, that is, by ballot, lot or otherwise, as prescribed by the State laws, and does not affect the questions involved in the right of challenging the jurors called, whether peremptorily or for cause. Those questions stand upon the common law, except where regulated by Act of Congress. *Per NELSON, J.* *id.*

4. The Act of July 20th, 1840, (5 *U. S. Stat. at Large*, 394,) manifests a purpose to conform the regulations in regard to the designation and impanelling of jurors in the Courts of the United States, so far as may be practicable, to the existing laws of the particular States. *Per BETTS, J.* *id.*

5. The right to a qualified peremptory challenge in a criminal case did not belong to the Crown, at common law. It rested wholly upon a construction of the statute of 33 *Edw. I.* *Per BETTS, J.* *id.*

6. The case of *The United States v. Marchant*, (12 *Wheat.* 480,) did not involve any question as to the right of the Government with regard to challenges of jurors. *Per BETTS, J.* *id.*

7. The laws of the State of New York do not allow to the prosecution, in a criminal case, such qualified peremptory challenge, and the practice of the Courts of the United States has always been, to conform in all respects, in trials by jury, as nearly as practicable, to the laws of the State in which they sit. *Per BETTS, J.* *id.*

8. The Attorney for the United States is bound to assign and substantiate his challenge when it is made, and before other jurors can be drawn. *Per BETTS, J.* *id.*

9. Peremptory challenges to jurors are not allowed in the Courts of the United States in any other than capital cases, even though they are allowed in other cases by the State law. *The United States v. Cottingham*, 470

See EVIDENCE, 3.
 GRAND JURY.
 PATENTS, 2, 25, 27, 28, 91 to 93.
 VERDICT.

L

LACHES.

See PRACTICE, 13.
 SEIZURE, 4.

LAND.

See EMINENT DOMAIN.
 JUDGMENT, 1 to 4.
 POWER.
 RENTS AND PROFITS.

LEASE.

See POWER, 2 to 4.

LEGISLAURE.

See EMINENT DOMAIN, 1 to 4.

LETTER.

See POST-OFFICE.

LETTER CARRIER.

See POST-OFFICE, 3, 4.

LEX DOMICILII.

See MARRIAGE.

LEX LOCI.

See MARRIAGE.

LICENSE.

See PATENTS, 57 to 62.

LIEN.

1. It is sufficient to give a lien, under

the statute of New York, (2 R. S. 493, § 1,) against a domestic vessel, for money advanced for supplies furnished to her in her home port, that the items of account for such advances amount in the aggregate to \$50. It is not necessary that each item should amount to \$50. *The St. Mary*, 329

2. Where S., having a claim against F. for \$5,000, as the balance of \$12,000, purchase-money of a vessel, took a bill of sale of the vessel from F., with power to sell her and pay himself said balance, and at that time W. had a claim against F., for disbursements for stores and supplies for the vessel and for a commission for services in fitting the vessel for sea and procuring freight and passengers for her, of which claim S. had knowledge at the time: *Held*, on a libel *in rem* filed by W. to recover his claim, that S. was entitled to payment of his claim for the balance of the purchase-money, before W. could receive any part of his claim, but that W.'s claim had priority over a claim by S. for disbursements made by him, after taking said bill of sale, in fitting the vessel for sea. *id.*

3. The terms of the bill of sale, considered. *id.*

4. The rule in respect to maritime liens against vessels for supplies and materials furnished to her master at a foreign port is, that the party first instituting legal proceedings for the purpose of enforcing his claim against the vessel, is entitled to satisfaction out of the proceeds of her sale. *The Globe*, 427

5. The true meaning of a maritime lien is, that it renders the property liable to the claim without a previous judgment or decree of the Court sequestering or condemning it, or establishing the demand, as at common law, and the action *in rem* carries it into effect. *id.*

6. The appropriation of the property to that end becomes absolute and exclusive on suit brought, unless superseded by some pledge or lien of paramount order. *id.*

7. The first action by which the property is seized is entitled to hold it as against all other claims of no higher character. *id.*

8. The *lien*, so termed, is, in reality, only a privilege to arrest the vessel for the demand, which, of itself, constitutes no incumbrance on the vessel, and becomes such only by virtue of an actual attachment of the same. *id.*

9. G. filed a libel *in rem* in the Admiralty in New York, under the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 726,) against a vessel, to recover for supplies and materials furnished to her in New York, as a foreign vessel, owned in Michigan. Before the filing of the libel, she had been sold in Ohio upon a judgment recovered in a State Court in Ohio, for supplies and materials furnished to her by C. subsequently to the time when G. furnished his supplies and materials. The Ohio judgment was recovered in a proceeding *in rem* against the vessel by attachment under a law of Ohio, she being then also a foreign vessel, owned in Michigan: *Held*, that the priority of time in the furnishing of the supplies and materials by G. gave him no paramount lien on the vessel over the lien of C. *id.*

See CARRIER, 1 to 4.
JUDGMENT, 1 to 4.
RENTS AND PROFITS.

M

MAIL.

See POST-OFFICE, 10.

MAIL-CARRIER.

See POST-OFFICE, 1, 3, 4.

MANIFEST.

See REVENUE LAWS.

MANSLAUGHTER.

See STEAMBOATS.

MARINE INSURANCE.

See INSURANCE.

MARRIAGE.

1. As a general rule, the capacity or incapacity to marry depends on the law of the place where the marriage is contracted, and not on the place of the domicil of the parties. *Ponsford v. Johnson*, 51

2. Prior to 1826, P. was married in New York to H., who, in that year, obtained from the Court of Chancery of New York a decree of divorce on account of the adultery of P. The decree dissolved the marriage, and freed each of the parties from the obligations of the same. The Act under which the divorce was granted provided, that the party convicted of adultery should not marry until the other should be actually dead. In 1837, while H. was still living, P. and A., both then residing in New York, were married to each other in New Jersey, in due form and according to the laws of that State. A. then knew nothing of the divorce or of H., and had only heard that P. had had a wife who was dead. A. was married in New Jersey in compliance with the wishes of P., and with no intention on her part of evading any law of New York. P. died in 1845, intestate, domiciled at the time in New York. Under the laws of New York, A., if his widow, was entitled to a share of his personal estate. The defendant J. obtained administration in New York on P.'s estate, and received assets to a large amount, but refused to pay any portion of them to A. A bill filed by A. to compel such payment, having been demurred to on the ground that the marriage between P. and A. was void: *Held*, that the decree of divorce was an absolute dissolution of the marriage contract as to both parties; that the disability to marry imposed by the

statute of New York attached to P., by way of penalty, only within that State; that the marriage between A. and P. in New Jersey was valid; that A. was entitled to all the rights of the lawful widow of P. under the laws of New York; and that J. was bound to pay over to her her share of P.'s estate. *id.*

3. *Semble*, that the validity of the New Jersey marriage would not have been affected if both parties had resorted to that State to evade the prohibitory law of New York. And clearly, where one party was innocent and ignorant of such purpose, the *mala fides* of the other could not impeach the marriage, if it was lawful in other respects. *id.*

MASTER

See STEAMBOATS.

MEASURER.

See DUTIES, 27.

MONEY HAD AND RECEIVED.

1. R. B. & Co., a copartnership, acted, by mutual agreement, as the selling agents of the Burlington Mills Co., a manufacturing corporation. The copartnership of R. B. & Co. was dissolved, and a new firm constituted, under the same style and consisting in part of the same members. The new firm assumed and continued the business of the old firm, acting as the selling agents of the corporation under the same agreement which existed with the old firm. The corporation, by its treasurer, requested the new firm to pay and adjust the balance due from the corporation to the old firm and charge it, in their account, to the corporation. They did adjust it accordingly, and the old firm credited the corporation with the amount of the balance, as received of the new firm, and rendered their account to the corporation balanced by the credit in full: *Held*, that it must be inferred that

this balance was discharged by the payment of money or what was equivalent thereto; that the corporation thereby became debtors to the new firm for the amount; and that it might be recovered by them, in an action for money had and received or for money paid and advanced. *Bradley v. Richardson*, 343

2. The treasurer, being not merely the keeper of the money of the corporation, but empowered by the directors to borrow money in the name and for the use of the corporation, and having a general authority given him by the by-laws to pay the debts of the corporation: *Held*, that he had sufficient authority to give the assent of the corporation to the transaction by which the balance due to the old firm was thus paid. *id.*

3. *Held, also*, that it could not be objected against the validity of the transaction that the treasurer was a member both of the old and the new firm, that fact being fully known to the corporation. *id.*

4. An account having been rendered to the corporation, stating the balance, the payment of it and by whom it was paid, and no objection having been made at the time or afterwards, until a suit was commenced against the corporation by the new firm to recover the amount due to them: *Held*, that the transaction must be deemed to have been acquiesced in by the corporation. *id.*

MONEY PAID AND ADVANCED.

See MONEY HAD AND RECEIVED.

MULTIFARIOUSNESS.

See DEMURRER, 3, 4.

MURDER.

1. Where a person is present, actually or constructively, at a murder, aiding and abetting it, that is sufficient, both at common law and under the statutes of the United States, to

warrant his conviction under an indictment charging him with the murder, though containing no count charging him with only being present at the murder, aiding and abetting it. *The United States v. Douglass*, 207

2. The Acts of Congress of April 30th, 1790, (1 *U. S. Stat. at Large*, 114, § 10,) and of March 8d, 1825, (4 *Id.* 115, § 4,) do not make the aiding and abetting an act of murder by personal presence and assistance, a separate and distinct offence. *id.*

See EVIDENCE, 1.

MUSICAL COMPOSITION.

See COPYRIGHT, 3.

N

NAVIGATION LAWS.

See SEIZURE.

NAVY.

See SALVAGE.

NEGLIGENCE.

See COLLECTOR.
PATENTS, 39.

NOVELTY.

See PATENTS, 6, 11, 118, 126 to 133, 137.

P

PARTIES.

See JURISDICTION.
PATENTS, 62.
PRACTICE, 26 to 28.

PARTNERSHIP.

See PRACTICE, 28.

PASSENGER.

See CARRIER, 1 to 4.

PATENTABILITY.

See DISCOVERY, 15.
PATENTS, 1, 2, 6, 7, 9.

PATENTS.

1. Invention. (1 to 10.)
2. Novelty. (11.)
3. Utility. (12.)
4. Validity.
5. Combination. (13.)
6. Abandonment. (14 to 26.)
7. Specification. (27 to 34.)
8. Drawings. (35 to 37.)
9. Disclaimer. (38 to 41.)
10. Extension. (42 to 44.)
11. Assignment. (45 to 56.)
12. License. (57 to 62.)
13. Infringement. (63 to 75.)
14. Declaration. (76 to 84.)
15. Defence. (85 to 87.)
16. Trial. (88 to 90.)
17. Evidence.
18. Damages. (91 to 109.)
19. Injunction. (110 to 113.)
20. Interfering Patents. (114 to 117.)
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22. Particular Patents.
 - (1.) Montgomery and Harris'—Bark-Mill. (119 to 123.)
 - (2.) McCormick's—Reaping Machine. (124.)
 - (3.) Foote's—Stove-Regulator. (125 to 133.)
 - (4.) Ide's—Cultivator. (134 to 136.)
 - (5.) Winans'—Eight-wheeled Car. (137 to 140.)
 - (6.) Woodworth's—Planing Machine.
 - (7.) Blanchard's—Turning Irregular Forms. (141, 142.)

1. Invention.

1. A formal change, such as a change of proportions, a mere change of form, or a different shape, is not, within the meaning of the patent law, a change sufficient to support a patent; but the improvement upon the old contrivance must embody some originality, and something substantial in the change, producing a more useful effect and operation. *Hall v. Wiles*, 194
2. In determining the question of pat-

- entability, the jury have a right to take into consideration, in connection with the change, the result which has been produced; because the result, if greatly more beneficial than it was with the old contrivance, reflects back, and tends to characterize in some degree the importance of the change. *id.*
3. The presumption of law is, that a patentee was the inventor of that which he patented, and the burden is thrown on the defendant to disprove the fact. *Pitts v. Hall*, 229
4. A person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embodied in his improvement. *id.*
5. But, in order to invalidate a patent on the ground that the patentee did not conceive such idea, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement completely and perfectly. *id.*
6. In an action for the infringement of a patent, it being objected, that the arrangement of machinery claimed in the patent was so simple and obvious as not to be the subject of a patent: *Held*, that novelty and utility in an improvement are the only conditions requisite to the granting of a patent. *McCormick v. Seymour*, 240
7. Where a party has discovered a new application of some property in nature, never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying the new property. *Foot's v. Silsby*, 260
8. Hence, the inventor has a right to use any means, old or new, in the application of the new property to produce the new and useful result, to the exclusion of all other means. *id.*
- 8a. The case of *Neilson v. Harford*, (*Weber. P. C.* 295,) cited and approved. *id.*
9. A mere abstract conception cannot be the subject of a patent; but, when it is reduced to practice, by any means, old or new, resulting usefully, it is the subject of a patent, independently of the machinery by which the application is made. *id.*
10. In the case of such a patent, although old means be used by the patentee for giving application to the new conception, yet the patent excludes all persons other than the patentee from the use of those means, and of all other means, in a similar application. *id.*
- See 184.
2. *Novelty.*
11. On a question of the novelty of an improvement in a reaping machine, the inquiry for the jury is, whether the alleged prior invention is identical with the plaintiff's, or whether his involves a new operation and produces a new effect on the standing or tangled grain, in the use of the machine. *McCormick v. Seymour*, 240
- See 6, 113, 126 to 133, 137.
3. *Utility.*
12. On the point of the utility of an invention, the question is not, whether the machine invented is the best one known to the community, nor whether it does its work better or faster than any other machine in the same department of labor, but whether it is, to a certain degree, useful. *Wilbur v. Beecher*, 132
- See 6, 120, 127, 133, 140.
4. *Validity.*
- See 29 to 34, 38 to 41.
DISCOVERY, 15 to 17.

5. *Combination.*

13. Where one part of a combination is new, the combination is a new one, though the other parts of the combination may be old. *Hall v. Wiles*, 194

See 63, 73, 74, 130 to 133, 141, 142.

6. *Abandonment.*

14. An inventor may *forfeit* his right to an invention by using it publicly, or by vending it to others to use, at any time prior to the period of two years before his application for a patent. *Pitts v. Hall*, 229

15. Such use must be a use by the patentee himself, publicly, in the ordinary way of a public use of a machine, and not a use for experiment or trial, with a view to test its operation or ascertain its defects. *id.*

16. A forfeiture of an invention is not favored in law; and, where a use is relied on as having worked a forfeiture, the evidence should be quite clear that the use was not by way of experiment, or for the purpose of perfecting the machine. *id.*

17. An inventor may *abandon* his invention, or dedicate it to the public, at any time before procuring his patent. *id.*

18. But the mere use or sale of the invention by the patentee within two years before his application for a patent, will not alone or of itself work an abandonment. There must be, in addition, some declaration or act going to establish an intention on his part to give to the public the benefit of his invention. *id.*

19. Declarations of a determination not to take out a patent, but to let the public have the invention, will estop the party making such declarations, and any one holding under him, from afterwards asserting his right against any one who acts on the faith of them. *id.*

20. But declarations of an intention to

dedicate an invention to the public, will not be regarded as equivalent to an actual dedication. Besides words, there must be acts, in order to fasten on a patentee the intention which, in judgment of law, will work an abandonment of his invention. *id.*

21. Such an abandonment operates in the nature of a forfeiture of a right, which the law does not favor, and must be made out beyond all reasonable doubt. *id.*

22. Since the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 353,) a patentee may make and vend or use his invention within two entire years before the time when he applies for a patent, without forfeiting or necessarily abandoning his right to a patent; but, if he either sells a machine, or uses one, or puts one into public use, at any time more than two years before his application, it works a forfeiture of his rights. *McCormick v. Seymour*, 240

23. The Act virtually extends the patentee's privilege to sixteen years instead of fourteen. *id.*

24. The mere fact that an inventor makes and sells an invention, or puts it into public use, at any time within two years before he applies for a patent, is not, of itself, an abandonment of the invention to the public. *id.*

25. Something more must be done within the two years—there must be some acts of the inventor, indicating an intention on his part to devote his improvement to the public in general—in order to authorize a jury to come to the conclusion that he has so abandoned it. *id.*

26. Those who rely upon the ground that a party has forfeited a legal right secured to him in due form of law, for the purpose of defeating his enjoyment of that right, must make out the point clearly and satisfactorily, beyond any reasonable doubt or hesitation; because, the law does not favor an abandonment, and throws upon the party who seeks to

obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. *id.*

See 89, 140.

7. Specification.

27. It is the province and the duty of the Court to settle, as a question of law, the meaning of the specification of a patent, and, if that cannot be ascertained satisfactorily upon its face, the patent is void for ambiguity. *Emerson v. Hogg*, 1

28. Accordingly, where it was objected, upon the face of the specification of a patent for improvements in the mode of propelling vessels, that it was uncertain whether the patentee claimed a *wheel* constructed *spirally*, or only *spiral paddles* attached to a wheel, and the Court instructed the jury that the question whether the specification was ambiguous in the particular charged was one compounded of law and fact, and that, if the jury should find that a *spiral wheel* and a *spiral propeller* were the same thing in ordinary acceptance, then the specification was sufficiently certain in that respect: *Held*, that the instruction was erroneous. *id.*

29. A patent embracing several distinct inventions is valid, where they are capable of being used in connection, and to subserve the same common end. *id.*

30. But their actual employment together is not required to sustain the validity of the patent, and the wrongful use of either invention separately is a violation of the patent *pro tanto*. *id.*

31. Where a patent contained three claims, viz.: (1.) A mode of converting the reciprocating motion of a piston into a continued rotary motion, by a new combination of machinery; (2.) An improved spiral propelling-wheel; and (3.) The application of a revolving vertical shaft to the turning of a capstan on the deck of a vessel; and it appeared from the specification that the

three inventions were contrived with the view of being used conjointly, and as conducing to a common end, in the better propelling and navigating a ship: *Held*, that the patent was valid. *id.*

32. *Held*, also, that the fact that the three inventions were capable of being used separately and independent of each other, did not prevent their being embraced in one patent. *id.*

33. If a patent describes an invention and how it is to be applied, it is not necessary, in either the specification or the drawing, to describe or delineate the old machinery with which the new contrivance is to be connected, when no change in its form or proportions enters into the new invention. *id.*

34. Under the act of February 21st, 1793, (1 *U. S. Stat. at Large*, 322, § 3,) it is sufficient for the patentee to put on file, with his specification, drawings and written references, without their being mentioned in the specification; and, if the references are written on the drawings, the terms of the act are complied with. *id.*

See 35 to 37, 121, 124, 125, 129, 130, 137 to 139, 141.

8. Drawings.

35. A patent, which was issued in 1834, had no drawings originally annexed to it, and the specification contained no reference to any drawings. The patent was recorded anew in June, 1837, under § 1 of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 191,) and a drawing of the invention, verified by the oath of the patentee under said § 1, was filed in November, 1838: *Held*, in an action for the infringement of the patent, that a certified copy of such drawing was admissible in evidence under § 2 of said Act, in connection with certified copies of the patent and specification, and that the whole together were *prima-facie* evidence of the particulars of the invention and of the patent granted therefor. *Winans v.*

The Schenectady and Troy Railroad Co., 279

86. As a general rule, such a drawing cannot be used to correct any material defect in the specification, unless it corresponds with a drawing filed with the original specification for the patent; otherwise, in case of discrepancy, the specification must prevail. *id.*

87. Nor can such a drawing have the same force and effect as if it had been referred to in the specification, nor is it to be deemed and taken as part of the specification. *id.*

See 33, 34, 88, 89, 139.

9. *Disclaimer.*

88. Where a patent contains several claims, and the invention covered by one of them is not new, the patentee may, under the 7th and 9th sections of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 193, 194,) maintain an action for the infringement of the patent, so far as regards the valid claims, although he did not, before the commencement of the action, make or record a disclaimer of so much of the thing patented as he claimed without right; but he will not be entitled to costs. *Hall v. Wiles*, 194

89. Under the 9th section of the Act, the question whether there has been unreasonable negligence or delay on the part of the patentee in entering such disclaimer, is a question which goes to his right of action. *id.*

40. A disclaimer is necessary only where the thing claimed without right is a material and substantial part of the thing patented. *id.*

41. Where the thing claimed without right is a part of a machine, if it is not an essential part, and was not introduced into the patent through the wilful default of the patentee, or with intent to defraud or mislead the public, the want of a disclaimer in regard to it affords no ground for invalidating the patent. *id.*

10. *Extension.*

42. Where an application for the extension of a patent under § 18 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 124,) was pending at the time of the passage of the Act of May 27th, 1848, (9 *Id.* 231,) which conferred upon the Commissioner of Patents alone the same authority to extend patents which had previously been confided to the Board created by the Act of 1836: *Held*, that it was not necessary to renew the application, but that the Commissioner was authorized to go on with the proceedings, as having been properly instituted, and complete them by granting the extension. *Colt v. Young*, 471

43. Where the Commissioner of Patents has jurisdiction over an application for the extension of a patent, his decision is conclusive as to the regularity of the proceedings on the extension. *id.*

44. The only exception to the conclusiveness of his decision is, perhaps, the case of fraud. *id.*

See 50 to 55, 61.

11. *Assignment.*

45. Under the Patent laws of the United States, an assignee of a patent must be regarded as acquiring his title to it, with a right of action in his own name, only by force of the statute. *Suydam v. Day*, 20

46. Such exclusive right of action exists in favor of a sole assignee only in two cases, namely, where he acquires, by assignment, the whole interest in the patent, or a grant or conveyance of the whole interest within some particular district or territory. *id.*

47. Under §§ 11 and 14 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121, 123,) an action is given only to such party, (composed of one or more persons,) as possesses the whole interest. *id.*

48. The subject-matter of a patent is

not partible except in respect to territorial assignments. *id.*

49. Where a patent was granted for an improvement in the mode of preparing india-rubber with sulphur "for the manufacture of various articles," and S. became the assignee of the exclusive right to use the improvement "in the manufacture of shirred or corrugated india-rubber goods:" *Held*, that S. could not maintain an action in his own name alone for an infringement of his right by the manufacture of such goods. *id.*

50. To enable an assignee of a patent to derive any benefit from a subsequent extension of the patent by Act of Congress, there must be an express provision in the assignment looking to such renewal. *Gibson v. Cook*, 144

51. Under § 11 of the Patent Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) the assignment of an exclusive right in the patent within a given territory must not only be in writing, but must be recorded within three months after its execution, to defeat the title of a subsequent purchaser without notice and for a valuable consideration. *id.*

52. Within three months, an unrecorded prior assignment would prevail; but it must be an assignment in writing, that may be recorded within the time limited. *id.*

53. An interest in a grant of a future term of a patent not yet *in esse*, is not the subject of assignment at common law, or within the sense of § 11 of the Act of July 4th, 1836, and the right to such an interest, when stipulated for, rests only in contract. *id.*

54. As between the right of a person holding a contract for such an interest, and the right of a *bond-fide* purchaser, for a valuable consideration and without notice, of the same interest in the future term, after its grant, the latter must prevail. *id.*

55. The party setting up such a contract, by way of equitable defence to

the legal title to the same interest, must deny that the plaintiff is a *bond-fide* purchaser for a valuable consideration without notice, and must assume the burthen of impeaching the legal title. *id.*

56. Where W. granted to V. an exclusive right to construct and use and vend to others to construct and use ten *planing, tonguing and grooving* machines under the Woodworth patent within a particular territory, and the grant declared that V. was to enjoy an exclusive use of the patent within the territory, limited to said ten machines: *Held*, that the entire interest in the patent for that territory was thereby vested in V., and that a subsequent grant by W. to R. of the exclusive right under the patent, for the same territory, to make, use and vend *moulding planing machines*, was void. *Ritter v. Serrell*, 379

See 85, 111, 112, 114.

12. License

57. A license given by W., the patentee, to C., to use six patented planing machines, recited that C. desired a license to use the machines in a certain county, "on the conditions hereinafter mentioned," and then granted to C. permission to use the six machines within the county, "and also, within said limits, to dispose of the plank or other things dressed and prepared on the said machines;" it further provided that W. should not permit any other person than C. to use the machines within the county, and that C. should not use more than six machines there, "nor use any such machines, nor sell and dispose of any plank or other thing dressed and prepared in such machines, anywhere else within the United States;" and it concluded thus: "It is understood that said C. has all the rights I (W.) have in said county, under said patent, to use six machines, and no more:" *Held*, that the sale of the products of the machines was restricted within the county, and that there was nothing in the prior clauses of the license

- necessarily repugnant to the last one.
Woodworth v. Cook, 151
58. But, where it appeared that the actual agreement between W. and C. at the time was, that C. was not to be restricted as to place in selling the dressed plank, and that the last clause in the license was especially inserted for that purpose, a Court of Equity would, probably, on a proper application, direct the contract to be reformed by the insertion of a clause to the effect claimed. *id.*
59. Under the license in this case, W., on a breach by C. of the condition as to the sale of the products of the machines, had a right to avoid the contract, and to be remitted to his original rights, and to prosecute C. for an infringement of the patent. *id.*
60. But C. also is remitted to his original position and rights; for the contract must be avoided altogether, if at all. *id.*
61. And C. may set up any right he had prior to the license, to use the machines; as, for instance, where the right granted by the license was for an extension of the patent under § 18 of the Patent Act of July 4th, 1836, he may set up a right, under the decision in *Wilson v. Rousseau*, (4 How. 646,) to use the machines as having been in use when the first term of the patent expired. *id.*
62. In a suit in Equity against C., to take advantage of a breach of said condition of the license, W. is properly joined as a plaintiff with G., although the latter owns the whole of the beneficial interest in the subject-matter; because W. was a party to the license, and, for aught that appears, is yet the owner of a portion of the interest in the patent, and, as such, interested in upholding it, and may be interested indirectly in the infringement itself. *id.*
13. *Infringement.*
63. In this case it was *Held*, that the thing patented, namely, a carriage in a brick-press, was not a combination of materials, within the doctrine of the patent law, and that the principle, that unless the defendant had taken the whole of the combination he was not liable, did not apply. *Hall v. Wiles*, 194
64. On the point of infringement, the inquiry is, whether the defendant's machine involves, in its construction, some new idea not to be found in the plaintiff's, or whether the plan of the former is in substance the same as that of the latter, the differences introduced in the former being merely differences in things not material or important. *McCormick v. Seymour*, 240
65. If the defendant has taken the same general plan and applied it for the same purpose, though he may have varied the mode of construction, he will only have introduced mechanical equivalents, and it will still be, substantially, and in the eye of the patent law, the same thing. *id.*
66. The proper tests for determining the identity of one machine with another, on the question of infringement, defined. *Blanchard v. Beers*, 411
67. The rules of law for determining the question of identity between two machines, stated. *Tatham v. Le Roy*, 474
68. Effect of a mere change in form or proportions, or of the mere substitution of one mechanical equivalent for another. *id.*
69. Tests for determining what is a substantial change in a machine. *id.*
70. Where the plaintiff was the first to apply a hollow ram sliding upon a core in a cylinder to the making of lead pipe by pressure, (a cylinder sliding upon a rod not being new in machinery,) and, in his patent, claimed as his invention the constructing of the ram hollow, so as to slide upon the core, and the combination of the same with the core: *Held*, that the mere use of a hollow ram in combination with a core, in a machine for making lead pipe by pressure, would not be an infringement of the patent, but that there must be a use of such combination, in such a machine, in substantially the same way in which the plaintiff had applied it. *id.*

71. Where the change from a patented machine produces an effect, in the operation of the machine, different in kind, such difference in effect is evidence of a substantial change, although, without connecting the new effect with the change, the change might be only formal and unsubstantial. *id.*
72. But such new effect, in order to give materiality to an apparently formal change, must not consist in merely doing more work in a given time or in merely requiring less power. These results, if found, must follow from the different effect in kind. *id.*
73. Where a patent was granted for an improvement in making friction matches, the invention being only a new combination of old materials before used in making such matches, and consisting in a composition formed of phosphorus and earthy material and a glutinous substance only, without chlorate of potash, or any highly combustible material, in addition to the phosphorus: *Held*, that it was no infringement to use any one or all of the materials forming the composition, in making matches, provided they were not used in the combination patented, or to use them for such purpose in combination with chlorate of potash, as they were formerly used. *Byam v. Eddy*, 521
74. But a mere colorable difference, or slight variation in the combination, will not exempt a person from the charge of infringement. *id.*
75. Where a defendant, four months before the service of an injunction on him, had executed a bond to the plaintiff, acknowledging the validity of his patent, and his right to all that was granted by it: *Held*, that the bond was no evidence of a breach of the injunction, further than the recital in it, that the defendant had infringed the patent, might have a tendency to establish such breach; and that the inference or presumption arising from it might be overcome by credible and positive testimony, proving no infringement. *id.*
- See* 10, 30, 38, 49, 59, 62, 82, 90, 108, 109, 111, 11 2, 122, 123, 134 to 136, 142.
- DISCOVERY, 15.
- PRACTICE, 5, 6.
- VERDICT.
14. *Declaration.*
76. In a declaration on Letters Patent for an invention, it is not necessary to aver at what specific time the invention patented was made; it need only be before the application for the patent. *Wilder v. McCormick*, 31
77. The grant of Letters Patent is itself sufficient evidence that all the preliminary steps required by law were properly taken by the patentee; and it is not necessary, in a declaration on a patent, to plead the taking of any of those steps. *id.*
78. A declaration on a patent must tender an issue on the novelty and utility of the discovery patented, but it need not show the regularity of the proceedings in the Patent Office preliminary to the grant. *id.*
79. The authority of the Commissioner of Patents in granting a patent is not of the nature of *jurisdiction*, in its common law acceptation, and the doctrine appertaining to the judgments of tribunals of inferior jurisdiction, when pleaded, is not applicable to his acts. *id.*
80. A declaration on a patent, which avers the patent and specification to be "in language of the import and to the effect following," and then sets them forth *in hæc verba*, is sufficient, and is not open to the objection that the patent is not set forth according to its legal tenor and effect. *id.*
81. An averment that the patent and specification are "ready in Court to be produced," is equivalent to a *profert* in its most formal terms. *id.*
82. A reiteration of infringements of a patent may be sued for in one action. *id.*
83. A declaration for the infringement of a patent, commencing in *case*, and

concluding by demanding *actual damages* in gross in compensation of the wrong, is good. *id.*

84. Where a declaration on a patent, though not formal, embodies all that is essential to enable the plaintiff to give evidence of his right and of its violation, and affords to the defendant the opportunity to interpose every defence allowed him by law, the Court will not encourage merely critical objections, and will seek, even on special demurrer, to sustain the declaration. *id.*

15. Defence.

85. An American assignee of an alien inventor, who obtains Letters Patent in his own name from the United States, under § 6 of the Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 193,) is not within the alien clause of § 15 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) which requires the patentee, if an alien at the time the patent was granted, to put and continue on sale to the public, on reasonable terms, the invention for which the patent issued. That clause applies only to an alien patentee. *Tatham v. Lowber*, 49

86. It is not necessary, under that clause, for an alien patentee to prove that he hawked the patented invention to obtain a market for it, or that he endeavored to sell it to any person. *id.*

87. But it rests on those who seek to defeat the patent, to prove that the patentee neglected or refused to sell the patented invention for reasonable prices when application was made to him to purchase. *id.*

See DISCOVERY, 15.

16. Trial.

88. Where a patent was issued in 1834, to which no drawing was annexed, but a drawing had been originally deposited in the Patent Office, and the record of the patent and drawing were destroyed by fire in the burning of the Office in December, 1836, and the patentee, under the

Act of March 3d, 1837, (5 *U. S. Stat. at Large*, 191,) restored the record of his patent in May, 1841, but did not file a drawing under § 1 of that Act, verified by oath, until February, 1844, and then, in March, 1844, finding that drawing imperfect, made and swore to and filed a second one, and, in May, 1844, commenced an action for the infringement of his patent: *Held*, that a duly certified copy of the second drawing, as so attested and filed, was admissible in evidence, on the trial of such action, under § 2 of that Act. *Emerson v. Hogg*, 1

89. It being alleged that the patentee had abandoned his discovery, and the lapse of time from the grant of the patent to the commencement of the action being urged as proof of that fact: *Held*, that he was entitled to give evidence of the filing of his drawings, or of any other act done by him in assertion of his right. *id.*

90. Where, in such case, on a motion by the defendant for a new trial, it was objected that the plaintiff was not entitled to damages for infringements committed prior to the re-recording of his patent, the charge of the Court at the trial having imported a general liability of the defendant, and the Court not having been prayed to instruct the jury otherwise, and no exception having been taken to the direction as given: *Held*, that the objection could not now be taken. *id.*

See 27, 28, 91 to 93.

17. Evidence.

See 3, 35 to 37, 88, 89, 91 to 93.
VERDICT.

18. Damages.

91. On the trial of an action for the infringement of a patent for a writing fluid, no proof was given of the cost of the manufacture of the fluid, or of the sale price, but it was shown that sales were highly profitable, and that the defendants had made and sold very large quantities. The defendants gave no evidence of the

- amount of their manufacture and sales, or of the cost or value of the article. The jury found a verdict of \$2,000 for the plaintiff: *Held*, that the verdict must stand, it not being one of palpable extravagance. *Stephens v. Felt*, 37
92. In such a case, a plaintiff is not held to the most exact proof of the amount of his damages, and the jury are warranted in exercising a liberal discretion. *id.*
93. If the defendant prefers to leave the damages to general inference and the estimate of the jury, when he might make their amount reasonably certain by evidence on his part, the finding of the jury will not be interfered with, except in a case of palpable extravagance. *id.*
94. The plaintiff, in a patent suit for making and selling, is entitled to the actual damages he has sustained by the infringement, or, in other words, to the profits the defendant has made thereby; for the law presumes, that if the defendant had not put his machines into the market, the demand would have been for the plaintiff's, and he would have received the profits. *Wilbur v. Beecher*, 132
95. The difference between the actual cost of making a machine and its sale price is not all nominal profit; but the jury must take into account the interest on capital, the risk of bad debts and the expenses of selling, in arriving at the defendant's profits. *id.*
96. The rule of law as to damages, when an infringement is made out, is, to give to the plaintiff the actual loss he has sustained, and nothing more. Exemplary or vindictive damages cannot be given. *Hall v. Wiles*, 194
97. In this case it was *Held*, that the plaintiff was entitled, if his case was made out, to the profits on all the machines sold by the defendant. *id.*
98. In patent cases, the plaintiff is entitled to the actual damages he has sustained in consequence of the infringement of his patent, as contradistinguished from exemplary, vindictive and punitive damages. *Pitts v. Hall*, 229
99. One mode of arriving at the damages is, to ascertain the profits which the plaintiff derives from the machines he makes and sells and which have been made and sold by the defendant. *id.*
100. Another mode is, to ascertain the profits which the party infringing has derived from the machines; but this measure of damages is not controlling, and the plaintiff is entitled to the profits he would have made if not interfered with. *id.*
101. The plaintiff is entitled to interest on the actual damages, from the commencement of the suit. *id.*
102. The general rule as to damages in patent suits is, that the plaintiff is entitled to the actual damages he has sustained by reason of the infringement; and those damages may be determined by ascertaining the profits which, in judgment of law, he would have made, provided the defendant had not interfered with his rights—upon the principle that, if the defendant had not so interfered, all persons who bought his machine would necessarily have purchased the patentee's.* *McCormick v. Seymour*, 240
103. There is no distinction, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine, and the damages, in the latter case, are not to be limited in proportion to the value of the improvement.* *id.*
104. The inventor of an improvement on an old machine, who has a right to use the old machine, is entitled, under a patent for his improvement, to the benefit of the operation of the

* See *Seymour v. McCormick*, (16 How. 480,) as to this point.

machine under all circumstances, with the improvement engrafted upon it, to the same degree in which the original patentee was entitled to the old machine.* *id.*

105. In order to ascertain the net profits on the making and selling of machines, the jury must take into account, as making up the cost and to be deducted from the sale price, the cost of materials and labor, the interest on capital used, the expense of putting the machines into market, such as agencies and transportation and insurance; and, where the article is sold on credit, a deduction must be made for bad debts. *id.*

106. When the actual damages are ascertained, the plaintiff is entitled to interest on them from the commencement of his suit. *id.*

107. The jury may also allow to the plaintiff the damages which he has sustained beyond those arising from the actual interference of the defendant in making and putting into market machines which infringe the patent—such as damages from publications by the defendant, disparaging the plaintiff's improvement, while engaged in violating the patent. *id.*

108. The rule of damages for the infringement of a patent, stated. *Tatham v. Le Roy*, 474

109. Interest, by way of damages, may be given by the jury, in an action for the infringement of a patent. *id.*

See 90.

19. Injunction.

110. Where, on the filing of a bill against K. to restrain him from violating the plaintiff's patent, a provisional injunction was granted, and afterwards the Court allowed a supplemental bill to be filed, bringing in, as a party to the suit, G., who it was alleged had become interested in the subject-matter of the suit since its commencement, and also

allowed new charges in regard to K. to be inserted in the supplemental bill, so as to embrace transactions not covered by the injunction: *Held* that, as the transactions of K. set forth in the supplemental bill were of the same character with those first enjoined, the injunction must be extended so as to include them. *Parkhurst v. Kinsman*, 78

111. It appearing that G., who was so made a party by supplemental bill, was the clerk of K. from the commencement of the suit to the bearing of the application for the injunction against K., and knew of the existence of the suit and of the proceedings for the injunction, and, on the day the application was heard, became assignee of K. of his rights in litigation in the suit: *Held*, on a motion for a provisional injunction against G., that he took the subject-matter assigned to him, with no higher or other rights, as respected the plaintiff, than K. possessed, but was chargeable with the liabilities of K., and did not stand before the Court as an independent infringer. *id.*

112. *Held, further*, that as G. was a sheer volunteer in the controversy, and the mere substitute for K., the like injunction as against K., must issue against him, and that he could not be allowed to give security and keep an account till the hearing. *id.*

113. The defendant was enjoined, before final hearing, from infringing two of the claims of a patent, although it was not held that another claim in the same patent, the novelty of which was disputed, was valid. *Colt v. Young*, 471

See 75, 185.

20. Interfering Patents.

114. Where T., a patentee, and P., his assignee of an undivided interest in the patent, brought a suit in Equity in the Circuit Court of the United States in Louisiana, under § 16 of

* *See Seymour v. McCormick*, (16 How. 480,) as to this point.

the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123,) against D., the patentee of a junior patent, and other parties claiming under him, founded on the interference of D.'s patent with T.'s patent, and praying that D.'s patent might be declared void, and subsequently T. and P. brought an action at law in this Court, for the infringement of T.'s patent, against H., who was not a party to the suit in Louisiana, but who owned an undivided interest in D.'s patent, by title derived from D. after the commencement of the suit in Louisiana, although prior to the rendition of any judgment in that suit: *Held*, that the parties to the suit in this Court were virtually within the proviso to said § 16, and that their rights would be bound by a decision in the suit in Louisiana pronouncing judgment that the two patents interfered, or that either of the patents or any part of them was valid or invalid. *Tyler v. Hyde*, 308

115. But, where H. pleaded in bar the bringing of the suit in Louisiana and the dismissal of the bill therein by the judgment of the Court upon the merits thereof: *Held*, that that judgment did not necessarily import that the patents of T. and D. interfered, or that T.'s patent was adjudged void and inoperative. *id.*

116. In order to be received and acted upon in this Court, as against T.'s patent, and in a trial between other parties, the judgment should have been direct and affirmative in terms, and should have asserted the interference of the patents, and have declared T.'s patent void in the whole or in part, or inoperative and invalid in some particular part of the United States. *id.*

117. Such a judgment would, under the decision in *Smith v. Kernochen*, (7 *Hov.* 198,) have been a bar to the action at law in this Court. *id.*

21. Miscellaneous.

118. The history of improvements in

machinery for making lead pipe by pressure, given. *Tatham v. Le Roy*, 474

22. Particular Patents.

(1.) *Montgomery and Harris'—Bark-Mill.*

119. The invention covered by Montgomery and Harris' patent of the 12th of August, 1840, for an "improvement in the mill for breaking and grinding bark," is a multiplication of the grinding-chambers and apparatus in a mill of a given size, and which may still be driven by the same power as a mill of a single chamber. *Wilbur v. Beecher*, 132

120. It appearing that a mill constructed according to the specification of the patent, with three grinding-chambers, would grind, when not in very rapid operation, say at a speed of 50 or 60 revolutions in a minute, a cord of bark an hour through the day, being double the quantity ground by the old single-chambered mill: *Held*, that that was evidence enough of the utility of the invention. *id.*

121. In this case, the thing discovered and described was the formation of grinding-chambers, by the combination of movable conical rings with stationary cylinders, these two parts being severally brought together and fastened by cross-bars; the particular description in the specification showed a mill with three grinding-chambers; but the claim was to the combination of stationary cylinders with one or more movable conical rings, thus allowing both cylinders and rings to be multiplied to any extent, or the mill to be limited to two cylinders and one ring: *Held*, that any further particular description in the specification was unnecessary, in order to enable a mechanic of ordinary skill to make a mill with more chambers than three. *id.*

122. A bark-mill that multiplies the grinding-chambers by a combination of movable conical rings with stationary cylinders is an infringement of Montgomery and Harris' patent. *id.*

123. The shape of the grinding chambers and the form of the teeth in the mill are no part of the patented combination, and, therefore, although the defendant's mill, by a change in those points, grinds better and faster than the patented mill, yet, if it contains the combination of the movable conical nuts with the stationary cylinders, it is still an infringement. *id.*

(2.) *McCormick's—Reaping Machine.*

124. In *McCormick's* patent of October 23d, 1847, for *improvements in reaping machines*, the claim of "the arrangement of the seat of the raker over the end of the finger-piece, which projects beyond the range of fingers, and just back of the driving-wheel, as described, in combination with and placed at the end of the reel," is not a claim for the seat as a seat, or for its particular mode and form of construction, but is a claim to the arrangement and combination of machinery described, by which the benefit of a seat or position for the raker on the machine is obtained. *McCormick v. Seymour*, 240

(3.) *Foot's—Stove-Regulator.*

125. In *Foot's* patent for an "improvement in regulating the draft of stoves," the first claim, being a claim to "the application of the expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue," is a claim independent of any particular arrangement or combination of machinery or contrivance for the purpose of applying the principle to the regulation of the heat of stoves. *Foot v. Silsby*, 260

126. The novelty of the invention covered by said first claim, can be defeated only by showing the prior application of the expansion and contraction of the metallic rod to regulate the heat of a stove, by means of the heat produced by the stove itself. It is not defeated by showing a prior application of the expansion and con-

traction of a metallic rod to open and close a damper, where the metallic rod was heated *indirectly* by the heat of a furnace, by being immersed in hot water. *id.*

127. But the prior application, in order to defeat the novelty of the said first claim, need not have been made by the very best apparatus that could be devised. The question does not depend upon the degree of usefulness, but upon the practically useful and successful prior application of the principle. *id.*

128. Where, prior to the plaintiff's invention of the application covered by the said first claim, the principle of the expansion and contraction of a metallic rod heated by the stove itself, had been applied to regulate its heat, the rod being, however, a compound rod, composed of a slip of brass and a slip of iron, firmly fastened together, and the motion of the damper being produced through a deflection of the rod resulting from its curvature, caused by the unequal dilatation, under a given degree of heat, of the two metals composing it, that of brass being greater than that of iron, whereas, in the plaintiff's invention, the motion was produced by the direct linear expansion of a brass rod used in connection with an iron stove: *Held*, that the principle of the application of the expansion and contraction of the metallic rod to regulate the damper, by causing it to open and close according to the degrees of heat in the stove itself, as covered by the said first claim, was the same in the two applications. *id.*

129. The said first claim does not involve any mode or method of application, or any question of difference in degree—as that an apparatus having the linear expansion as distinguished from curvature, possesses greater power or can perform what the other cannot. *id.*

130. The third claim of the patent, being a claim to "the combination, above described, by which the regulation of the heat of a stove in which it may be used is effected," *Held* to be a claim for a combination, consisting of four parts, specifically defined. *id.*

131. Though the parts separately may all be old, yet, if the plaintiff was the first to combine all four of them, for the particular purpose of regulating the heat of a stove by means of its own heat, he is entitled to be protected in that improvement. *id.*

132. The novelty of the said third claim is not defeated by showing a prior combination of the same four parts, in which the expansion and contraction of the metallic rod were produced by its immersion in hot water, and not directly by the heat of the stove itself whose heat was to be regulated. *id.*

133. The prior combination, to defeat the novelty of said third claim, must have been an apparatus of practical utility, and must have embraced all the elements embraced in the plaintiff's combination. *id.*

(4.) *Ide's—Cultivator.*

134. Where a patentee of an improvement in cultivators claimed in his patent "the arrangement of the teeth in two rows, in combination with a pair of wheels the treads of which are in a line midway between the points of the two rows of teeth, substantially as described," and, in his specification, described the nature of his invention as consisting in the arrangement of the teeth in two rows, one back and the other front, when this was combined with a pair of sustaining and carrying wheels the bearing points of which were in a line midway between the two rows of teeth, so that any tendency which one row of teeth might have to cut too deep was resisted by the weight of earth on the other row, the tread of the wheels between them acting as the fulcrum, so that the team, by this means, was entirely relieved of any strain which they otherwise would have to sustain in consequence of the motion of the beam up and down as the teeth ran too deep or too shallow, and stated that by that arrangement the necessity for guiding handles and the employment of four wheels were entirely dispensed with, and also described the teeth as seven in number, arranged in two

straight rows, three teeth in one row and four in the other, the points of the three teeth being in front of the line of the wheels, and the points of the four teeth being behind the line of the wheels: *Held*, that a cultivator which differed from that described in the patent only in having the axle of the wheels thrown forward and the hind teeth thrown backward so far that the tread of the wheels was not midway between the points of the two rows of teeth, (which increased the leverage behind and reduced the strain on the horses still more than in the plaintiff's arrangement,) and in having the middle tooth of the forward three moved forward, and the two middle teeth of the four behind also moved forward, so that the two rows were not straight, infringed the patented combination; that the infringing machine contained the principle and substance of the patented invention, merely carrying it out further in practice than had been done by the patentee when he took out his patent; and that the infringing arrangement was not in law even an improvement on that of the patentee, because it was only the result of practical experience in the use of the patentee's arrangement, and involved no invention beyond what was embodied in that and was clearly set forth in the specification. *Tracy v. Torrey*, 275

135. *Held*, also, that the case was a proper one for a provisional injunction; and that, the infringement being clear, and the right to the injunction manifest, the injunction ought not to be stayed on the defendant's giving security to the plaintiff and rendering a periodical account of sales, although the defendant was a man of pecuniary responsibility. *id.*

136. *Held*, also, that another machine which differed from the former infringing machine in having the middle tooth of the forward three set back instead of forward, thus bringing the points of two teeth forward of the wheels and the points of five teeth behind the wheels, infringed the patented combination. *Chamberlain v. Ganson*, 279

(5.) *Winans'—Eight-wheeled Car.*

137. The claim of Winans' patent, granted October 1st, 1884, for an "improvement in the construction of cars or carriages intended to run on railroads," which claim is "the before-described manner of arranging and connecting the eight wheels, which constitute the two bearing-carriages, with a railroad car, so as to accomplish the end proposed by the means set forth or by any others which are analogous and dependent upon the same principles," is a claim for the car itself constructed and arranged as described in the patent, and evidence that parts of the arrangement and construction were before known does not affect the novelty of the invention. *Winans v. The Schenectady and Troy Railroad Co.*, 279

138. The location of the trucks relatively to each other under the body of the car, as well as the near proximity of the two axles of each truck to each other, form an essential part of the arrangement of the patentee, who states, in his specification, that the closeness of the fore and hind wheels of each truck, taken in connection with the use of two trucks arranged as remotely from each other as can conveniently be done for the support of the car-body, with a view to the objects and on the principles set forth by him, is considered by him as an important feature of his invention. But the improvement does not consist in placing the axles of the two trucks at any precise distance apart, or at any precise distance from each end of the body; and the specification is sufficient, although it does not state in feet or inches the exact distance from the ends of the car-body at which it would be best to arrange the trucks, or what should be the exact distance between the axles. *id.*

139. The specification of Winans' patent said nothing about the mode of attaching the car to the motive-power or to the next car in a train, nor anything about the use of side-bearings to prevent the rocking of the car from side to side, but the drawing

filed in November, 1888, showed that the car was to be attached to the motive-power and to the next car in a train by its body, and not by a perch from the truck, and also showed a provision for side-bearings: *Held*, that the specification afforded a sufficient description of the invention independently of the drawing, and that the mode of attaching the car and the use of side-bearings did not enter into the essence of the invention or constitute any substantial part of the improvement. *id.*

140. The law allows an inventor a reasonable time to perfect his invention by experiment and ascertain its utility, before it obliges him to take out his patent; and, in the case of Winans' invention, experiments could be made only by putting the car into the service of those controlling lines of railroads. In applying the rule, a jury must take into consideration the nature of the invention, and all the circumstances of the case. But an inventor is bound to act in good faith, and must not suffer his invention to be used except for the purposes of experiment. *id.*

(6.) *Woodworth's—Planing Machine.*

See 56.

(7.) *Blanchard's—Turning Irregular Forms.*

141. The claim in Thomas Blanchard's patent of January 20th, 1820, for "a machine for turning and cutting irregular forms," construed and defined. *Blanchard v. Beers*, 411

142. A person who uses the combination claimed by Blanchard, though in a machine which will make only wagon-spokes, infringes the patent. *id.*

PENALTY.

See DISCOVERY, 1 to 5, 18, 14.
DUTIES, 7, 18, 21, 26, 51.
MARRIAGE, 2, 3.

PERU.

See DUTIES, 54.

PETITION.

See PRACTICE, 9 to 12.

PILOT.

See STEAMBOATS, 2, 3.

PLEADING.

1. Where a bill in Equity against three defendants showed title in the plaintiff to a copyright, and a wrongful violation of it by all the defendants, and injuries inflicted and apprehended from such violation, and prayed for an injunction against all the defendants, and also for a discovery from all in aid of a suit at law against one for the same violation: *Held*, on general demurrer to the whole bill, that the relief by injunction was not dependent on the discovery prayed, and that, although the bill was bad as a bill of discovery, yet it was good as an injunction bill, and that the demurrer must be overruled. *Atwill v. Ferrett*, 89

2. A general demurrer to the whole bill must be overruled if any independent part of the bill is sufficient. *id.*

3. Nor will a formal protestation accompanying the demurrer avoid the force of the rule. *id.*

See COPYRIGHT, 4.

DEMURRER.

DISCOVERY.

INSURANCE, 6, 7.

MARRIAGE, 2, 3.

PATENTS, 55, 62, 76 to 84, 115, 116.

PRACTICE, 7, 8, 81.

POLICY.

See INSURANCE.

POST-OFFICE.

1. The 22d section of the Post-Office Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 108,) which makes it an offence for any person to open any letter which shall have been in a Post-Office, or in the custody of a mail-carrier, before it shall be delivered to the person to whom it is directed, with a design to obstruct the correspondence, and for any person to secrete, embezzle or destroy any such letter, does not look beyond a possession of letters obtained *wrongfully* from the Post-Office or from a mail-carrier. *The United States v. Parsons*, 104
2. After the voluntary termination of the custody of a letter by the Post-Office or its agents, the rights of the real proprietor of the letter are under the guardianship of the local law, and not of that of the United States. *id.*
3. Where a letter, mailed at Boston and directed to a person at New York, reached the Post-Office there, and was taken by a letter-carrier for delivery: *Held* that, under § 41 of the Act of July 2d, 1836, (5 *U. S. Stat. at Large*, 89,) such letter-carrier was a mail-carrier within § 22 of the said Act of March 3d, 1825. *id.*
4. But, the letter-carrier having given the letter to a person in the defendant's house, the defendant not being present, and not participating in the delivery, and that person having subsequently and at a different place delivered it to the defendant, and the defendant having opened it and embezzled money from it, it not being intended for him, but for another person of the same name, the letter, however, not having come into the possession of the defendant within view of the letter-carrier, or with his knowledge, or while he remained at the place where he left it: *Held*, that the defendant was not liable to indictment under § 22 of the said Act of March 3d, 1825. *id.*
5. All action and authority of the Post-Office Department, in respect to the

- letter, terminated with its delivery to the third person, and § 22 of the Act applies only while the letter is within the power and control of that Department. *id.*
6. Whether Congress has power to pass laws governing the conduct of persons in respect to letters which have been mailed, after such letters have become strictly disconnected from the Post-Office Department, *quere.* *id.*
7. To constitute a *Post-Office*, under § 22 of the Post-Office Act of March 3d, 1825, (4 *U. S. Stat. at Large*, 108,) the place where the business of keeping, forwarding and distributing mailable matter is conducted need not be a building set apart for that use, or any apartment or room in a building; but, according to the extent of the business done, may be a desk, or a trunk or box carried about a house, or from one building to another. *The United States v. Marselis*, 108
8. The place of the deposit of the mailable matter would, in this sense, constitute the *Post-Office*, and anything taken out of that place of reception or keeping would be taken *from or out of the Post-Office*, within § 22 of said Act, without regard to the distance of removal, or to circumjacent enclosures or rooms. *id.*
9. If a person takes a letter containing money, in a Post-Office building, from and out of that part of it appropriated to the deposit of the letter, with intent to convert its contents to his own use, he is guilty of *stealing the letter from and out of the Post-Office*, within § 22 of said Act, even though he only transfers the letter to his pocket, and does not remove it beyond the building containing the Post-Office. *id.*
10. But, whether he is guilty of *stealing the mail*, under the same section, *quere.* *id.*
11. And he is liable to be convicted under § 22 of said Act, although he was a clerk employed in the Post-Office at the time of the larceny, and

although he might, perhaps, be subject to indictment for the same offence under § 21 of said Act. *id.*

12. A decoy-letter, containing money, mailed for the purpose of entrapping a clerk in a Post-Office, who opens it and takes the money, is within the 21st section of the act of March 3d, 1825, (4 *U. S. Stat. at Large*, 107.) *The United States v. Cottingham*, 470

POWER.

1. E. made his will in 1819, devising real estate to R. his wife, for life, or during her widowhood, for the support of herself, her three daughters, and one P.; and, on the death or re-marriage of R., the estate was devised to P. for his life, for the support of himself and the daughters; and, after the death or re-marriage of R. and the death of P., the estate was devised to the three daughters in fee. The will gave power to R., so long as she should remain single, and to P. after her death or re-marriage, to sell and convey the real estate, *provided that B. should in writing, signed with his hand, approve and consent to such sale*, without which approbation and consent no such sale should be valid. The moneys arising from the sale were directed to be invested in such manner as B. should direct, for the purposes of the will. R. was appointed executrix: *Held*, that R. had only a naked power in respect to the disposition of the estate, and that the power could be rightfully exercised only by a sale of the estate in fee. *Waldron v. Chastaney*, 62
2. The testator having died, and the will having been proved, R., in 1825, leased the real estate, as executrix and trustee, to N., setting forth the will at large in the lease, for 21 years, the lessee to pay to R., her heirs and assigns, yearly during the term, if she should so long live and remain the widow of E., and, after her death or marriage, during the residue of the term then unexpired, unto P., a certain rent: *Held*, that the lease, as a conveyance under the power of sale in the will, was void,

as not fulfilling the intent of the testator, and not a sale of the estate for cash, or something which could be invested as its representative. *id.*

3. But *held, also*, that R., having an absolute estate for her widowhood, could lease that, independently of the power of sale, and that the lease was good for the interest she had, and only void for any surplus of the term unexpired at her decease. *id.*

4. R. having, in 1827, sold and conveyed the same real estate in fee to H., the conveyance purporting to be made by her as executrix and trustee under the will and in pursuance of the power of sale: *Held*, that the lease to N. was no impediment to the exercise of the power of sale. *id.*

5. In ejectment brought by the remainder-men under the will, to recover the real estate, after the death of R. and P.: *Held*, that questions touching the discreet exercise of the power of sale belonged to a Court of Equity, and that the deed to H., if valid on its face, must operate as such at law. *id.*

6. The approbation and consent of B. to the deed to H. were given by his writing at the foot of the deed, and directly following the signature of R.: "I consent to the above," and subscribing his name thereto: *Held*, that the requirement of the proviso in the power of sale was thereby satisfied, and that the consent of B. imported his approbation. *id.*

PRACTICE.

1. Where prayers for instructions to the jury are made, and are not complied with by the Court, they are to be considered as refused. *Emerson v. Hogg*, 1

2. Exceptions will lie to the refusals of the Court to give instructions when requested, in like manner as to the instructions actually given. *id.*

3. In a proceeding in this Court under § 15 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*,

82,) to obtain a discovery, in an action at law, of documents in the possession of the adverse party, it is only requisite that the cause should be at issue, and that the Court should be satisfied that the evidence required to be disclosed will be pertinent to such issue, and that the circumstances should be those in which a discovery would be decreed in Chancery. *Jacques v. Collins*, 23

4. It is not necessary that the petition for the discovery should contain the formalities of a bill of discovery in Chancery; but it is enough if it contains a notice to the opposite party of the time and place of making the application, and a plain designation of the documents sought for. *id.*

5. Where a plaintiff, who had obtained an injunction from this Court restraining a defendant from the infringement of a patent, set on foot a stratagem to lead the defendant to violate the injunction, and immediately made a motion for an attachment, knowing the defendant to be innocent of any wrongful act, and it clearly appeared that there had been no violation of the injunction: *Held*, that the plaintiff must pay the costs of the motion. *Sparkman v. Higgins*, 29

6. Even if there had been an actual violation of the injunction, induced by the stratagem of the plaintiff, an application for an attachment would not, *it seems*, be justified, either in conscience or in law. *id.*

7. Where it is assigned, as cause of demurrer to a declaration, that it is not properly entitled, but the defect is not pointed out until the argument, and is then alleged to consist in a variance between the declaration and the writ, the Court cannot act upon it on such a suggestion. *Wilder v. McCormick*, 31

8. But, even if such an objection were properly raised, an amendment of the error would be allowed. *id.*

9. Under Rule 57 in Equity, requiring notice to be given on an application for leave to file a supplemental bill

- it is not necessary that the petition for leave should embrace the averments intended to be inserted in the supplemental bill, but only that it should advise the opposite party and the Court of the ground on which the relief is applied for. *Parkhurst v. Kinsman*, 72
10. All that the Court inquires into, on such a petition, is to see whether probable cause exists for granting the leave, and whether the petition states facts or circumstances which, if properly pleaded, would sustain a supplemental bill. *id.*
 11. Where the original bill was against K., and was founded mainly on an agreement between the plaintiff and K., in relation to a machine patented to the former, which gave K. the right to make and vend the machines on certain conditions, and, on filing the bill, an injunction was issued against K., prohibiting his further making or selling the machines: *Held*, that a petition alleging that, since the filing of the bill, G. had, as the plaintiff was informed and believed, become in some way interested in the machines, and was, as the plaintiff believed, acting in collusion with K. in making and vending them, and represented himself as so interested, was sufficient to authorize the plaintiff to make G. a party to the same suit by supplemental bill. *id.*
 12. Where the same petition asked leave to insert in a supplemental bill new matters in regard to K.: *Held*, that although most of them would be proper subjects of amendment to the original bill, and could not lay the foundation for a supplemental bill, yet, as a discovery was sought from K. in regard to particulars not stated in the original bill, and K. had already answered that bill, the leave ought to be granted. *id.*
 13. Circumstances stated under which laches will not be imputed to the plaintiff as a ground for denying him leave to file a supplemental bill. *id.*
 14. The principles which govern the practice of the United States Courts in Equity, considered. *Van Hook v. Pendleton*, 85
 15. The practice as to examining witnesses in suits in Equity, considered. *id.*
 16. The Circuit Courts of the United States have power to appoint Examiners in suits in Equity. *id.*
 17. It is a matter of discretion whether such Examiners shall be standing Examiners, or be designated as the occasion arises for their services in any cause. *id.*
 18. Where the plaintiff in a suit in Equity, proceeded, after the cause was at issue, to take proofs before one of the standing Examiners of the Court, without his having been specially appointed as Examiner or Commissioner in the suit: *Held*, that the Examiner was competent to take the evidence. *id.*
 19. An oral examination before an Examiner, without any agreement between the parties to waive written interrogatories, is irregular. *id.*
 20. Such agreement ought to be in writing. *id.*
 21. But, where a party has due notice that such an oral examination is to be taken or has been taken, and acquiesces in it, he waives his right to require written interrogatories. *id.*
 22. Where, more than ten months after such an oral examination, and nearly five months after publication, the defendant, who had due notice of the time and place of the examination, moved to set the proofs aside because they were not taken on written interrogatories: *Held*, that he was guilty of laches, and that it was too late for him to raise the objection. *id.*
 23. Under Rule 78 of the Rules in Equity of 1842, it is a matter of discretion with the Court whether it will or will not stay the proceedings in a cause to allow a party to cross-examine or take a new deposition of a witness already examined by de-

- position for the opposite party under § 80 of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 88.) *id.*
24. The practice in taking depositions under that Act, considered. *id.*
25. It is a well-settled principle, in the jurisprudence of the United States, that rules of State practice acted upon by the Courts of the United States in a State, as obligatory upon them, have the efficacy of rules adopted by express order of those Courts. *Per* BETTS, J. *The United States v. Douglass*, 207
26. In a common law action, in the Circuit Court for the Southern District of New York, the assignee of a non-negotiable contract has no capacity to sue upon it in his own name, the provision of the State Code of Procedure, requiring every suit to be brought in the name of the real party in interest, not having been adopted by that Court. *Suydam v. Ewing*, 359
27. And this practice applies not only to an action originally commenced in that Court, but to one removed into that Court from a Court of the State, and to all the proceedings in such action after its removal. *id.*
28. Accordingly, where a debt was contracted with a copartnership, and afterwards the interests of some of the members of the copartnership in the debt were assigned, and then a suit at law was brought thereon in a Court of the State, in the names of the real parties in interest, and was removed into the Circuit Court for the Southern District of New York, and afterwards one of the partners died: *Held*, that the suit must be continued in the Circuit Court in the names of the surviving partners, without any reference to the real parties in interest. *id.*
29. When a cause is removed from a State Court into a Circuit Court of the United States, under the provisions of the 3d section of the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 633,) as having been commenced against an officer of the United States, for an act done under the revenue laws of the United States or under color thereof, the question whether the property for the taking of which the action was brought was seized by the defendant in the performance of his duty as an officer of the customs under the revenue laws, is a matter of fact involved in the merits of the case, and cannot be raised or determined upon a motion to dismiss the suit. *Wood v. Matthews*, 370
30. The Act of Congress gives the jurisdiction and right of removal "in any case" falling within the particular class of cases provided for, without any regard to the amount in controversy in the suit. Hence, no question can be raised in the Circuit Court based upon the trifling value of the property for the taking of which the suit was commenced. *id.*
31. The sufficiency, in point of substance, of a plea which is regular in form, cannot be inquired into on motion. *Tyler v. Hyde*, 399
32. A collector who withholds from an informer the proceeds of goods condemned as forfeited for a breach of the revenue laws, can, when sued for such proceeds, by such informer, in a State Court, remove the action by *certiorari* into a Circuit Court of the United States, under § 3 of the Act of March 2d, 1833, (4 *U. S. Stat. at Large*, 633.) *Van Zandt v. Maxwell*, 421
33. Whether, when such an action is improperly removed, the plaintiff can, upon a motion, have it remitted to the State Court, *quere*. *id.*
- See* ADMIRALTY.
ATTACHMENT.
COURTS OF U. STATES.
DEMURRER, 1.
DISCOVERY, 11 to 13.
INJUNCTION, 1 to 4.
JURY, 7.
PATENTS, 27, 28, 88 to 93.
SEIZURE, 4.

PROCESS.

See FUGITIVE SLAVE LAW, 1 to 8, 7.

PROFITS.

See PATENTS, 94, 95, 97, 99, 100, 102, 105.

RENTS AND PROFITS.

PROTEST.

See DUTIES, 13 to 17, 19, 20, 24, 28, 29, 32, 34, 35, 38 to 41, 45, 53.

PUBLICATIONS.

See PATENTS, 107.

PUBLIC USE.

See EMINENT DOMAIN.

R.

REAL ESTATE.

See EMINENT DOMAIN.
JUDGMENT, 1 to 4.
POWER.

RENTS AND PROFITS.

RECEIPT.

See BILLS OF EXCHANGE, 1.
CARRIER, 3, 4.

RECEIVER.

1. The peril of a fund in litigation is cause for the interference of the Court to secure and protect it by the appointment of a Receiver. *Parkhurst v. Kinsman*, 78

See RENTS AND PROFITS.

REMOVAL.

See PRACTICE, 27 to 30.

RENTS AND PROFITS.

1. Where, on the filing of a bill to remove an incumbrance on land, so that it may be sold under the plaintiff's judgment, a receiver is appointed of the rents and profits of the land, they are, in equity, subject to the lien and claim of the judgment, the same as the land itself. *The United States v. Butler*, 201
2. Where the parties to such a suit settle it, the plaintiff getting rid of the incumbrance by paying to its holder a certain sum, and the land being thus left subject only to his judgment, the result is, in legal effect, the same, as it respects the lien of the judgment, as if a decree were to be made in the suit that, on payment of the sum, the prior incumbrance should be discharged. *id.*
3. On the payment of such sum by the plaintiff, under a decree, the land and the rents and profits would be applicable to the plaintiff's judgment; and, the incumbrance being disposed of by settlement, the land and the rents and profits that have accrued become subject to the judgment. *id.*
4. Nor does the fact that the land is then sold under the judgment, and satisfaction entered of the judgment, that being done in pursuance of an agreement with the defendant in the judgment, affect the right of the plaintiff to those rents and profits. They are, in equity, immediately applicable to the judgment when the right under the incumbrance is disposed of; and the agreement to enter the satisfaction after selling the land and applying the proceeds, will be construed, upon a fair interpretation, to intend that the rents and profits which have accrued and are in the hands of the receiver shall also be applied on the judgment. *id.*

REPLEVIN.

See DUTIES, 11.

REPORTER.

See REPORTS.

REPORTS.

1. The provision of the 22d section of the 6th Article of the Constitution of the State of New York, adopted in 1846, that all "judicial decisions shall be free for publication by any person," is not repugnant to the Constitution and laws of the United States. *Little v. Gould*, 165
2. Nor is the 2d section of the Act of the Legislature of the State of New York, passed April 9th, 1850, (*Laws of 1850, chap. 245*), which provides that "the copyright of any notes or references made by the State Reporter" to any of the Reports of the decisions of the Court of Appeals "shall be vested in the Secretary of State for the benefit of the People" of the State, inconsistent with the said provision of the Constitution of the State of New York. *id.*
3. The various Acts passed in relation to the publication of the reports of the Court of Appeals of the State of New York, reviewed. *id.*
4. The word "notes" in the said Act of 1850, comprises the summary of the points decided by the Court which immediately follows the title of the suit in each case reported, and the foot-notes in the volume of Reports, and in the statement of the arguments of counsel. *id.*
5. The abstracts of the pleadings and the statements of facts, which form the basis of the decisions reported, are neither "notes" nor "references." *id.*
6. The "notes and references" intended by the Act do not embrace such original notes and references as the Reporter may see fit, of his own accord, to superadd to what would otherwise be, in themselves, complete Reports of the cases reported by him. *id.*
7. As to what is covered by the words "references" in the Act, *quere. id.*
8. In pursuance of law, the State Reporter, the Secretary of State and the Comptroller of the State of New York, contracted with L. that he should, during the term of five years, publish the decisions of the Court of Appeals, and have the exclusive benefit of the copyright to be taken out in behalf of the State, of the notes and references and other matter furnished by the State Reporter connected with such decisions, which contract was therein declared to be an assignment and transfer to L. of the copyright of the matter so published. The contract was made after the passage of said Act of 1850. The Reporter, was a salaried officer, appointed by the State authorities, under laws which declared that he should have no pecuniary interest in his Reports, but that they should be published by contract, and that it should not be lawful for the Reporter, or any other person within the State, "to secure or obtain any copyright for said Reports of judicial decisions," but that the same might be published by any person. After said contract was made, the Reporter prepared a volume of said Reports, and the necessary steps to obtain a copyright for it under the Acts of Congress were taken in the name of the Secretary of State of the State of New York, in trust for said State. This volume was, during the five years, printed and published by L. under his contract. Subsequently, and during the five years, G. reprinted and published the volume: *Held*, on a motion by L. for a provisional injunction, that he was entitled to such an injunction restraining G. from publishing or selling any copies of the Reports of cases argued and determined in said Court, already published or to be thereafter published by L. in pursuance of his contract, containing any of the head-notes or summary statements of points decided, or any foot-notes, copied or taken or colorably altered from any book so published by L. *id.*

See COPYRIGHT, 13 to 17.

RES ADJUDICATA.

See PATENTS, 114 to 117.

RESCUE.

See FUGITIVE SLAVE LAW, 1 to 3, 7.

REVENUE LAWS.

1. The 1st section of the Act of March 2d, 1821, (3 *U. S. Stat. at Large*, 616,) as re-enacted by the Act of March 3d, 1823, (*Id.* 781,) which imposes a penalty for bringing into the United States from adjacent territory goods subject to duty, and not delivering a manifest thereof at the nearest Collector's office, is not repealed by § 19 of the Act of August 30th, 1842, (5 *Id.* 565.) *The United States v. Smith*, 127
2. The first two Acts and the last Act provide for a very different class of offences. The former attach the penalty to the mere neglect to deliver a manifest, no matter what the intent. In the latter, there must be an intent to defraud the revenue, and either smuggling or an attempt to pass a fraudulent invoice. *id.*
3. The Act of 1821 does not require either a formal entry at the Collector's office or an invoice, and the system established by it is a distinct one, applicable to the frontiers adjacent to foreign territories. *id.*
4. The Act of 1842 is aimed at frauds on the revenue, in cases where an entry of goods and an invoice are required, as prescribed by the Act of March 1st, 1823, (3 *U. S. Stat. at Large*, 729.) *id.*

See COSTS, 2 to 5.

DUTIES.

FORGERY.

PRACTICE, 29, 30, 32, 38.

SEIZURE.

RULES.

See PRACTICE, 25.

S.

SALE.

See DUTIES, 10, 11, 30.

JUDGMENT, 7, 8.

LIEN, 4, 9.

PATENTS, 57 to 62.

POWER.

SALVAGE.

1. Where the officers and crew of a vessel of war belonging to the United States Government rendered, under the direction of her commander, and in obedience to the general instructions of the Government to all its vessels to render relief freely and promptly to American vessels in distress, services in towing into an American port an American merchant-vessel found abandoned at sea five hundred miles distant, but the delay thus caused was one of only two days, and no extraordinary service was rendered, and no unusual hardship or peril was encountered: *Held*, that the officers and crew were not entitled to salvage. *The Josephine*, 322
2. Whether the officers and crews of the naval vessels of the United States are in any case entitled to salvage for services rendered to American merchant-vessels in distress, notwithstanding such instructions, *quere*. *id.*

SEIZURE.

1. Where a vessel was seized by a Collector for an alleged violation of the navigation laws of the United States, but was discharged from arrest by this Court on a hearing of the libel filed against her, on the ground that the statute had not been violated, and the Collector afterwards applied to the Court, under § 1 of the Act of February 24th, 1807, (2 *U. S. Stat. at Large*, 422,) for a certificate of reasonable cause for the seizure, and it appeared that the vessel was seized upon a construction of the statute adopted by the Secretary of the

Treasury, in conformity with the opinion of the Attorney-General, and that the Collector acted under the instructions of the former officer in making the seizure: *Held*, that the certificate must be granted. *The United States v. The Ship Recorder*, 119

2. It makes no difference whether the Collector acted under a mistake as to facts on which he had reason to rely, or as to the law. *id.*

3. A reasonable ground of suspicion is reasonable cause for a seizure. *id.*

4. Where the application for a certificate was not made until more than two years and four months after the decision of the cause, and until after the claimant had brought suit against the Collector for the seizure: *Held* that, although the lapse of time was not a bar to the application, yet, as there had been laches in not making it until after the claimant had brought such suit and incurred consequent expenses, those costs must be paid him. *id.*

SHIPPING.

See BILL OF LADING.
CARRIER.
COLLISION.
LIEN.
SALVAGE.
SEIZURE.
STEAMBOATS.

SLAVE.

See FUGITIVE SLAVE LAW.

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See REVENUE LAWS, 2.

SPECIFICATION.

See PATENTS, 27 to 37, 121, 124, 125, 129, 130, 137 to 139, 141.

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See EQUITY, 1, 2.

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STEALING.

See POST-OFFICE, 8 to 10.

STEAMBOATS.

1. On an indictment for manslaughter, under the 12th section of the Act of July 7th, 1838, (*5 U. S. Stat. at Large*, 306,) against the captain of a steamboat, it is not necessary for the prosecution to show wilful misconduct, negligence or inattention in the captain. *The United States v. Farnham*, 528
2. The captain of a steamboat is responsible for the proper performance by the engineer, the pilot, and all the other officers, of their duties on board, unless their authority is expressly made independent of him. *id.*
3. The duties and responsibilities of the captain of a steamboat are the same as those of the captain of any other vessel; and, as to the relative duties and responsibilities of the different officers of steam vessels, there is no distinction between those which navigate inland waters exclusively and sea-going vessels. *id.*
4. The 7th section of the Act above named makes it the duty of the master to see that the safety-valve of the boiler is raised when the steamboat stops. *id.*
5. Under that section, it is not sufficient to raise the safety-valve only when the pressure of steam is higher after than before the stoppage of the boat. *id.*
6. Nor is the safety-valve to be raised only when the pressure of steam becomes, during the stoppage, higher than that named in the certificate of the inspectors as the pressure the boiler will bear. *id.*
7. Nor can other methods of lowering the pressure of steam—such as opening the furnace-doors—be substituted for the raising of the safety-valve. *id.*

8. It is a culpable omission in the captain to leave it to the discretion of the engineer whether to raise the safety-valve during a stoppage or not. *id.*

9. The omission of the captain to give orders for the raising of the safety-valve when the boat stops, is legal evidence to support an indictment against him under the 12th section of the Act, provided the omission to raise the safety-valve was the proximate cause of the destruction of life. *id.*

STEAM VESSELS.

See STEAMBOATS.

STIPULATION.

See ADMIRALTY, 3.

SUPERVISOR.

See FORGERY.

SUPPLEMENTAL BILL.

See PRACTICE, 9 to 13.

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See ADMIRALTY, 3.

T.

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See DUTIES.

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See PRACTICE, 15 to 24.

TITLE.

See DISCOVERY, 15, 16.
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TRESPASS.

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DISCOVERY, 8, 9.

TRIAL.

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V.

VARIANCE.

See DEMURRER, 1.
PRACTICE, 7, 8.

VENIRE.

See GRAND JURY, 6, 10 to 14.

VERDICT.

1. The rule that the verdict of a jury will not be set aside where evidence was given on both sides, and there was no misdirection as to the law, is applicable to an action on the case for the infringement of a patent. *Blanchard's Gun-Stock Turning Factory v. Jacobs*, 69
2. Where, in such an action, it was submitted to the jury, as a question of fact, whether the defendant was concerned in using the infringing machine, or was merely a purchaser of the articles manufactured by it, and the jury, having been instructed that the defendant was not liable if he was only the purchaser of the articles after they were manufactured, found for the plaintiff: *Held* that, as there was evidence on both sides of the question, and the verdict was not clearly against the weight of evidence, it must stand. *id.*

See PATENTS, 91 to 93.

VESSEL.

See BILL OF LADING.
CARRIER.
COLLISION.
JUDGMENT, 7, 8.
LIEN.
SALVAGE.
SEIZURE.
STEAMBOATS.

W.

WAREHOUSE.

See COLLECTOR.

WARRANT.

See FUGITIVE SLAVE LAW, 1.

WEIGHER.

See DUTIES, 26, 27.

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